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TRANSCRIPT OF RECORD.

IN THE SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1890.

No. ~~860~~. 50

J. McGREGOR ADAMS, PLAINTIFF IN ERROR,

vs.

THE BELLAIRE STAMPING COMPANY, J. T. MERCER, AND C. H. TALLMAN.

IN ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE SOUTHERN DISTRICT OF OHIO.

FILED MAY 1, 1888.

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No. 360.

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1 June Term, A. D. 1887.

At a stated term of the circuit court within and for the sixth judicial circuit and eastern division of the southern district of Ohio, begun and held at the court-rooms, at the city of Columbus, on the first Tuesday of June, in the year of our Lord one thousand eight hundred and eighty-seven, and in the one hundred and eleventh year of the Independence of the United States of America—present, the Honorable George R. Sage, district judge—among the proceedings had were the following:

JOHN MCGREGOR ADAMS, Plaintiff,
vs.
THE BELLAIRE STAMPING COMPANY, J. T. MERCER, and C. H. TALLMAN, Defendants. } No. 173. Law.

Be it remembered that on the 19 day of June, in the year of our Lord one thousand eight hundred and eighty-four, came the plaintiff, by his attorney, and filed in the clerk's office of the court aforesaid his certain petition against the defendants herein, clothed
2 in the words and figures following, to wit:

Petition.

United States Circuit Court, Southern District of Ohio, Eastern Division.

JOHN MCGREGOR ADAMS
vs.
THE BELLAIRE STAMPING COMPANY, J. T. MERCER, and C. H. TALLMAN. } At Law. Petition.

John McGregor Adams, who is a citizen of the United States and resident in the city of Chicago, in the county of Cook and State of Illinois, plaintiff in this suit, by Wood and Boyd, his attorneys, complains of The Bellaire Stamping Company, a corporation organized under the laws of the State of Ohio, having its principal place of business in Bellaire, in said State, and of J. T. Mercer and of C. H. Tallman, citizens of Ohio and residents of said Bellaire, defendants in this suit, of a plea that the said defendants render unto the said plaintiff the sum of sixty-seven thousand two hundred and fifty dollars, lawful money of the United States of America, which the said defendants, jointly and severally, to the said plaintiff owe and from him unjustly detain, as damages for the infringement of letters patent of the United States hereinafter mentioned:

For that whereas heretofore and before the 24 day of Oct.,
3 A. D. 1865, and before and at the time of the making of the letters patent and before the committing of the several grievances hereinafter mentioned, one John H. Irwin, being then a citizen of the United States, was the true, original, and first inventor or discoverer of a certain new and useful invention in lanterns, and which said invention was not known or used by others before such

invention and discovery thereof as aforesaid, and was not at the time of the application for letters patent therefor in public use or on sale with the consent or allowance of the said John H. Irwin.

That the said John H. Irwin thereupon afterwards made application in writing to the Commissioner of Patents of the United States for the granting of letters patent for said invention and discovery to him, and accompanied the same with a written description of the said invention or discovery and the manner and process of constructing and using the same in such full, clear, and exact terms as to enable any person skilled in the art to which the said invention appertained to construct and use the same, and with a specification of the parts and improvements and combinations which he claimed as his invention, and with drawings, models, and references explaining the said invention, by which it might be distinguished from other inventions, and then and there made oath that he verily believed that he was the original and first inventor of the said invention, and that he did not know or believe that the same was ever before known or used, and then and there also duly complied in all other respects with all the necessary conditions and requirements of the statutes of the United States in such case made and provided prior to the granting of the latters patent hereinafter mentioned.

4 That on the said 24th day of October, A. D. 1865, letters patent bearing date on that day were issued to the said John H. Irwin, according to law, whereby there was granted to him, his heirs, executors, administrators, or assigns, for the term of 17 years from the said 24th day of Oct., A. D. 1865, the full and exclusive right and liberty of making, of constructing, of using, and of vending to others to be used the invention or discovery aforesaid, as by reference to the specification, claims, and drawings of the said letters patent, a copy of which is hereto annexed and made a part hereof, will more fully and at large appear, said letters patent being numbered 50591.

And plaintiff further says that on or before the 31st day of Oct., A. D. 1874, the said letters patent No. 50591 were assigned by mesne assignments, duly executed and delivered, for a good and valuable consideration, to the said John McGregor Adams, plaintiff, &c., whereby he acquired all the right, title, and interest in and to said letters patent, together with the right to recover any and all profits, damages, savings, and license fees which had then accrued by reason of any infringement prior thereto by parties not licensed under said letters patent, as by said mesne assignments or duly certified copies thereof, to be here in court produced, will more fully appear, and that by virtue of the premises the said John McGregor Adams, plaintiff, &c., is now the sole and exclusive owner of the right to recover for and on account of any and all infringements heretofore committed from and after the said 24th day of Oct., A. 1865, to and until the expiration of said letters patent, to wit, the 24th day

5 of Oct., A. D. 1882, within the said southern district of Ohio and elsewhere.

And plaintiff further says that the invention or discovery so

patented as aforesaid is and was of very great utility, and that the same has been extensively introduced into public use, and that the public have generally acquiesced in his exclusive right to the same as aforesaid; and so it is that two certain mutual unincorporated associations of railroad companies, called the Eastern Railroad Association and the Western Railroad Association, the former having its headquarters at Washington, in the District of Columbia, and the latter having its headquarters at Chicago, in the State of Illinois, which said associations embrace about one hundred thousand miles of railroad, did so acquiesce in the validity of the said letters patent and in and to the plaintiff's exclusive title thereto, and for a valuable consideration did purchase from this plaintiff licenses to use the said invention, and did contract to and with this plaintiff not to purchase lanterns embodying the said invention from others than this plaintiff and his duly authorized licensees; and so it is that a large number of manufacturers and dealers also during the life of said letters patent did acquiesce in the validity thereof and did purchase licenses to make, to cause to be made, and to sell lanterns involving the said invention from this plaintiff, and that certain of said manufacturers and supply agents contracted to pay and did pay to this plaintiff, as a fair and reasonable license fee for such license right, the sum of fifty (50) cents per dozen of lanterns made and sold and involving the said invention, and that among the manufacturers and supply agents so acquiesced in the title and validity of said letters patent
6 and so paying the said license fee of fifty (50) cents per dozen was the Adams & Westlake Manufacturing — and Messrs. Crerar, Adams & Company, of Chicago, Ill; M. M. Buck & Company and the Railroad Supplies Manufacturing Company, of St. Louis; S. M. Aikman & Company and Underhill, Osborn & Company, of New York city; the New England Glass Works, of Boston, Mass., and the Hemingway Glass Company, of Cincinnati, Ohio.

And plaintiff further says that heretofore, in the United States circuit court for the northern district of Illinois, to wit, on the 26th day of Nov., A. D. 1879, in a cause therein pending, in which the said John McGregor Adams was plaintiff and The Illinois Manufacturing Company was defendant, in which cause copies of the following letters patent of the United States and of Great Britain, as exhibiting the prior state of the art and as limiting, if not defeating, the said letters patent here sued on, were introduced in evidence on behalf of the defendant and were fully considered by the court, to wit:

United States letters patent—

No. 3747, granted Nov. 23, 1869, to W. Westlake.
" 11632, " Aug. 29, 1854, " P. A. Morley.
" 27924, " April 17, 1860, " " "
" 13286, " July 17, 1855, " G. Waters.
" 13539, " Sept. 11, 1855, " C. H. Butterfisk.
" 14006, " Dec. 25, 1855, " " "
" 21209, " Aug. 17, 1858, " Max Miller.
" 48839, " May 24, 1864, " G. F. J. Colburn.

And English patents of Isaac Evans, of April 8, 1861, No. 2512, and of G. Chappell, of April 28, 1812, No. 3557. The said
7 letters patent No. 50591 were adjudged to be good and valid, and that the said John H. Irwin was the first and original inventor of the said improvements therein described and claimed, and that the said John McGregor Adams, by virtue of assignments duly made, acquired the entire right, title, and interest in and to the said invention and letters patent, as hereinbefore alleged and claimed; and that in the United States circuit court for the southern district of New York, heretofore, to wit, on the 6th day of Feb., A. D. 1884, in a cause therein pending, in which the said John McGregor Adams was a plaintiff and one John R. Howard and others were defendants, in which cause copies of the following English letters patent, as exhibiting the prior state of the art and as limiting if not defeating the said letters patent here sued on, were introduced in evidence on behalf of the defendant and were fully considered by the court, to wit:

English patent of			Southerland,	of 1857, No. 1194.
"	"	"	Dessales	" 1856.
"	"	"	"	" 1858.
"	"	"	Burnell	" 1841.
"	"	"	Brown	" 1846.
"	"	"	Price	" 1863.
"	"	"	Marsley	" 1864.
"	"	"	Strafford	" 1864.
"	"	"	Wavish	" 1864.

A similar decree was entered by order of the court adjudging the said letters patent No. 50591 to be valid and the said title of the said Adams to be subject to certain licenses theretofore granted by him, as hereinabove alleged.

8 And plaintiff further says that the said defendants and each of them, well knowing the premises and the rights and privileges secured unto the said plaintiff, and in order to deprive him of his profits, damages, benefits, and advantages and to interfere with his said exclusive rights, which otherwise would have accrued to him, at the southern district of Ohio and elsewhere, and without the license or permission of the said plaintiff and without any right, title, or license under the said letters patent, the said defendants, first under the name of The Baron Manufacturing Company and afterwards under the present corporate name of the said defendant company, to wit, The Bellaire Stamping Company, has at divers and sundry times since the said 24th day of Oct., A. D. 1865, and within the said term of years in the said letters patent mentioned and before the commencement of this suit and, to wit, on the 21st day of March, A. D. 1871, and on divers and sundry days, both between and since said dates herein last mentioned, made, caused to be made, sold, and used a large number of lanterns, of the exact number of which the said plaintiff is now ignorant, each and all containing the said invention, discovery, improvements, and com-

binations in said letters patent described and claimed, the exclusive right to which was secured to this said plaintiff, as hereinabove set forth, and which said unlawful making, use, and sale by the defendants as aforesaid was in violation and infringement of the said plaintiff's exclusive rights and privileges secured to plaintiff by said letters patent as aforesaid and contrary to the form of the statute of the United States in such case made and provided; and that the said J. T. Mercer and the said C. H. Tallman, defendants as aforesaid, well knowing the premises and being often warned and cautioned not to so do, the former being president and the latter being secretary and treasurer of the said defendant company, did each of them personally and knowingly participate in and direct the said infringement hereinabove complained of, and as officers and stockholders in the said company have participated in the profits so wrongfully derived therefrom, whereby the said defendants have jointly and severally derived and received from such manufacture and sales and use great gains and profits, to wit, the sum of sixty-seven thousand two hundred and fifty dollars.

9

And the said defendant, The Bellaire Stamping Company, by its proper officers, and the said C. H. Tallman, defendant as aforesaid, and each of them, are hereby required, over the corporate seal of the said Bellaire Stamping Company and upon the corporal oath of the said C. H. Tallman, according to the best and utmost of his knowledge, remembrance, information, and belief, to make full, true, direct, and perfect answers to the several interrogatories hereinafter numbered and set forth—that is to say:

First. Whether the said Bellaire Stamping Company, under and in its present incorporate name and also under the name of the Buckeye Lantern Company and also under the name of the Baron Manufacturing Company, has not since the said 24th day of Oct., A. D. 1865, and prior to the 24th day of Oct., A. D. 1882, made, sold, and delivered lanterns having a removable top attached to the upper part of the lantern guard by a hinge and by removable fastening or spring catch opposite to said hinge.

10

Second. How many lanterns so constructed have been made and sold during said period by the said defendant corporation, either by or through the said "Baron Manufacturing Company" or by or through the said "Buckeye Lantern Company" or otherwise?

Third. Whether the said "Buckeye Lantern Company" is a copartnership acting as the sales agent for the said Bellaire Stamping Company, and how many lanterns so constructed as above and made or caused to be made by the said Bellaire Stamping Company have been sold to or have been sold by the said Buckeye Lantern Company within the period aforesaid?

And the plaintiff further says that by force of the statute aforesaid an action has accrued to him to recover his actual damages in the premises and such additional amount, not exceeding in the whole three times the amount of such actual damages, as the court may see fit to order and adjudge, beside costs; yet the defendant, though requested, has never paid the same nor any part thereof to

the plaintiff, but has refused and yet refuses so to do, and therefore the plaintiff brings this suit, etc.

WOOD & BOYD,
Attorneys for Plaintiff.

J. H. RAYMOND,
Honore Buildings, Chicago, Ill., Counsel.

11 United States Circuit Court, Southern District of Ohio, Eastern Division. At Law.

STATE OF ILLINOIS, } ss:
County of Cook, }

William M. Campbell, being duly sworn, on oath states that he is the agent of the said John McGregor Adams, the plaintiff in the above-entitled cause; that he is familiar with the subject-matter of the allegations contained in the foregoing petition or declarations; that he has read the same and understands the contents thereof, and that this affiant believes the facts therein pleaded to be true.

WILLIAM M. CAMPBELL.

Subscribed and sworn to in my presence this 17th day of June, A. D. 1884.

[SEAL.] JOSHUA S. SEAVERNS,
Notary Public in and for the County and State Aforesaid.

12 Attached to the foregoing petition is the following exhibit:

UNITED STATES PATENT OFFICE.

JOHN H. IRWIN, of Chicago, Illinois.

Improvement in Lanterns.

Specification forming part of Letters Patent No. 50591, dated October 24, 1865.

To all whom it may concern:

Be it known that I, John H. Irwin, of the city of Chicago, in the county of Cook and the State of Illinois, have invented a new and useful improvement in lanters, and I do hereby declare that the following is a full, clear, and exact description of the same, reference being had to the accompanying drawing and the letters and figures marked thereon, which form part of this specification.

The nature of my said invention consists in attaching the metallic top of the lantern in which the top of the glass globe or protector enters and by which it is held in place by a hinge to the upper part of the wire guard surrounding the globe and securing it at the side opposite said hinge by a removable fastening or spring-catch, so that by detaching said catch from the said upper part of the lantern guard the top of the lantern may be thrown back, opening upon the aforesaid hinge, thus enabling the globe to be removed, or for any other purpose.

To enable those skilled in the art to understand how to construct

13.A

J. H. IRWIN.

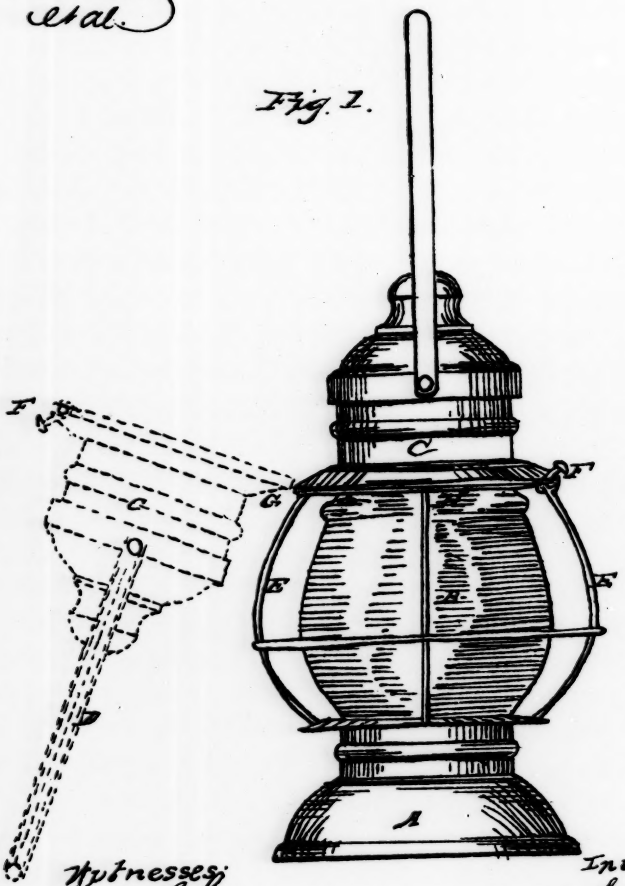
Lantern.

13

No. 50,591. Patented Oct. 24, 1865.

No. 360. Adams & B. & L. Co. et al. } p. 13.

Fig. 1.



Witnesses:
Sumford Byb
Geo B Nichols

Inventor:
John H. Irwin
by Coburn & Mann
Attorneys

and make use of my invention I will proceed to describe the same with particularity, making reference in so doing to the aforesaid drawing, in which—

13 (Here follows diagram marked p. 13.)

Figure 1 represents a side elevation of my invention, the removable top being represented in two positions.

Similar letters of reference indicate the same parts of my invention in the different positions represented.

A represents the ordinary base or bottom of the lantern containing the oil cup; B, the glass globe or protector; C, the top of the lantern, hinged to the upper part of the guard E at G, F being the handle by which the lantern is held or carried from place to place, and F′, the catch, arranged opposite the hinge G, for holding the lantern top firmly to the guard, H representing an annular wire attached to the upper ends of the guards E.

The full lines in the drawing show the lantern ready for use.

When it is desired to remove the globe or to open the lantern for any other purpose the catch F′ is pressed downward or inward, releasing the same from the annular wire H, or its equivalent, for holding the catch when the top is swung back upon the hinge G into the position indicated by the dotted lines, when the globe can be removed, or any other purposes may be accomplished, as desired.

What I claim as my invention and desire to secure by letters patent is—

Securing a removable lantern top to the upper part of the guard, substantially as herein specified and described.

JOHN H. IRWIN.

Witnesses:
JAMES F. GRIFFIN.
LEWIS L. COBURN.

14 And afterwards, to wit, on the same day, there was filed in the clerk's office of the court aforesaid our certain præcipe for summons. Said præcipe is clothed in the words and figures following, to wit:

Præcipe.

United States Circuit Court, Southern District of Ohio, Eastern Division.

JOHN MCGREGOR ADAMS
vs.
THE BELLAIRE STAMPING COMPANY, J. T. MERCER, and C. H. TALLMAN. } No. 173.

To William C. Howard, clerk of said court:

Please issue summons endorsed for damages, $67,250.00.

WOOD AND BOYD
Att'ys for Pl'ff.

And afterwards, to wit, on the 19th day of June, A. D. 1884, there was issued out of the clerk's office of the court aforesaid our certain summons, directed to the marshal of the district aforesaid and against the defendants herein. Said summons is clothed in the words and figures following, to wit:

Summons.

UNITED STATES OF AMERICA,
Southern District of Ohio, Eastern Division, } ss:

15 The President of the United States of America to the marshal of the southern district of Ohio, Greeting:

You are hereby commanded to summon The Bellaire Stamping Company, a corporation organized under the laws ot the State of Ohio, and J. T. Mercer and C. H. Tallman, citizens of and residents in the State of Ohio, if they be found in your district, to be and appear in the circuit court of the United States for the southern district of Ohio aforesaid, at Columbus, on the first Tuesday in the month of July, 1884, to answer unto John McGregor Adams, citizen of and resident in the State of Illinois, in civil action for damages; and have you then and there this writ.

Witness the Honorable Morrison R. Waite, Chief Justice
[SEAL.] of the United States, this 19th day of June, A. D. 1884, and in the 108th year of the Independence of the United States of America.

Attest: WM. C. HOWARD, *Clerk*,
By ROB'T C. GEORGI, *Deputy*.

Endorsed thereon: Action for the recovery of damages. Amount claimed, $67,250.00, for which judgment may be taken unless they answer on or before the 3rd day of July, 1884.

And afterwards, to wit, on the 19th day of June, A. D. 1884, the following cost bond was filed in the clerk's office of the court aforesaid in the words and figures following, to wit:

Cost Bond.

In the Circuit Court of the United States for the Southern District of Ohio, Eastern Division.

16 JOHN MCGREGOR ADAMS
vs.
THE BELLAIRE STAMPING COMPANY *et al.*

I hereby acknowledge myself security for costs in this case.
E. V. CHERRY. [SEAL.]

Taken and acknowledged before me this 19th day of June, A. D. 1884.

ROB'T C. GEORGI, [SEAL.]
Dep'ty Clk C. C., S. D. O.

SOUTHERN DISTRICT OF OHIO, *ss:*

I, Elias V. Cherry, a resident of said district, do solemnly swear that after paying my just debts and liabilities I am worth five thousand dollars in real estate within the jurisdiction of this court and subject to execution, levy, and sale.

E. V. CHERRY.

Sworn to and subscribed before me this 19th day of ——, A. D. 1884.

ROB'T C. GEORGI, [SEAL.]
Dep'ty Clk U. S. C. C., S. D. O.

And afterwards, to wit, on the 28th day of June, A. D. 1884, came the marshal of the district aforesaid, to whom the said summons was in form directed, and returned the same into the clerk's office of the said court, with his proceedings thereon endorsed, in words and figures following, to wit:

Return.

17 Marshal's return.

Received this writ on the 20th day of June, A. D. 1884, and served on the 25 day of June, A. D. 1884. I served the same by handing a true copy thereof, with the endorsements thereon, to said J. T. Mercer, president of the Bellaire Stamping Company, and J. T. Mercer and C. H. Tallman personally on June 26th, 1884.

LOT WRIGHT, *Marshal,*
By C. M. MORRIS, *Deputy.*

Fees: Total amount, $15.90.

And afterwards, to wit, on the 28th day of June, A. D. 1884, the following appearance of defendants was filed in the cl'k's office of the said court, clothed in the words and figures following, to wit:

Appearance.

WASHINGTON, D. C., *June* 28, 1884.

Clerk U. S. C. court, Columbus, Ohio.

DEAR SIR: Please enter my appearance for all the defendants in the suit of John McGregor Adams *vs.* The Bellaire Stamping Company and J. T. Mercer and C. H. Tallman. I enclose copy of the summons as served.

Yours truly, GEO. W. DYER.

P. S.—If a declaration has been filed in this suit please send me a copy of the same, with your charges for it, unless copies were left with you for the defendants, in which case please send me at once. You will oblige me, also, by informing — when the circuit court holds its regular terms at Columbus and when this suit may be reached for trial.

Yours, &c. GEO. W. D.

18 And afterwards, to wit, on the 30th day of June, A. D. 1884, the following stipulation was filed in the clerk's office of the court aforesaid, clothed in the words and figures following, to wit:

Stipulation.

U. S. Circuit Court, Southern District of Ohio, Eastern Division.

JOHN MCGREGOR ADAMS
vs.
THE BELLAIRE STAMPING COMPANY *et al.* } No. 173.

Upon request of defendants in this cause it is stipulated that the defendants have twenty days from and after July 15, 1884, in which to plead to the plaintiff's petition and declaration.

WOOD AND BOYD,
Att'ys for Pl't'f.
GEO. W. DYER,
Att'y for Def'ts.

And afterwards, to wit, on the 4th day of Aug., A. D. 1884, the following motion was filed in the clerk's office of the court aforesaid, clothed in the words and figures following, to wit:

Motion.

United States Circuit Court, Southern District of Ohio.

JOHN MCGREGOR ADAMS
vs.
BELLAIRE STAMPING COMPANY *et al.* } At Law. No. 173.

And now come the said defendants and move the court to order the plaintiff to strike out from his petition the following language,
19 because the same is redundant, irrelevant, and immaterial and is a statement of the evidence and not of the facts upon which he bases his claim, to wit:

First. For that whereas, heretofore and before the 24th day of Oct., A. D. 1885, and before and at the time of the making of the letters patent and before the committing of the several grievances hereinafter mentioned, one John H. Irwin, being then a citizen of the United States, was the true, original, and first inventor of or discoverer of a certain new and useful invention in lanterns, and which said invention was not known or used by others before such invention and discovery thereof as aforesaid, and was not at the time of the application for letters patent therefor in public use or on sale with the consent or allowance of the said John H. Irwin; that the said John H. Irwin thereupon afterwards made application in writing to the Commissioner of Patents of the United States for the granting of letters patent for said invention and discovery to him, and accompanied the same with a written description of the said invention or discovery and the manner and process of constructing and using the same in such full, clear, and exact terms as to enable any person skilled in the art to which the said invention

appertained to construct and use the same, and with a specification of the parts and improvements and combinations which he claimed as his invention, and with drawings, models, and references explaining the said invention, by which it might be distinguished from other inventions, and then and there made oath that he verily believed that he was the original and first inventor of the said invention, and that he did not know or believe that the same was
20 ever before known or used, and then and there also duly complied in all other respects with all the necessary conditions and requirements of the statutes of the United States in such case made and provided prior to the granting of the letters patent hereinafter mentioned.

Second. Also to strike out the following words, to wit: And plaintiff further says that the invention or discovery so patented as aforesaid is and was of very great utility, and that the same has been extensively introduced into public use, and that the public have generally acquiesced in his exclusive right to the same as aforesaid, and so it is that two certain mutual incorporated associations of railroad companies, called the Eastern Railroad Association and the Western Railroad Association, the former having its headquarters at Washington, in the District of Columbia, and the latter having its headquarters at Chicago, in the State of Illinois, which said associations embrace about one hundred thousand miles of railroad, did so acquiesce in the validity of the said letters patent and in and to plaintiff's exclusive title thereto, and for a valuable consideration did purchase from this plaintiff license to use the said invention and did contract to and with this plaintiff not to purchase lanterns embodying the said invention from others than this plaintiff and his duly authorized licensees; and so it is that a large number of manufacturers and dealers also during the life of said letters patent did acquiesce in the validity thereof and in this plaintiff's exclusive right and title thereto, and did purchase licenses to make, to cause to be made, and to sell lanterns involving the said
21 invention from this plaintiff, and that certain of said manufacturers and supply agents contracted to pay and did pay to this plaintiff as a fair and reasonable license fee for such license right the sum of fifty (50) cents per dozen of lanterns made and sold and involving the said invention, and that among the manufacturers and supply agents so acquiescing in the title and validity of said letters patent and so paying the said license fee of fifty (50) cents per dozen was the Adams and Westlake Manufacturing Company and Messrs. Crerar, Adams & Company, of Chicago, Ill.; M. M. Buck & Company and the Railroad Supplies Manufacturing Company, of St. Louis, Mo.; S. M. Aikman and Company and Underhill, Osborn & Company, of New York city; the New England Glass Works, of Boston, Mass., and the Hemingway Glass Company, of Cincinnati, Ohio.

And plaintiff further says that heretofore, in the United States circuit court for the northern district of Illinois, to wit, on the 26th day of Nov., A. D. 1879, in a cause therein pending, in which the said John McGregor Adams was plaintiff and The Illinois Manufacturing

Company was defendant, in which cause copies of the following letters patent of the United States and of Great Britain, as exhibiting the prior state of the art and as limiting if not defeating the said letters patent here sued on, were introduced in evidence on behalf of the defendant and were fully considered by the court, to wit:

United States letters patent—
No. 3747, granted Nov. 23, 1869, to W. Westlake.
" 11632, " Aug. 29, 1854, " P. A. Morley.
" 27924, " Apr. 17, 1860, " " "
" 13286, " July 17, 1855, " G. Waters.
No. 13539, granted Sept. 11, 1885, to C. H. Butterfield.
22 " 14006, " Dec. 25, 1855, " " "
" 21609, " Aug. 17, 1868, " Max Miller.
No. 48839, granted May 24, 1864, to G. F. T. Colburn.

And English patents of Isaac Evans, of April 8, 1861, No. 2512, and of G. Chappell, of April 28, 1812, No. 3557. The said letters patent No. 50591 were adjudged to be good and valid, and that the said John H. Irwin was the first and original inventor of the said improvements therein described and claimed, and that the said John McGregor Adams, by virtue of assignments duly made, acquired the entire right, title, and interest in and to the said invention and letters patent, as hereinafter alleged and claimed; and that in the United States circuit court for the southern district of New York, heretofore, to wit, on the 6th day of Feb., A. D. 1884, in a cause therein pending, in which the said John McGregor Adams was a plaintiff and one John R. Howard and others *was* defendants, in which cause copies of the following English letters patent, as exhibiting the prior state of the art as *a* limiting if not defeating the said letters patent here sued on, were introduced in evidence on behalf of the defendants and were fully considered by the court, to wit:

English patent of Sutherland, of 1857, No. 1194.
" " Dessales " 1856.
" " " " 1858.
" " Burnell " 1841.
" " Brown " 1846.
" " Price " 1863.
" " Marsley " 1864.
" " Strafford " 1864.
" " Navish " 1864.

23 A decree was entered by order of the court adjudging the said letters patent No. 50591 to be valid and the said title of the said Adams to be subject to a certain license theretofore granted by him, as hereinabove alleged.

Third. Also to strike out the following words, to wit: "Since the said 24th day of Oct., A. D. 1865, and upon the — day of ——, A. D. 1871," because the same is barred by the statute of limitations and is therefore improperly joined in said petition.

GEO. W. DYER AND C. H. GROSVNER,
Att'ys for Defendants.

And afterwards, to wit, on the 25th day of Nov., A. D. 1884, an order was made upon the order book of the court aforesaid in the words and figures following, to wit:

O. B., p. 27.

Leave is granted to the plaintiff to substitute a declaration in case for his petition hereinbefore filed, the petition to remain on files but withdrawn from the record. The defendants have leave to plead within 20 days.

GEO. R. SAGE,
U. S. District Judge.

And afterwards, to wit, on the 25th day of Nov., A. D. 1884, the following declaration was filed in the clerk's office of the court aforesaid in words and figures following, to wit:

Declaration.

C. C. of the U. S. for the Southern District of Ohio, Eastern Division

JOHN MCGREGOR ADAMS
vs.
THE BELLAIRE STAMPING COMPANY *et al.*

On the 25th day of Nov., A. D. 1884, as yet of the term, A. D. 1884.

THE SOUTHERN DISTRICT OF OHIO, *ss:*

John McGregor Adams, a citizen of the State of Ill., pl't'f in this suit, by E. E. Wood and Edward Boyd his attorneys, com-
24 plains of The Bellaire Stamping Company, a corporation organized under the laws of the State of Ohio, citizen of said State, having their principal place of business in the city of Bellaire, in said State, and of J. T. Mercer and of C. H. Tallman, citizens of said State of Ohio, residents of said city of Bellaire, in said State, defendants in this suit, who have been summoned to answer the plaintiff in an action of trespass on the case; for that whereas heretofore and before the 24th day of Oct., A. D. 1865, and before and at the time of the making of the letters patent and before the committing of the several grievances hereinafter mentioned, one John H. Irwin, being then a citizen of the United States and a resident of the city of Chicago, in the State of Illinois, was the first, true, and original inventor or discoverer of a new and useful improvement in lanterns, which said invention was not known or used by others before such invention or discovery thereof as aforesaid and had not at the time of the application for letters patent therefor, as hereinafter mentioned, been for more than two years in public use or on sale; and the said John H. Irwin thereupon afterwards made due application in writing, in accordance with the statutes in such case made and provided, to the Commissioner of Patents for the United States for the granting of letters patent upon said invention and discovery to him, and such proceedings according to law were had that thereafter, to wit, on the said 24th day of Oct., A. D. 1865, letters patent for said in-

vention and discovery bearing date on that day and numbered 50591 were issued in the name of the United States of America, under the seal of the United States Patent Office, signed by the Secre-
25 tary of the Interior and countersigned by the Commissioner of Patents, and were delivered to the said John H. Irwin, whereby there was granted to him, his heirs, executors, administrators, and assigns, for the term of 17 years from and after said 24th day of Oct., A. D. 1865, the full and exclusive right and liberty of making, of constructing, of using, and of vending to others to be used the invention and discovery aforesaid throughout the United States and the Territories thereof, as by reference to the specification, claims, and drawings of the said letters latent or a duly authenticated copy thereof will, among other things, more fully and at large appear.

And plaintiff saith that, to wit, on the 6th day of Oct., A. D. 1866, the said John H. Irwin, by an assignment — was entered of record in the Patent Office for the United States, to wit, Oct. 9th, A. D. 1866, sold, assigned, transferred, and set over to the Chicago Manufacturing Company (a corporation organized under and pursuant to the laws of the State of Illinois) and to its successors and assigns all his right, title, and interest in and to the said letters patent for the full end of the term for which the said patent was granted, and that, to wit, Jan'y 1st, A. D. 1873, the said Chicago Manufacturing Company, by an assignment, duly signed and delivered for a good and valuable consideration, which said assignment was entered of record in the Patent Office for the United States, to wit, May 24, A. D. 1873, sold, assigned, transferred, and set over to one Charles B. Sawyer, his heirs, assigns, and legal representatives, an undivided one-half of all the right, title, and interest of said company in and to the said letters patent during the full term for which they were
26 granted, and that, to wit, Oct. 3rd, A. D. 1874, by an assignment, duly signed and delivered for a good and valuable consideration, which said assignment was entered of record in the Patent Office for the United States, to wit, June 18, A. D. 1877, the said Charles B. Sawyer sold, assigned, transferred, and set over to this plaintiff all his right, title, and interest in said letters patent, and also all claims and demands which he, the said Charles B. Sawyer, had against any corporation, firm, or person on account of infringements of said letters patent theretofore committed, and, to wit, March 10th, A. D. 1881, by an assignment, duly signed and delivered for a good and valuable consideration, which said assignment was entered of record in the Patent Office for the United States, to wit, March 31st, A. D. 1881, the said Chicago Manufacturing Company sold, assigned, transferred, and set over to this plaintiff all its right, title, and interest in and to the aforesaid letters patent and all rights and claims of the said company against any party or parties, firms, or corporations on account of the infringement of the aforesaid letters patent, together with full authority to collect the same, either in his own name or in the name of the aforesaid company, for his own use, as by said assignments respectively or by duly authenticated copies thereof will, amongst other things, more fully and at large appear, whereby and by virtue of the premises this

plaintiff acquired all the right, title, and interest in and to said letters patent and the inventions and discovery — any and all damages which may have accrued by reason of any infringement of said letters patent or of the rights therein secured heretofore committed during the term or period commencing with the said 6th day of Oct., A. D. 1866, and ending with the date of the expiration of the said letters patent, to wit, the 24th day of Oct., A. D. 1882.

27 And plaintiff further says that the invention or discovery so patented as aforesaid is and was during the said term for which it was granted of very great utility, and that the same was during the said term extensively introduced into public use, and that the public then generally acquiesced in his, plaintiff's, exclusive right to the same as aforesaid, and so it is that a large number of manufacturers and dealers also during the life of said letters patent did acquiesce in the validity thereof and in this plaintiff's exclusive title and right thereto and did purchase licenses to make, to cause to be made, and to sell lanterns involving the said invention from this plaintiff, and that said manufacturers and supply agents contracted to pay and did pay to this plaintiff, as a fair and reasonable license fee for such license right, the sum of fifty (50) cents per dozen of lanterns made and sold and involving the said invention, and but for the wrongful acts of the said defendants the plaintiff would have made large gains, profits, and advantages from the manufacture, use, and sale of said invention, and that by the said wrongful acts and doings he was prevented and hindered from so doing.

And plaintiff further says that heretofore, in the United States circuit court for the northern district of Illinois, to wit, on the 26th day of Nov., A. D. 1879, in a cause therein pending, in which the said John McGregor Adams was plaintiff and the Illinois Manufacturing Company was defendant, in which cause copies of the following letters patent of the United States and of Great Britain, as exhibiting the prior state of the art and as limiting if not de-

28 feating the said letters patent here sued on, were introduced in evidence on behalf of the defendant and were fully considered by the court, to wit:

United States letters patent—
No. 3747, granted Nov. 23, 1869, to W. Westlake.
No. 11632, granted Aug. 29, 1854, to P. A. Morley.
" 27924, " Apr. 17, 1860, " "
No. 13286, granted July 17, 1855, to G. Waters.
No. 13539, granted Sept. 11, 1855, to C. H. Butterfield.
No. 14006, granted Dec. 25, 1855, to C. H. Butterfield.
No. 21209, granted Aug. 17, 1858, to Max Miller.
No. 48839, granted May 24, 1864, to G. F. J. Colburn.

And English patent—
No. 2512, granted to Isaac Evans Apr. 8, 1861, and
No. 3557, granted to G. Chappell Apr. 28, 1812.

The said letters patent No. 50591 were adjudged to be good and valid and that the said John H. Irwin was the first and original inventor of the said improvements therein described and claimed, and that the said John McGregor Adams, by virtue of assignments duly made, acquired the entire right, title, and interest in and to the said invention and letters patent, as hereinbefore alleged and claimed; and that in the United States circuit court for the southern district of New York heretofore, to wit, on the 6th day of Feb., A. D. 1884, in a cause therein pending, in which the said John McGregor Adams was a plaintiff and one John R. Howard and others were defendants, in which cause copies of the following English letters patent, as exhibiting the prior state of the art and as limiting if not defeating the said letters patent here sued on, were introduced in evidence on behalf of the defendants and were fully considered by the court, to wit:

No. 1194, granted in 1857 to K. L. Sutherland.
No. 9148, granted in 1841 to John Burnell.
No. 207, granted in 1856 to A. J. Dessales.
29 No. 386, granted in 1858 to A. F. T. Mosley.
" 737, granted in 1864 to John Strafford.
No. 1158, granted in 1864 to James Wavish.

A similar decree was entered by order of the court adjudging the said letters patent No. 50591 to be valid and the said title of the said Adams, subject to certain licenses theretofore granted by him, to be as hereinabove alleged.

And plaintiff further says that the said defendants and each of them, well knowing the premises and the rights and privileges secured unto the said plaintiff, and in order to deprive him of his profits, damages, benefits, and advantages, and to interfere with his said exclusive rights which otherwise would have accrued to him, at the southern district of Ohio and elsewhere, and without the license or permission of the said plaintiff and without any right, title, or license under the said letters patent, the said defendants, contriving to injure the plaintiff, have at divers and sundry times since the said 6th day of Oct., A. D. 1866, and within the said term of years in the said letters patent mentioned and before the commencement of this suit and, to wit, on the 21st day of March, A. D. 1882, and on divers and sundry days, both between and since said dates herein last mentioned, made, caused to be made, sold, and used a large number of lanterns, each and all containing the said invention, discovery, improvements, and combinations in said letters patent described and claimed, the exclusive right to which was secured to this said plaintiff as hereinabove set forth, and which said unlawful making, use, and sale by the defendants as aforesaid was in violation and infringement of the said plaintiff — by said
30 letters patent as aforesaid, contrary to the form of the statute of the United States in such case made and provided, and that the said J. T. Mercer and C. H. Tallman, defendants as aforesaid, well knowing the premises and being often warned and cau-

tioned not to so to do, did each of them personally and knowingly participate in and direct the said infaingement hereinbefore complained of, have participated in the profits so wrongfully derived therefrom, whereby the defendants have jointly and severally derived and received from such manufacture and sales and use great gains and profits, to wit, the sum of sixty-two thousand and five hundred dollars.

And the plaintiff further says that by force of the statute aforesaid an action has accrued to him to recover his actual damages in the premises and such additional amount, not exceeding — the whole three times the amount of such actual damages as the court may see fit to order and adjudge, beside costs; yet the defendants and each of them, though requested, have never paid the same or any part thereof to the plaintiff, but have refused and yet refuse so to do, and therefore the plaintiff brings this suit.

WOOD & BOYD,
Att'ys for Plaintiff.

J. H. RAYMOND,
Honore Buildings, Chicago, Ill., of Counsel.

And afterwards, to wit, on the 22d day of December, A. D. 1884, the following demurrers were filed in the clerk's office of the court aforesaid, clothed in the words and figures following, to wit:

Demurrers.

Circuit Court of the United States for the Eastern Division, Southern District of Ohio.

31 JOHN MCGREGOR ADAMS *vs.* THE BELLAIRE STAMPING CO. *et al.* } Case.

The said defendants, by George W. Dyer, their attorney, come and defend the wrong or injury when, etc., and say that the said declaration in this cause exhibited and the matters and things therein contained, in manner and form as the same are stated and set forth, are not sufficient in law for the said plaintiff to have or maintain his aforesaid action thereof against the defendants, and that they, the defendants, are not bound by law to answer to same.

And this they are ready to verify; wherefore, by reason of the insufficiency of the said declaration in this behalf, the said defendants pray judgment, and that the said plaintiff may be barred from having or maintaining his aforesaid action thereof against them, etc.

GEO. W. DYER,
Defendants' Attorney.

Circuit Court of the United States for the Eastern Division, Southern District of Ohio.

JOHN MCGREGOR ADAMS
vs.
BELLAIRE STAMPING COMPANY *et al.* } Case.

The said defendants, by Geo. W. Dyer, their attorney, come and defend the wrong or injury when, etc., and say that the said declaration in this cause exhibited and the matters and things therein contained, in manner and form as the same are —, not sufficient in law for the said plaintiff to have or maintain his aforesaid action thereof against the defendants, and that they, the defendants, are not bound by law to answer to same.

32 And they are ready to verify; wherefore, by reason of the insufficiency of the said declaration in this behalf, the said defendants pray judgment, and that the said plaintiff may be barred from having or maintaining his aforesaid action therefor against them, etc.

And the said defendants state and show to the court here the following causes of demurrer to the said declaration—that is to say:

First. That the declaration does not set out the proper parties plaintiff, it appearing from said declaration *from said declaration* that one Charles B. Sawyer should have been joined as plaintiff in this suit.

Second. That the declaration does not set out the proper parties plaintiff, it appearing from said declaration that the Chicago Manufacturing Company should have been joined as a plaintiff in this suit.

Third. The allegation in said declaration as to the acquiescing of the public generally in said Adams, exclusive title and right to the invention described in said letters patent numbered 50591 during the life of said patent, viz., from Oct. 25, 1865, to Oct. 25, 1882, and as to the acts of acquiescence alleged, is superfluous and not essential to the maintenance of this suit, misleading, and inconsistent with other allegations in said declaration, that the defendants in this suit have acquiesced in said Adams' exclusive title and right to the invention described in said letters patent, and it appearing from said declaration that said Adams does not allege that he had the exclusive title to said invention described in said letters patent until March 10, 1881, and also appearing from said declaration that said Adams does — allege any right to infringe earlier in date than Oct. 6, 1886.

33 Fourth. The allegation in said declaration of the proceedings in the United States circuit court for the northern district of Illinois on the 26th day of Nov., 1879, between the said Adams and the Illinois Manufacturing Co. is superfluous and not essential for the maintenance of this suit, misleading, and inconsistent with other allegations in said declaration, it appearing from said declaration that said cause was against parties defendant other and different from the parties defendant in this suit here pending, and that the said cause was a proceeding in equity and not at law, as in

this suit here pending, and it appearing from said declaration that the said Adams did not have, as alleged, "all the right, title, and interest in and to said letters patent and the invention or discovery therein described and claimed" on Nov. 26, 1879, nor until March 10, 1881.

Fifth. The allegation in said declaration of the proceedings in the United States circuit court for the southern district of New York in the cause between the said Adams and John P. Howard and others, on the 6th day of Feb., A. D. 1884, is superfluous and not essential for the maintenance of this suit, misleading, and inconsistent with other allegations in said declaration, it appearing from said declaration that said cause was against parties defendant other and different from the parties defendant in this suit here pending, and that said cause was a proceeding in equity and not at law, as in the suit here pending, and — not appearing from said declaration when said proceedings in equity *was* commenced or at what date the said Adams was adjudged to have title to said letters patent and the discovery or invention therein described and claimed, or whether said title was complete in said Adams before or after
34 Oct. 25, 1882, when said letters patent expired, or whether the same was complete in said Adams, — alleged, on Nov. 26, 1879, the date when the United States circuit court for the northern district of Illinois adjudged that the said Adams had "all the right, title, and interest in and to said letters patent and to the invention and discovery therein described and claimed," or was so complete on March 10, 1881, the date, as also alleged by said Adams, when he acquired all the right, title, and interest in and to said letters patent and to the invention and discovery therein described and claimed.

Wherefore said defendants pray judgment, and that the said plaintiff may be barred from having or maintaining his aforesaid action thereof against them, etc.

GEO. Q. DYER,
Def'ts' Att'y.

And afterwards, to wit, on the 17th day of Oct., A. D. 1885, an entry was made upon the journal of said court, clothed in the words and figures following, to wit:

A, 439.

This cause being heard on the demurrer of the defendants to the declaration of the complainant, the court, on consideration, overrules the same, with leave to the defendants to plead within thirty (30) days.

35 And afterwards, to wit, on the 16th day of Nov., A. D. 1885, the following plea was filed in the clerk's office of the court aforesaid, clothed in the words and figures following, to wit:

Plea.

United States Circuit Court, Southern District of Ohio, Eastern Division.

JOHN McGREGOR ADAMS
vs.
THE BELLAIRE STAMPING COMPANY *et al.* } At Law.

And now the said Bellaire Stamping Company, John T. Mercer, and Charles H. Tallman, the above-named defendants in this suit, by Geo. W. Dyer, their attorney, come and defend the wrong and injury when, &c., and say that they are not guilty of the said supposed trespasses in manner and form as alleged — plaintiff's declaration or any part thereof; and of this the said defendants put themselves upon the country.

GEO. W. DYER,
Att'y for Def'ts.

And, as provided by the statute in such case made and provided, the defendants give notice that they will prove upon the trial of this cause the following special matters, viz:

1. That the said patentee, John H. Irwin, surreptitiously and unjustly obtained his said patent No. 50591 for that which was in fact invented by another, to wit, Anthony M. Duburn, then of Chicago, in the State of Ill., lately residing at No. 138 North Curtis street, in said Chicago, who was at the time when said Irwin obtained his said patent using reasonable diligence in adapting and perfecting the same invention.

2. That the said supposed invention of said Irwin de-
36 scribed in his said patent No. 50591 had been patented or described in printed publications or patents prior to his supposed invention or discovery, viz:

In United States patent No. 11632, granted to P. A. Moreley Aug. 29, 1854.

In U. S. patent No. 21209, granted to Max Miller Aug. 17, 1858.

In U. S. patent No. 47551, granted to J. H. Irwin May 2, 1865.

In English patent No. 1194, of 1857, granted to K. L. Sutherland.

3. That the said John H. Irwin was not the original or first inventor or discoverer of any material and substantial part of the thing patented in said patent No. 50591, but that all the material and substantial parts of the thing patented in said patent No. 50591 had been invented or discovered by said Morley, Miller, Irwin, Sutherland, and Duburn prior to his, said Irwin's, supposed invention or discovery.

GEO. W. DYER,
Att'y for Def't's

And afterwards, to wit, on the 18th day of Nov., A. D. 1885, the following special plea was filed in the clerk's office of the court aforesaid, clothed in the words and figures following, to wit:

Special Plea.

United States Circuit Court, Southern District of Ohio, Eastern Division.

JOHN MCGREGOR ADAMS
vs.
THE BELLAIRE STAMPING COMPANY *et al.* } At law.

37 And now The Bellaire Stamping Company, John T. Mercer, and Charles H. Tallman, the above-named defendants in this suit, by Geo. W. Dyer, their attorney, come and defend, &c., and for plea say that the plaintiff ought not to have or maintain his said action, because they say—

1. That the supposed invention of the said John H. Irwin described and claimed in said patent No. 50591, here in suit, did not, in view of the state of the art, require the exercise of the inventive faculty, but only mechanical skill and good judgment; wherefore said patent was never valid, and the plaintiff has no right of action upon the same.

2. That the supposed invention of the said John H. Irwin described and claimed in said patent No. 50591, here in suit, is not for a patentable combination of parts, but is for an aggregation of old and well-known parts, each of which performs only its old and well-known function, unchanged by the combination; wherefore said patent was never valid, and the plaintiff has no right of action upon the same.

3. That when the said Irwin filed the application upon which said patent No. 50591 was granted there was pending in the Patent Office another application for the same invention, in the name of Anthony M. Duburn, upon which application a patent, No. 58392, was, on Oct. 2, 1866, granted to said Duburn, and the Commissioner of Patents granted the said patent No. 50591 to said Irwin without an interference with the application of said Duburn, in violation of the statute in such case made and provided; wherefore said patent No. 50591 was never valid, and the plaintiff has no right of action upon the same.

4. That the said plaintiff had no sufficient title in law to
38 said patent No. 50591 at the date of the commencement of this suit to enable him to bring said suit and theretofore had no right of action upon said patent.

C. H. GROSVENER AND
GEO. W. DYER,
Att'ys for Defendants, 519 7th Street, Washington, D. C.

And afterwards, to wit, on the 18th day of Nov., A. D. 1885, the following plea in bar was filed in the clerk's office of the court aforesaid, clothed in the words and figures following, to wit:

United States Circuit Court, Southern District of Ohio, Eastern Division.

JOHN MCGREGOR ADAMS
vs.
THE BELLAIRE STAMPING CO. *et al.* } At Law.

Plea in Bar.

And the said Bellaire Stamping Company and John T. Mercer and Charles H. Tallman, defendants in this suit, by one Geo. W. Dyer, their attorney, come and defend, &c., and for plea say that the plaintiff ought not to have or maintain his aforesaid action thereof against the said defendants if the same is for infringements by the defendants of the plaintiff's exclusive rights under patent No. 50591 between Oct. 6, 1866, and July 3, 1870, because they say that a right of action for the same between the dates mentioned is not authorized by the statutes of the United States and is barred by the statute of limitations of the State of Ohio.

C. H. GROSNENOR,
GEO. W. DYER,
Def'ts' Att'ys.

39 And the said Bellaire Stamping Company and John T. Mercer and Charles H. Tallman, defendants in this suit, by Geo. W. Dyer, their attorney, come and defend, &c., and for plea say that the plaintiff ought not to have or maintain his aforesaid action thereof against the said defendants if the same is for infringements by the defendants of the plaintiff's exclusive rights under patent No. 50591, between July 8, 1870, and June 22, 1874, because they say that the right of action for the same between the dates mentioned is barred by the statutes of limitations of the State of Ohio.

C. H. GROSEVNOR,
GEO. W. DYER,
Def'ts' Att'ys.

And the said Bellaire Stamping Company and John T. Mercer and Charles H. Tallman, defendants in this suit, by Geo. W. Dyer, their attorney, come and defend, &c., and for plea say that the plaintiff ought not to have or maintain his aforesaid action thereof against the said defendants if the same is for infringements by the defendants of the plaintiff's exclusive rights under patent No. 50591, between June 22, 1874, and Nov. 25, 1880, because they say that the right of action for the same between the dates mentioned is not authorized by the statutes of the United States and is barred by the statutes of limitations of the State of Ohio.

C. H. GROSEVENOR,
GEO. W. DYER,
Defendants' Attorneys.

40 And afterwards, to wit, on the 2 day of June, A. D. 1886, an entry was made upon the journal of the court aforesaid, clothed in the words and figures following, to wit:

Journal A, p. 509.

This day came the parties, by their attorneys, and thereupon, to try the issues joined, a jury, being called, came, to wit, John Biggert, Moses F. Dickey, John S. Ellis, Rob't Fulton, Henry Haskins, J. J. Miller, Joseph Peterson, Terris Painter, William H. Robb, Benjamin L. Reece, George E. Roberts, and Cyrus Leeds, Jr.; who were duly empaneled and sworn well and truly to try the issues joined between the parties; but, the testimony not being finished, the court respited the jury until to-morrow morning at ten o'clock, to which time this cause is continued.

And afterwards, to wit, on the 3 day of June, A. D. 1886, an entry was made upon the journal of the court aforesaid, clothed in the words and figures following, to wit:

A, p. 511.

And now comes the plaintiff, by *its* attorney, and, by leave of court first had and obtained, moves to annul his declaration as follows, to wit:

First. By striking out of the 2d paragraph thereof *the* beginning on page 3 thereof the following words, to wit: "A corporation or-
41 ganized under and pursuant to the laws of the State of Illinois."

Second. By striking out of said paragraph on said page the words, to wit, Oct. 30th, A. D. 1875, and substituting therefor the words, to wit, Oct. 3rd, A. D. 1874.

And afterwards, to wit, on the 3d day of June, A. D. 1886, an entry was made upon the journal of said court, clothed in the words and figures following, to wit:

A, p. 512.

This cause came on to be heard on the second day of June, A. D. 1886, and before the jury was empaneled and sworn herein upon the demurrer of the plaintiff to the defendants' plea of the statute of limitations filed herein, which being argued by counsel, the court, being fully advised in the premises, doth sustain the same.

And afterwards, to wit, on the same day, to wit, an entry was made upon the journal of said court, clothed in the words and figures following, to wit:

A, p. 512.

This day again came the parties, by their attorneys, and the jury heretofore empaneled and sworn herein; but, the testimony not being finished, the court respited the jury until to-morrow morning at 10 o'clock, until which time this cause is continued.

And afterwards, to wit, on the 4th day of June, A. D. 1886, an entry was made upon the journal of the said court, clothed in the words and figures following, to wit:

A, p. 518.

42 This day again came the parties, by their attorneys, and it appearing that Cyrus Leeds, Sr., one of the jurors, is unable, by reason of serious illness in his family, further to attend this trial, and the remaining eleven jurors heretofore empaneled and sworn herein now coming, the trial, by consent of both parties, proceeded with the eleven remaining jurors; but, the testimony not being finished, the court respited the jury until ten o'clock to-morrow morning, to which time this cause is continued.

And afterwards, to wit, on the 5th day of June, A. D. 1886, an entry was made upon the journal of the said court, clothed in the words and figures following, to wit:

A, p. 520.

This day again came the parties, by their attorneys, and the jury heretofore empaneled and sworn herein; but, the testimony not being finished, the court respited the jury until next Monday morning at ten o'clock, until which time this cause is continued.

And afterwards, to wit, on the 7th day of June, A. D. 1886, an entry was made upon the journal of the said court, clothed in the words and figures following, to wit:

A, p. 522.

This day again came the parties, by their attorneys; also the jury heretofore empaneled and sworn herein; but, the testimony not being finished, the court respited the jury until to-morrow morning at nine o'clock, to which time this cause is continued.

43 And afterwards, to wit, on the 8th day of June, A. D. 1886, an entry was made upon the journal of the court aforesaid, clothed in the words and figures following, to wit:

A, p. 526.

This day came again the parties, by their attorneys; also the jury heretofore empaneled and sworn herein; and, having heard the evidence, the arguments of counsel, and the hour of adjournment arrived, the court respited the jury until to-morrow morning at nine o'clock, to which time this cause is continued.

And afterwards, to wit, on the 9th day of June, A. D. 1886, an entry was made upon the journal of the court aforesaid, clothed in the words and figures following, to wit:

A, p. 527.

This day again came the parties, by their counsel, and the jury heretofore empaneled and sworn herein; and the said jury, having heard the evidence, the arguments of counsel; and the charge of the court, under oath returned the following verdict as answers to interrogatories submitted to them as follows, to wit:

4'

uestions Submitted by the Court, with the Consent of all the Counsel in the Case, to be Answered by the Jury in Writing.

1. Does the Irwin patent, No. 50591, dated Oct. 24th, 1865, here in suit, disclose an improvement which required invention, as distinguished from mere mechanical skill or judgment, at the date of said alleged invention?

Answer. No invention.

2. Had the invention claimed in the Irwin patent, No. 50591, dated Oct. 24, 1865, been patented or described in any printed publication prior to Irwin's supposed discovery or invention thereof?

44 Answer. Yes.

3. Was Irwin the original and first inventor or discoverer of any material and substantial part of the thing patented in plaintiff's patent, No. 50591, dated Oct. 24, 1865?

Answer. No.

4. Have the defendants infringed the plaintiff's patent, No. 50591, dated Oct. 24, 1865?

Answer. No.

5. Does the evidence show an established license fee or royalty for the use of the plaintiff's patent, No. 50591, now in suit; if so, during what period and at what rate?

Answer. No.

Whereupon plaintiff's counsel filed a motion for a new trial.

And afterwards, to wit, on the 9th day of June, A. D. 1886, the following motion was filed in the clerk's office of the court aforesaid, clothed in the words and figures following, to wit:

Motion.

United States Circuit Court, Southern District of Ohio, Eastern Division.

J. McGregor Adams
vs.
Bellaire Stamping Company *et al.*
} Case 173. Motion for New Trial.

45 And now comes the plaintiff and moves the court to set aside and vacate the verdict heretofore entered against the plaintiff herein, to wit, on the 9th day of June, A. D. 1886, and grant a new trial herein on the following grounds, to wit:

1. Irregularity in proceedings of the court.

2. Misconduct of the defendant.

3. For that the defendant introduced matters and evidence which by permission of the court were considered by the jury, the prescribed statutory notice of which had not been given.

4. Surprise, which ordinary prudence could not have guarded against.

5. That the verdict is not sustained by sufficient evidence.
6. That the verdict is contrary to the evidence.
7. That the verdict is contrary to the weight of the evidence.
8. That the verdict is contrary to law.
9. Errors of law occurring at the trial and excepted to by plaintiff.
10. Error of the court in its charge to the jury.
11. Error of the court in refusing instructions asked by the plaintiff.
12. Error of the court in not permitting this plaintiff to introduce certain testimony offered in evidence at the trial.
13. Error of the court in its ruling on questions of law during the progress of the trial.

RAYMOND & RAINEY,
For Plaintiff.

Dated June 9th, 1886.

46 And it is agreed that the hearing of said motion is postponed without prejudice, to be called up and to be determined on reasonable notice by either party to the other.

RAYMOND & RAINEY,
For Plaintiff.

GEO. W. DYER,
For Defendants.

Columbus, Ohio, June 9, 1886.

And afterwards, to wit, on the 9th day of June, A. D. 1886, the following stipulation was filed in the clerk's office of the court aforesaid, clothed in the words and figures following, to wit:

Stipulation.

Stipulation of facts as to damages.

Defendants made and sold prior to June 19, 1880—

Lanterns	$27,922\frac{10}{12}$	dozen
Frames	$31,595\frac{5}{12}$	"
Total	$59,518\frac{3}{12}$	

Between June 19, 1880, Oct. 1st, 1882—

Lanterns	$2,445\frac{8}{12}$	
Frames	$30,199\frac{2}{12}$	
Total	$32,644\frac{10}{12}$	
First total	$59,518\frac{3}{12}$	
Second "	$32,644\frac{10}{12}$	
Grand total	$92,163\frac{1}{12}$	

47 Agreed to June 8th, 1886.

RAYMOND & RAINEY,
For Plaintiff.
GEO. W. DYER,
For Defendants.

Lanterns complete from Oct. 6, 1886, to July 8, 1870, none.
Lanterns complete from July 8, 1870, to June 22, 1874, 10,938¾ dozen.
Lanterns complete from June 22, 1874, to June 19, 1880, 17,402½ dozen.
Agreed to June 8, 1886.

GEO. W. DYER,
For Defendants.
RAYMOND & RAINEY.

And afterwards, to wit, on the 16th day of June, A. D. 1887, an entry was made upon the journal of the court aforesaid, clothed in the words and figures following, to wit:

B., p. 87.

This cause came on to be further heard at this term upon the motion of the plaintiff for a new trial, and was argued by counsel; and thereupon, upon consideration thereof, it was ordered that said motion be, and the same hereby is, overruled, and judgment is hereby awarded in favor of the defendants and against the plaintiff for their costs in this behalf expended, taxed at $——, and execution is awarded therefor.

And afterwards, to wit, on the 1st day of December, A. D. 1887, an entry was made upon the journal of the court aforesaid, clothed in the words and figures following, to wit:

O. B., 93.

48 On motion of the plaintiff, it is ordered that he be allowed until January 15, 1888, in which to file and present his bill of exceptions in this case.
December 1st, 1887.

And afterwards, to wit, on the 23d day of December, A. D. 1887, the following protested objections to bill of exceptions was filed in the clerk's office of the court aforesaid, clothed in the words and figures following, to wit:

Protested Objections to Bill of Exceptions.

Circuit Court of the United States for the Southern District of Ohio, Eastern Division.

J. McGregor Adams
vs.
Bellaire Stamping Co. *et al.*

To Mr. George W. Dyer, solicitor for defendants.

Dear Sir: You will please take notice that on Friday next, December 23, 1887, at ten o'clock a. m., or as soon thereafter as the same can be considered, I shall present to the court at Cincinnati, Ohio, the bill of exceptions in the above-entitled cause, a copy of which is herewith handed to you, to be then and there signed and sealed.

You are invited to be present.

Respectfully, etc.,

J. H. RAYMOND,
Solicitor for Plaintiff.

Chicago, December 17, 1887.

49 Circuit Court of the United States, Southern District of Ohio, Eastern Division.

J. McGregor Adams
vs.
The Bellaire Stamping Company, J. T. Mercer, and C. H. Tallman. } At Law.

And now come the defendants in the above-entitled suit, by Geo. W. Dyer, their attorney, in pursuance of the notice heretofore appended, and ask leave to file in opposition to the allowance of the plaintiff's bill of exceptions the following protest and objections:

The defendants, alleging that the final judgment of this honorable court in the above-entitled suit was made and entered upon a certain day in Sept., 1887, and a writ of error to the Supreme Court of the United States was issued, returnable on the second Monday of Oct., 1887, as appears of record in this honorable court, protest and object against the allowance of any bill of exceptions in said suit at this date as made without authority of law upon the part of this honorable court, and likewise protest and object against the allowance of any bill of exceptions in said suit at this date as of an earlier date as not justified by the conduct of the parties to said suit or authorized by law.

The defendants, not waiving the above protest and objections, and reserving the right to move in the Supreme Court of
50 the United States for the dismissal of said bill of exceptions should the same be allowed and filed, further object to the same generally upon the ground that it does not state distinctly the

several matters of law excepted to and so much only of the evidence as applies to said exceptions, especially because—

a. The license, marked "Exhibit Adams License," put in evidence after answer 20 of Adams' deposition has been omitted.

b. In the reference to the testimony of David J. Powers it should appear that the same was taken in a suit against other defendants, and was introduced principally in support of the Irwin patent in suit, and the testimony quoted was directed to that point.

c. It does not appear that the testimony quoted in connection with the introduction of the Irwin patent, No. 47551, granted May 2, 1865, was read or referred to or put in evidence or attention invited to it.

d. The copy of the charge of the court to the jury is incorrectly quoted, and does not agree with that placed by Judge Jackson on file in this court.

GEO. W. DYER,
Att'y for Defendants.

51 And afterwards, to wit, on the 31st day of December, A. D. 1887, the following bill of exceptions was filed in the clerk's office of the court aforesaid, in the words and figures clothed as follows, to wit:

Circuit Court of the United States, Southern District of Ohio, Western Division.

J. McGREGOR ADAMS
vs.
BELLAIRE STAMPING CO., J. T. MERCER, and C. H. TALLMAN.

Bill of Exceptions.

Be it remembered that on the 2nd day of June, A. D. 1886, at a session of said court held in the city of Columbus, in the State of Ohio, before the Honorable Howell E. Jackson, circuit judge, and the Honorable George R. Sage, district judge, holding the said circuit court, the issue joined between the parties in this cause came on to be tried before a jury.

The following stipulation of the parties to this cause was presented and filed:

Stipulation.

It is stipulated and agreed by and between the parties hereto as follows:

52 1. That at the trial of these cases each party may use Patent Office printed copies of all patents which it is desired to offer in evidence to the same effect as though the same were certified copies.

2. That the complainant, in making out his title to the patent sued on herein, No. 50591, granted October 24, 1865, to J. H. Irwin,

may offer in evidence without other certification and to the same effect as if certified the printed copies of the chain of title as shown from pages 142 to 184, inclusive, so far as the same is competent and pertinent, of the printed record of a suit determined in the United States court for the southern district of the State of New York, in equity, wherein J. McGregor Adams and Robert E. Deitz were complainants and John W. Howard and David R. Morse were defendants, hereinafter referred to, and as to any other transfer or assignment of said patent necessary to make up the chain of title in the plaintiff herein certified copies from the Patent Office may be offered in evidence in lieu of the originals, so far as the same is competent and pertinent.

3. That on or before the 26th day of Nov., 1879, the plaintiff in these suits, J. McGregor Adams, brought a suit in equity in the United States circuit court for the northern district of Illinois against the Illinois Manufacturing Company for the infringement of letters patent No. 47551 and No. 50591; that in said cause the title of complainant was not questioned, and the infringement of No. 50591 was not denied, and there was a defense of the want of novelty of the said patent No. 50591 interposed, and to sustain which the
53 defendant set up in its answer and the court considered letters patent to P. A. Morley, to William Westlake, to Max Miller, to Charles Waters, to C. H. Butterfield, to G. F. J. Colburn, and the British patents to Isaac Evans, to Graham Chappelle, all for improvements in lanterns.

That in said cause proofs were taken, copies of said letters patent interposed in evidence, and on final hearing a decree was entered sustaining the validity of said patent No. 50591, notwithstanding such defenses.

4. That on or before the 6th day of Feb., 1884, in a cause then pending in the United States circuit court for the southern district of New York, on the equity side thereof, wherein J. McGregor Adams (the plaintiff herein) and Robert E. Deitz were complainants and John Howard and D. R. Morse were defendants, said cause being for infringement of letters patent No. 50591, a decree was entered sustaining the validity of said letters patent No. 50591; that in said cause, among other defenses interposed, the defendants set up the invalidity of said letters patent No. 50591 by reason of prior letters patent, as follows:

English patent No. 1194, of 1857, to K. L. Southerland. Another defense was set up in said cause that the said Irwin was not the prior inventor of the invention set forth in the patent sued on, as appeared from his application filed March 6, 1865, and afterwards patented Oct. 2, 1866.

5. That either party shall be at liberty to use at the trial of said causes any part of the printed record of said two cases of
54 Adams against The Illinois Manufacturing Company and Adams against Howard and others, above set forth, wherein the same shall be pertinent and relative to any issues herein to the same extent and to the same effect as though said records were duly certified.

That the decision of the judges deciding said causes, as reported in the Official Gazettes or any other printed report of patent decisions, shall be used to the same effect as though the same were certified.

6. It is further stipulated and agreed that should the plaintiff desire to take testimony of either of the parties defendant herein or either of their employés he shall give the defendants' counsel not less than seven days' notice of his intention to take such testimony, the same to be taken at Bellaire, in the State of Ohio, and before any notary public.

February 2, 1886.

RAYMOND & RAINEY,
Attorneys for Plaintiff.
GEO. W. DYER,
Attorney for Defendants.

And thereupon the plaintiff, in order to maintain and prove the issues on his part, introduced evidence, of which the following is pertinent to this bill of exceptions:

First. A copy of letters patent of the United States No. 50591, issued Oct. 24, 1865, to John H. Irwin, a copy of which is hereto attached and forms Exhibit "A."

55 Second. An assignment from said John H. Irwin and one Griffin to the Chicago Manufacturing Company, dated Oct. 6, 1866, of which a copy is hereto attached and marked Exhibit B.

Whereupon counsel for defendants objected to the said last-named evidence without stating any grounds for said objection, but the same was admitted subject to exception.

Thereupon the court, on motion, allowed the plaintiff to file a demurrer to the plea heretofore filed herein with reference to the statute of limitations as interposed by the defendants, and the demurrer was sustained, the defendants, by counsel, then and there excepting to the said ruling of the court.

And thereupon, to further maintain and prove the issues on his part, the plaintiff introduced and read the depositions of J. T. Mercer and C. H. Tallman, who testified to the existence of the defendant corporation, and that said Mercer was president thereof and said Tallman was secretary and treasurer thereof, and identifying certain lanterns introduced in evidence and marked "Bellaire Stamping Co.'s Lanterns Nos. 1, 2, 3, and 4" as being of the manufacture of the defendant corporation, which exhibits are hereby exhibits to this bill of exceptions.

And thereupon, to further maintain and prove the issues on the part of the plaintiff, the deposition of J. McGregor Adams, the plaintiff, was introduced and read to the jury as follows:

56 United States Circuit Court, Southern District of Ohio, Western Division.

J. McGregor Adams
vs.
Bellaire Stamping Company, J. T. Mercer, and C. H. Tallman.

Deposition taken on behalf of the complainant in the above-entitled cause at the office of Messrs. Raymond and Rainey, 44 Honor's building, Chicago, Ill., on this 13th day of April, 1886, by consent, all formalities being waived as to time and place of taking said deposition, before P. H. T. Mason, a notary public in and for the county of Cook, in the State of Illinois, who, for the purpose of taking this deposition, shall have all the powers of a duly appointed examiner of the court.

Present: W. G. Rainey, representing the plaintiff, and Mr. L. Hill, representing the defendants.

J. McGregor Adams, being first duly sworn, in answer to interrogatories propounded to him by W. G. Rainey deposes and says:

Q. 1. What is your name, age, residence, and occupation?

Ans. My name is J. McGregor Adams; age, 52; residence, Chicago, Ill.; occupation, merchant and manufacturer.

57 Q. 2. You are the complainant in this cause and the owner of the patent sued on?

Ans. I am.

Q. 3. State what knowledge you have had, if any, in the manufacture of lanterns.

Ans. I have been engaged in their manufacture since about 1860—of hand lanterns for the trade, and also made a specialty of lanterns for railroad uses.

Q. 4. Are you familiar with the lantern described and set forth in lantern patent No. 50591, sued on herein, issued Oct. 24, 1865, to J. H. Irwin?

Ans. I am.

Q. 5. Please state what you understand to be specific invention covered by this patent.

Ans. It consists of a lantern top secured to the guard of the lantern frame, whereby the lantern globe may be easily removed at the top, and when detached at one side makes a basket in which the lantern globe is held without being lost or falling out.

Q. 6. Are you familiar with the railroad lantern or lanterns for similar purposes prior to the date of the Irwin patent? If so, please describe what lanterns were in use prior to that time.

Ans. I am. Prior to the use of the Irwin patent on lanterns under this patent lanterns were made in a variety of forms. The principal amount were made by plastering the top and bottom of the globe to the top of the lantern and its bottom hoop, where they became one part. They were surrounded by their guards, also sol-

dered to the top and bottom, thus making the globe non-de-
58 tachable, except by breaking the plaster and unsoldering the guards. A second class of lanterns were made by cementing the top of and bottom of the lanterns on the globe with a removable guard. Another class were the lantern cemented to the bottom hoop and held in place by springs or lugs to the guards, permanently attached to the top flange of the lantern.

Q. 7. Please state, if you know, whether the lantern made under this Irwin patent became popular in the trade and superseded the prior lanterns you have described.

Ans. They did; and we ceased manufacturing lanterns under prior patents owned by us, at first taking a license under this Irwin patent and subsequently purchased the title, feeling it to be the only serviceable and practical lantern suited to our trade.

Q. 8. When you refer to "we" and "our" trade please designate what you mean.

Ans. I have been associated as boy, salesman, and partner with Clark & Jessup in 1856 and their successors M. K. Jessup & Co., Crerar, Adams & Co., and the Adams & Westlake Manufacturing Company since that date. These houses have made a specialty of railway material, where I became familiar with the wants of the trade prior to engaging in their manufacture, at about 1860. In the use of the pronoun "we" I refer to these various houses.

Q. 9. Since when have you owned this Irwin patent?

Ans. I acquired title to it some time in the fall of 1874.

59 Q. 10. What consideration did you pay for this Irwin patent?

Ans. I paid ten thousand dollars cash for this patent and for No. 47551, issued to Irwin May 2, 1865.

Q. 11. What was the value of patent No. 47551 as compared to No. 50591, the patent sued on?

Ans. The patent 47551 has no comparative value. It was impracticable, inoperative, and defeated the object we had in acquiring a lantern the parts of which could never become detached in giving signals or that the globe would drop out.

Q. 12. Please state in what manner you as the owner of the patent sued on, No. 50591, used or derived benefit therefrom.

Ans. I collected from many manufacturers past damages for the use of this patent, and I licensed them to continue its use.

Q. 13. Can you state how many manufacturers you licensed to make lanterns under this patent?

Ans. I licensed to some fourteen or fifteen manufacturers in the country; in fact, to all the manufacturers of lanterns that I know of with the exception of three—Messrs. William Porter & Son, New York; Howard & Morse, of New York, and the Bellaire Companies, whom I class as one, of Bellaire, Ohio. I now recall a concern at Wheeling, — Virginia, with whom I had some correspondence, but I do not think they took a license.

Q. 14. Can you give us the names of the parties at Bellaire, Ohio, whom you class as one in your above answer?

Ans. The name of the Barron Manufacturing Company,
60 the Buckeye Lantern Company, the Bellaire Stamping Company are all associated in my mind as one concern. I would also mention the Ohio Lantern Company of Bellaire, Ohio, as another party with whom I have had correspondence who did not take a license and whom I am now suing.

Q. 15. Did these several fourteen or fifteen manufacturers pay you a royalty under this patent; and, if so, what royalty?

Ans. They did, of fifty cents a dozen on all lanterns they made covered by this patent.

Q. 16. Can you state whether any part of the public besides these manufacturers recognized the validity of this patent; and, if so, what?

Ans. The public acquiesced in the validity of this patent. The Eastern and Western Railway Association, through their counsel, made an examination of the art and notified their correspondents, by circulars and letters, that it was not safe to buy lanterns manufactured in accordance with this patent except from parties holding license to manufacture them.

Answer objected to by Mr. Hill, so far as it relates to what the railroad associations said or did, on the ground that such matter is incompetent, irrelevant, and the evidence is secondary.

Q. 17. What do you understand the Eastern and Western Railroad Associations represent?

Same objection by Mr. Hill.

Ans. With a few exceptions the entire railway interests of the United States.

Q. 18. Can you state whether or not these railroad associa-
61 tions acquiesced in and recognized the validity of this patent?

Same objections by Mr. Hill, and further objected to because it does not appear that the alleged railroad associations were buyers, sellers, makers, or users of lanterns, and therefore what they may have done or not done is immaterial.

Ans. They did.

Q. 19. Do you know, and, if so, please state, whether or not the railroads generally throughout the United States purchased and used lanterns made under this Irwin patent?

Ans. I do know that to an almost universal extent they did use lanterns so constructed.

Q. 20. Have you any of the licenses granted *to* you to either of the manufacturers mentioned; and, if so, will you please produce the same? I mean licenses under patent 50591.

Ans. I have had with me copies of the uniform license granted to some of them, which I herewith produce.

Copy of a license granted Jan. 9, 1880, by J. McGregor Adams to M. M. Buck & Co., of St. Louis, Mo., is now offered in evidence as "Exhibit Adams License." (The same is so marked.)

Objected to by Mr. Hill as incompetent, irrelevant, and immaterial.

Q. 21. Do I understand you that all the licenses granted by you to the fourteen or fifteen manufacturers were identical, except as to the names and places of residence of the licensees, with the one granted to M. M. Buck & Co., offered in evidence as Exhibit Adams License?

62 Same objected — by Mr. Hill.

Ans. They were, with the exception of dates and the use of the personal pronoun. They were obliged to be so by the very terms of the license.

Q. 22. Can you give the names of the several licensees under this patent?

Objected to by Mr. Hill as immaterial.

Ans. I can. The Adams & Westlake Manufacturing Company of Chicago; Loeffelholz & Prier, of Milwaukee; St. Louis Railway Supplies Manufacturing Co. of St. Louis; M. M. Buck & Co., of St. Louis; F. Meyersa & Co., of St. Louis; Crerar, Adams & Co., of Chicago; Buffalo Steam-Gauge & Lantern Co. of Rochester; Kelly Lamp Co. of Rochester; and Jas. H. Kelly, of Rochester; R. E. Deitz, of New York; S. N. Aikman & Co., of New York; Underhill, Osborne & Co., of New York; and New England Glass Works, Boston; The Hemingray Glass Co. of Cincinnati, and Anton Prier, of Kansas City.

It is stipulated that the licenses issued to the several parties above mentioned are all alike, and that "Exhibit Adams License" may be used to the same effect as though the license to each of the said parties were offered in evidence, subject to the objections above noted as to competency, materiality, and relevancy.

Q. 23. In this license I observe that it grants to the licensee the privilege to use the inventions specified in the two Irwin's patents Nos. 47551 and 50591. Will you please state what part of the consideration of fifty cents per dozen was owing to patent No. 47551?

Ans. Not anything. As I before testified, it was worthless as a practical lantern in view of patent No. 50591, and I have
63 never known in my experience but one lantern made under that patent. The patent royalty fee of fifty cents per dozen was paid wholly for lanterns made under No. 50591.

Q. 24. I now hand you a lantern. Please state if that is the lantern you have referred to as having been made under patent No. 47551, and for what purpose was the lantern made.

Ans. It is; and was made as an exhibit to show how operative it was as a lantern.

This lantern is now introduced in evidence and asked to be marked Exhibit Irwin No. 1, which is done.

Q. 25. State whether you have ever brought suit against infringers

of this patent No. 50591; if so, against whom and with what result.

Ans. I have; against the Illinois Manufacturing Co., at Chicago, which was sustained by his honor Judge Blodgett. I have brought suit against John W. Howard and David R. Morse, in the southern district of New York, where the validity of the patent has also been sustained and an accounting ordered. I have also commenced two suits against the Ohio Lantern Co. and the Bellaire Stamping Co., in the southern district of Ohio, which are still pending, and one of which is the present suit.

Q. 26. Have you ever had any decision adverse to the validity of this patent?

Ans. I have never.

Cross-examination by Mr. HILL, *de bene esse:*

X Q. 27. You have in answer 5 stated in general terms what
64 the invention here in controversy consists in. Will you please state more specifically what you consider to be the distinctive features of the invention, which distinguish it mechanically from all other structures or inventions?

Ans. It consists of a means by which access may be had readily in the interior of the lantern, a means by which the globe may be taken out by hinging the lantern top backward, and a connection made with the various parts of the lantern by which it remains a unit, even should the spring catch opposite the hinge become attached.

X Q. 28. In the present patent, No. 50591, I observe that the bail marked D in the drawing is articulated to the lantern top. Is this a distinctive feature of the invention or would it still be the same invention if the bail were hinged to the guard independently of the top?

Ans. It is not, in my opinion. It would be the same invention if the bail were hinged to the guard independent of the top.

X Q. 29. In the patent I also observe that the top of the guard is apparently formed of a wire ring, to which the vertical wires marked E in the drawing are attached, and that apparently the lantern top is hinged to this horizontal wire ring. Is this wire ring a distinctive feature of the invention or would it be the same invention if the wire ring were omitted and the lantern top hinged directly to the vertical wires marked E?

Ans. I do not think a lantern top hinged to a vertical wire guard could be accomplished practically; but, in my opinion, an attachment by hinging to an upright guard would be mechanical
65 equivalent. In my opinion the wire ring is not a distinctive part of the invention.

X Q. 30. I see nothing in the patent to indicate that the form of the globe marked B is distinctive of the invention. If the globe were a straight glass cylinder would you regard it as still the same invention, the other parts remaining as shown in the patent?

Ans. The patent describes a globe that is removable from the top.

I should regard any form of glass susceptible of being removed through the top of the guards as the same invention.

X Q. 31. Assume a lantern having wire guards and a glass globe capable of insertion or removal through the top of the guard and a lantern top capable of displacement to permit such insertion or removal, do you regard the means by which such assumed lantern top should be capable of attachment to and detachment from the guards as an essential part of the invention, so that if one means were used the lantern would contain the invention, and if another and different means were used it might not contain the invention? In other words, do you regard the invention as broadly consisting of the displaceable lantern top or only as consisting of a hinged lantern top capable of displacement by being unlatched on one side and turned over on its hinge on the other side?

Ans. I do not consider the invention as affecting any lantern which has not a permanent attachment on one side like a hinge and a catch or fastening at some other part of the top. I mean by this that the top must be attached at one point. Two detachable catches on opposite sides of the top would not fall within the patent.

66 X Q. 32. Then, if I understand you, you consider it a distinctive feature of the invention that the lantern top should not be wholly removable from the guard frame, but that, on the contrary, the fastening on one side should be permanent and in the nature of a hinge, so as to always keep the parts together, while the fastening on the other side should be a catch, latch, or a locking device of some kind to hold that side of the top down when in use. Is my understanding correct?

Ans. It is.

X Q. 33. The invention, then, resides in the difference between a cover or top fastened by a hinge and catch or their equivalents, on the one hand, and a cover or top removably fastened by other common and well-known devices in mechanics, such as screws, spring catches, latches, bayonet joints, etc. Am I correct?

Ans. In my opinion it does.

The further taking of testimony was at this point adjourned to to-morrow, Wednesday, April 14, 1886, at ten o'clock a. m.

CHICAGO, *April* 14, 1886.

Cross-examination of J. MCGREGOR ADAMS resumed, pursuant to adjournment, at ten o'clock a. m.

Present: Same parties as before.

X Q. 34. Then if we should assume two lanterns, both constructed in all respects as shown in the drawings and described in the specifications of the patent herein sued, one of said lanterns having the top attached to the guard by a hinge and catch as shown in

67 the patent, and the other of said lanterns having no hinge, but having the top removably fastened to the guard by a screw connection or by spring catches, latches, or their equivalents, the one having the hinged top would fall within the invention and

the other one, having no hinge, would not fall within the invention, if I understand you correctly. Am I right?

Ans. In my opinion, yes.

X Q. 36. Now, will you please enumerate all the advantages which the one of said assumed lanterns, namely, the one with hinged top, would have over the other of said assumed lanterns, namely, the one with the top not hinged?

Ans. One of the principal advantages is the permanent attachment of the top of the lantern frame, by which the various parts are held together in case the catch becomes detached by swinging or otherwise. This is particularly valuable in railway service, where signals are given for moving trains, and an attachment of the nature of the patent is valuable in keeping the parts together. This is the main advantage that occurs to me at the moment.

X Q. 37. Does any other advantage occur to you; if so, what?

Ans. No other advantage occurs to me now.

X Q. 38. In your answer to X Q. 36 you state the advantage of the patented construction to lie in the permanent attachment of the top to the lantern frame, by which the various parts are held together in case the catch becomes detached by swinging or otherwise. By the parts being held together do you mean that the top is held to the guards by the hinge?

Ans. I do.

68 X Q. 39. Please tell me all the advantages arising out of the fact that the top — case the catch becomes detached accidentally, is prevented by the hinge from dropping off the structure.

Ans. It prevents the loss of the lower part of the lantern in case it is used on moving trains, causing an expense to replace. It also prevents loss by breakage of the glass globe if it should accidentally drop to the ground by reason of said detachment. This is all the advantage that occurs to me now.

X Q. 40. In this last answer you refer only to lanterns which have the bail hinged to the top, do you not?

Ans. I do.

At the request of defendants' counsel complainant *to* offers in evidence at this point a lantern belonging to complainant's counsel, and having a hinged top with the bail attached to the guard, the said lantern to be marked "Exhibit Defendants' Illustrative Lantern."

X Q. 41. The advantages referred to in your two last answers would also pertain to this lantern, "Exhibit Defendants' Illustrative Lantern"?

Ans. They would not. In my two last answers — would apply to this lantern only in a limited extent. The bail wire is not attached to the hinged top, but a basket is formed containing the globe, the same as in the previous lanterns.

X Q. 42. What I mean is this: In "Exhibit Defendants' Illustrative Lantern" *if* the catch which unfastened the lower part

69 of the lantern would not fall nor would the glass be broken any more in this lantern than in the complainant's patented lantern herein sued, would it?

Ans. It would not.

X Q. 43. Do you regard this Exhibit Defendants' Illustrative Lantern as coming within the limits of the invention covered by the patent herein sued?

Ans. I am not a professional expert. My knowledge of patents has been acquired by being practically brought in contact with them in our shop; and while I gladly give my opinion and views for what they are worth, I do not want this case prejudiced by non-professional views as to construction of patents. In my opinion it does.

X Q. 44. Now, let us take this "Exhibit Defendants' Illustrative Lantern" and assume that the hinge which secures the top to the guard frame were removed and a simple catch substituted for it like the catch on the opposite side now on it. In such case the lantern top would be held to the guard frame removably by means of two catches and without a hinge. Would the structure as thus modified contain what you understand to be the invention secured by the patent in suit?

Ans. It would not.

X Q. 45. What practical advantage can you mention as arising from the structure described and claimed in the patent in suit that would not arise from "defendants' illustrative lantern" modified by the removal of the hinge and the substitution of the catch, as assumed in my last question? Please name all.

Ans. It is difficult to explain all the vagaries of the demands of trade. We own a patent granted to Mr. William Westlake
70 for a lantern constructed as described by defendants' counsel, the top being attached to the lantern frame by two spring catches; but the demands of the trade would not take them, and demand a hinged top attached to the frame, one advantage claimed being that the top attached by two springs would get displaced and lost.

This is all the advantage that I can mention between a top hinged to the frame and a top attached by two springs or catches.

X Q. 46. Can you give me the date and number of the Westlake patent referred to in your last answer?

Ans. I cannot positively without referring to the patent papers in my office. My impression is that it is reissue to William Westlake No. 3747, reissued Nov. 23, 1869. I will ascertain definitely and report at a later hour, giving the exact information desired.

X Q. 47. In your 11th answer and in your 23rd answer you compare the value of the two inventions secured in patents No. 47551 and No. 50591, stating in substance that the former has no comparative value and was considered of no value in fixing the royalty to be paid by your licensees. Did you ever grant any licenses that did not include both of these patents—I mean did you ever grant any license under one of these patents independently of the other patent?

Ans. I have not.

X Q. 48. What facts can you cite, if any, to support the opinion expressed in your 23rd answer to the effect that no part of the roy-

alty of fifty cents per dozen reserved under your several licenses was attributable to the prior Irwin patent No. 47551?

71 Ans. The fact that I have known a lantern to be made by any of my licensees under the Irwin patent No. 47551. If such a lantern had been made and sold to the trade I should have seen it. The fact, also, that in talking with manufacturers of lanterns they said that this patent had no practical value, and the fact that the judgment of myself and our salesmen has always been expressed as to its impracticability. I recall now a conversation with M. M. Buck, of St. Louis, to this effect, and, I think, Mr. Osborn, of Underhill, Osborn & Co. It may have been Mr. Underhill in effect saying that patent No. 47551 was no good, but they paid their royalty of fifty cents per dozen for the hinged-top lantern of Irwin, No. 50591.

This conversation occurred in their office in Fulton street, New York; and another fact being that practical illustration as shown in "Exhibit Irwin No. 1," which, by practical illustration, shows the utter impracticability of a lantern made in accordance with that patent.

X Q. 49. Why, then, was that patent, No. 47551, included in your licenses?

Ans. I can only explain it by stating that I did not know as much about patents and licenses when I secured these patents as I now do. They were brought together, included in the same conveyance; have always been classed together in my conversations, and they crept into the license in the same way through my experience. I remember drawing up the license from a copy of one granted to me by the Kerosene Lamp Heater Co. of New York. I copied it myself from that license, altering the phraseology to suit the case. I assume that I submitted the form to my attor-

72 neys with no thought that this question would ever arise, my feelings being to keep the patent together as a unity just as I bought them.

X Q. 50. Was it not your understanding at that time that the Irwin patent No. 47551, being the older patent and covering a structure which admitted of the turning of the top back upon the hinge, broadly covered the invention contained in the letter patent No. 50591, and that the latter was an improvement upon the former, the general principle being the same in both?

Ans. It was not, for the reason that there were other patents in existence which Irwin's patent No. 47551 more nearly resembled, hinging at the base of the frame. Irwin, in patent No. 47551, carried his hinge only a little higher on the lantern frame. I refer to a patent, I think, granted to a Mr. Harris, of Pittsburgh, in a steamboat lantern; also one to a Mr. Coburn, No. 42839, May 24, 1864. I think this last is hinged at the bottom of the frame.

X Q. 51. In the bill in equity filed in the case of J. McGregor Adams, of Illinois, U. S. circuit court, in 1876, which declared on both of these Irwin patents, and which was signed and sworn to by yourself, as I learn from the record in the court, one of the things there stated under oath is that the invention described and claimed

in patent No. 47551 was — new and useful invention and that it had been put into use, or words to that effect. If a lantern as described and claimed in that patent had never to your knowledge been made at that time, and if you did not regard that patent as covering the underlying principle of the second Irwin patent, No. 50591, which did go into use, how could you truthfully make that statement in your bill of equity, and is not your memory a little at fault as to what you then understood to be the scope of the patent No. 47551? Inasmuch as a printed copy of that bill in equity has now been handed me, I will make my reference to it more specific. The first reference is the second paragraph of the bill, to the effect that one John H. Irwin was the true, original, and first inventor of certain new and useful improvements in lanterns, etc., referring to the lanterns patented May 2, 1865, No. 47551. The second reference is in the seventh paragraph of said bill, which refers to both of the Irwin patents, No. 47551 and No. 50591, and declares "that they have been and now are of great value and profit to your orator, and that your orator has brought the invention and improvements described in said letters patent into use, greatly to the advantage of the public," etc., etc. I will now add to my question this further interrogatory: Were you, then, really of the opinion that the structure patented in No. 47551 was impracticable, useless, of no advantage to the public, and that it had never been made or put into use; or that, on the other hand, is not your memory now in fault as to what you then understood to be covered by that patent?

73

Ans. Referring to the bill brought by myself against the Illinois Manufacturing Co., it was filed some years since. It was probably on a printed form with a great deal of verbiage which a practical business man does not understand. My feeling in signing the bill at that time must have been the unity of the patents as explained in answer to X Q. 49. I have no recollection now of my train of thought at that time or the reasons that actuated me at that time. I may have thought and probably did that the patent had more value than it had. My answers to questions 11, 23, and X Q. 48 were based upon more mature experience and the result of observation since the bill referred to was filed.

74

X Q. 52. In the suit against Howard & Morse, referred to in your 25th answer, did you sue upon both of these patents or only upon the later one?

Ans. I did upon both.

X Q. 53. When was that bill filed or sworn to, and by whom?

Ans. It was sworn to April 7, 1881, by myself.

X Q. 54. In the bill in this last-mentioned case, in paragraph two and eight thereof, I find substantially the same statements as to the usefulness and value of the invention contained in patent No. 47551 and as to the fact that the improvements and inventions therein described had been brought into use by yourself greatly to the advantage of the public. As this bill was sworn to April 7, 1881, I assume that the maturing of your experience and observation mentioned in your 51st cross-answer has been going on much more rapidly in the

five years since that bill was filed than it did in the sixteen years prior to that date. Am I correct?

Ans. My answer to this question would be the same as to the previous question as to the form of bill. While reading, signing, and swearing to it, it is not expected that a non-professional would understand its bearing as well and clearly as a simple statement made under examination as a witness. Patent No. 50591 was sus-
75 tained, as I understand, by Judge Blodgett's decision in the fall of 1879. Some time elapsed between the date of this decision and the commencement of the suit against Howard & Morse in the hope that negotiations would bring about a settlement without suit. Meantime licenses as presented had been issued, as before testified to, and it was only since the commencement and continuance of the suit that I have examined the bearing of patent No. 47551 and No. 50591. I frankly admit that I may have been in error, but I still adhere to my deliberately formed opinion as expressed in answer to X Q. 48 and direct questions 11 and 23. A man's judgment grows better as he grows older. I refer in the last paragraph to the suit against Howard & Morse. My judgment has matured more rapidly in the last five years than in the previous sixteen, from the fact that I have given this subject more careful consideration during the first-named period than the sixteen years previous.

At this point a recess was taken until 2.15 o'clock p. m.

Court met, pursuant to adjournment, at 2.15 p. m.

Present: Same parties as before; and cross-examination of Mr. J. McGREGOR ADAMS continued:

X Q. 55. In the suit brought against the Illinois Manufacturing Co., in the northern district of Illinois, by you, and hereinabove referred to, please describe the lantern which the Illinois Manufacturing Co. made or sold, and for which you charged them with infringement of the two Irwin patents.

Ans. The time is too far distant to state positively the style
76 of lantern. My recollection is that it was what we call a conductor lantern, made of brass, nickel-plated, and in construction similar to the lantern made now before me, so far as relates to the hinged top and guard, which lantern I make a part of my deposition and ask that the same be marked "Illinois Manufacturing Co.'s Lantern," which is accordingly done. I think I have one of the Illinois Manufacturing Co.'s lanterns at my office, which I should like to substitute as this exhibit.

X Q. 56. The Illinois Manufacturing Co.'s lantern was charged in that suit to infringe these patents; had a horizontal wire attached to and forming the upper end of the guard frame, and had the lantern top hinged to the upper end of the guard frame on one side and fastened by a catch at the opposite side, and had the bail pivoted to the lantern top, had it not?

Ans. As I remember it, it did.

Defendants' counsel offers in evidence a copy of the decree entered

in said case against the Illinois Manufacturing Company on the 26th day of Nov., 1879, to be marked Exhibit Illinois Manufacturing Co. Decree, which is done.

X Q. 57. In the decree which I have just put in evidence Judge Blodgett holds both of said patents, No. 47551 and No. 50591, to be good and valid, and that the defendant The Illinois Manufacturing Co. had infringed both of them, and ordered an accounting to be taken before Henry W. Bishop, master in chancery, and also ordered an injunction under both patents and adjudged costs to the complainant. Is not this the fact?

Ans. It is, as I have learned by reference to the decree.

77 X Q. 58. Was that decree ever reversed, annulled, or modified so far as you know?

Ans. It was not.

X Q. 59. Was the account ever taken under that decree?

Ans. I am not sure. My impression is that it was not, the company about this time becoming embarrassed and went out of business, but the details I am not sure about.

X Q. 60. You are the only J. McGregor Adams ever connected with the firm of Crear, Adams & Co., of Chicago, are you not?

Ans. I am.

X Q. 61. In the license which you have introduced into evidence I notice that one of the provisions is that the licensee will maintain the prices of all lanterns containing any of said improvements manufactured and sold by them at not less than the schedule of prices furnished them from time to time, and that another provision is that all your other licensees shall be furnished with the same schedule of prices, and that you will maintain the same for all lanterns manufactured or sold by you or any firm or corporation with whom you are connected and containing any of the said patented improvements, referring to the improvements of the two Irwin patents No. 47551 and No. 50591. These were provisions containing large advantages to the trade if maintained as agreed upon, were they not?

Ans. It was an advantage to the trade to know that they were not to be undersold, and as such I should answer yes.

78 X Q. 62. It prevented all who were making these lanterns from underselling each other and enabled you to fix a scale of prices for all parties which would be reasonably remunerative, did it not?

Ans. To all my licensees; yes.

X Q. 63. Give us an estimate of the advantage of this provision, if properly carried out, to your licensees, estimating per dozen of the lanterns made and sold by them. What I mean is this: How much advantage per dozen of lanterns was such a provision as this if complied with by all parties and assuming the schedule prices which you actually fixed for them from time to time?

Objected to by counsel for complainant as incompetent, irrelevant, and immaterial and not cross-examination.

Ans. The advantage in this provision cannot be estimated in dol-

lars and cents. The advantage consisted not in getting an enhanced price to the ruling rate of lanterns, but in insuring to the licensees a fair proportion of the trade incident to their locality without the fear of being undersold by competing houses, at the same time protecting their trade from all liability under these two Irwin patents. It insured stability of prices rather than increased rates.

X Q. 64. That provision, if I understand you, was in all your licenses. Am I correct?

Ans. Yes, sir; it was.

X Q. 65. At how early a time did you begin to license others besides your own firm or company to use these inventions?

Ans. About Dec., 1879; soon after the decree in the Illinois Manufacturing Co. case.

79 X Q. 66. Why did you neglect so long to bring suit against the Bellaire Stamping Co. if you regarded them as infringing your patents?

Ans. I had been in correspondence or had personal interviews with Mr. Barron for some time previous in regard to these patents. I had hoped to bring about a negotiation and amicable settlement. I had other suits pending in this and other matters, and had been too busy to take it up until I did. Barron, above referred to, was connected as manager with the Baron Manufacturing Company, subsequently succeeded by a change of name as the Bellaire Stamping Company. This Baron used to represent the Baron Manufacturing Co. in our meetings in New York on stamped ware association business, and was known there as Mr. Charlie Baron.

Redirect examination by Mr. W. G. RAINEY:

R. D. Q. 67. In your answer to X Q. 29 you state, "I do not think a lantern top hinged to a vertical wire guard could be accomplished practically." Now, will you please state what you mean by such answer?

Ans. I mean that, while a mechanical possibility, a lantern so constructed would be a mongrel affair, not salable to any extent except at reduced prices, would be unsatisfactory to the users, and, while infringing patent owned by me No. 50591, would do me an injury by underselling prices which I had established with my licensees.

R. D. Q. 68. Will you please examine lanterns now before you and marked "United States circuit court, southern district of Ohio, eastern division, J. McGregor Adams *vs.* A. L. Baron *et al.*, Exhibits Baron Nos. 1 and 2," respectively, and state whether they do not contain in their construction tops hinged to a vertical

80 wire guard without a horizontal wire at the top?

Ans. They do.

R. D. Q. 69. Now, will you please state whether these lanterns, "Exhibits Baron Nos. 1 and 2," have in their construction the elements contained and covered by the claim of the patent sued on, No. 50591, which is as follows: "A removable lantern top secured to the upper part of the guard"?

Ans. They do.

The same question is repeated by complainant's counsel as to Ex-

hibits Bellaire Stamping Co. Lanterns Nos. 1 and 2, 3 and 4, being exhibits in this case.

Ans. They all have it.

J. McGREGOR ADAMS.

It is stipulated that the original deposition shall be kept in the possession of the attorneys for the plaintiff, the defendants' counsel having a copy thereof, and that the examiner taking this deposition shall make his certificate thereof similar to the certificate attached to the depositions taken in this case at Bellaire, Ohio.

In my answer to X Q. 46 I have, as the number of Westlake patent referred to in my answer to X Q. 45, reissue 3747, Nov. 23, 1869, but promised to look it up and give the number accurately. I desire now to correct that answer. I find the patent I then had in mind and referred to was No. 51526, of December 12, 1865, which was reissued as No. 2239, May 8, 1886.

J. McGREGOR ADAMS.

81 United States Circuit Court, Southern District of Ohio, Eastern Division.

J. McGregor Adams
vs.
The Bellaire Stamping Co. *et al.*

Exhibit Adams' License. P. H. T. Mason, Notary Public.

Copy.

This agreement, made this 9th day of January, A. D. 1880, by and between J. McGregor Adams, of Chicago, in the county of Cook and State of Illinois, party of the first part; and M. M. Buck & Co., a corporation doing business at St. Louis, St. Louis county, Missouri, party of the second part, witnesseth:

That whereas party of the first part is owner of certain letters patent of the United States for improvements in lanterns granted to John H. Irwin, of Chicago, dated respectively May 2, 1865, and Oct. 24, 1865, and No. respectively 47551 and 50591; and whereas the said party of the second part are desirous of manufacturing lanterns containing said patented improvements:

Now, therefore, in consideration of the agreements on the
82 part of the said party of the second part to be performed, herein contained, and solely on condition that the same shall be faithfully performed by said party of the second part, and in further consideration of the sum of one dollar in hand paid, the receipt of which is hereby acknowledged, and in further consideration of the payment of the royalty or license fee hereinafter stated, which the party of the second part promise faithfully to pay unto the said party of the first part, and the adherence to prices and terms of sales of lanterns fixed as hereinafter provided, the said party of the first part does hereby grant unto the party of the second part the right and license to manufacture, use, and sell any and all of

said patented improvements for the period of life of the patent, subject to the conditions hereinafter named, at the factory in St. Louis, Mo., and in no other place or places is right granted them to manufacture, but right of sale is extended throughout the United States.

And the party of the second part hereby admit that the patents hereinbefore described are valid, and promise to covenant with the party of the first part, his successors and assigns, as follows:

1st. That they will not in any case dispute or deny the validity of the said patents or in any way attempt to infringe or evade them.

2nd. That they will not manufacture the said inventions secured by the said patents for any other purpose or to any greater extent than the license hereinabove granted gives a distinct right to manufacture the same.

3d. That they will pay unto the party of the first part, his successors or assigns, in consideration of the license herein granted, fifty cents per dozen for all lanterns manufactured by them
83 containing any of said patented improvements.

4th. They will maintain the prices of all lanterns containing any of said improvements manufactured or sold by them at not less than the schedule of prices furnished them from time to time, and that any deviation from said schedule to lower prices shall be construed as a forfeiture of this license and all moneys paid thereunder.

5th. That the party of the first part, his representatives and agents, shall have the right to inspect and examine the books and accounts of the said party of the second part relating to the manufacture and sale of lanterns.

6th. That said party of the second part shall make full and true returns under oath to the party of the first part, upon the first days of February, May, August, and November of each year, of all lanterns containing any of said patented improvements manufactured by them during the preceding three months, the first quarter dating from Dec. 1, 1879, covering two months.

7th. That said party of the second part shall on said first days of February, May, August, and November aforesaid pay to the said party of the first part, his representatives or assigns, all royalties and license fees accruing under this agreement during the period aforesaid immediately preceding said dates, and the same shall be due and payable at said dates aforesaid.

8th. That if said party of the second part shall fail to keep and perform any of the covenants and agreements herein contained for ten days after notice in writing specifying said default, or shall neglect or refuse to make returns or to make payments for twenty days after the times therefor above specified, the license herein
84 granted shall become null and void and all rights to use any of said improvements shall be forfeited, and the party of the first part may treat them as infringers for any manufacture or sale of said improvements after forfeiture, and thereafter the party of the second part shall have no further rights or privileges under this agreement, but shall still remain bound thereby as to all covenants and

agreements herein contained, and shall not thereby be discharged from any liability to the party of the first part for any license fees previously accrued.

And the said party of the first part hereby covenants and promises that he will issue to all other licensees the same schedule of prices and (as nearly as may be) at the same time as to the said party of the second part, and that he will maintain the same for all lanterns manufactured or sold by him or any firm or corporation with whom he is connected containing any of the said patented improvements.

In witness whereof the parties above named have hereunto set their hands the day and year first above written.

(Signed) J. McGREGOR ADAMS.
M. M. BUCK & CO.

85 The following is a schedule of prices for what is known as the loose-globe, hinge-top lanterns, made under the Irwin patents Nos. 47551 and 50591, dated respectively May 2, 1865, and Oct. 4, 1865:

The R. R. lantern, similar to that known as No. 39, made of IX tin, with white flint globes, base 6 in. or over in diam., per doz.	$9 00
Globes, base 6 in. with ruby globes, per doz.	14 00
Frames only (without globes), S. G., per doz.	7 50
" " " " D. G., " "	8 00

A discount of 10 per cent. may be made on the No. 39 lantern to the trade only.

The trade lantern, similar to that known as No. 43, made of I. C. tin, with lime glass, single guard, and bottom— 6 in. or less, per doz.	$8 00
" " " with ruby globes "	13 00
Frames only (without globes), S. G., "	7 00
" " " " D. G.	7 50

A discount of 15 per cent. may be made on the No. 43 lantern to the trade only.

Very respectfully,

——— ———,
For Owners of Patent.

86 And thereupon, to further maintain and prove the issues on his part, the plaintiff called and examined A. Weinberg, who, having examined the books of the defendant corporation, testified therefrom as to the number of lanterns and lantern frames as shown in said last-named exhibit which had been made and sold up to the date of the expiration of the said letters patent, showing a total up to the first day of Oct., 1882, of 61,794½ dozens; also the evidence of one David J. Powers, an expert (the deposition read having been taken in another case and by stipulation read in this case), to show that the said lanterns complained of were infringements of said letters patent, during the reading of which counsel was interrupted by the following:

"The COURT (to counsel): Do you read the opinion of the witness as testimony?

"Mr. RAYMOND: The fact upon which that expert testimony is based is in this record. It is in it that ten thousand of them were sold every year.

"The COURT: The witness whose testimony you read must confine his statement as an expert to the construction of this lamp and its superiority over any other, but he cannot go into an argument before this jury as to its general utility. (To the jury:) The jury will not pay any attention to what the witness is saying as to the general utility of this thing that is in evidence before you.

"Mr. RAYMOND: It is the province of an expert to examine what is in a patent and give testimony as to what these advantages are, and what the construction of the patent should be.

"The COURT: But he does not know all the patentable
87 lamps that have been in existence up to this time. He says 'so far as — knew and has gone,' but he does not undertake to say that he is perfectly familiar with the art as it existed up to the date of this patent.

"Mr. HILL: If he had done that it is his duty to bring the facts before the court and let the court see whether it was a patentable article or not.

"The COURT: You put yourself in the position of saying, Mr. Raymond, that this court cannot say what is patentable and what is not, but you cannot bring an expert here and testify what is patentable; the court won't submit to that. You must get your facts in here and the court will construe the matter of law to the jury. You have not laid the foundation to introduce any such testimony.

"Mr. RAYMOND: What we are reading now is usual, but it is accumulative of what we have already in the record, so we will stop this right now.

"The COURT: It is a question for the court and one which the court has to decide.

"Mr. RAYMOND: Then let the record show that the reading of the deposition closed with the answer to question 4, on p. 114, in the case of Adams *vs.* Howard *et al.*"

To which remarks on the part of the court in the hearing of the jury counsel for plaintiff then and there excepted.

And, further — maintain the issues on his part, the plaintiff, J. MCGREGOR ADAMS, was duly sworn and examined, and testified that in
88 and since 1874 he was and had been a partner in the firm of Crerar, Adams & Co.; that he has made a diligent search for the license to the said firm referred to in the aforesaid assignment of Oct. 3rd, 1874, by Sawyer, Dennis & Wheeler of said patent to plaintiff, but that he had been unable to find the said license and believed the same to have been burned in the Chicago fire of 1871; that prior to said fire it was in the vaults of said firm, which were — with all their contents of the license; that it was made about the year 1866 or 1867; that it was a mere shop right, was not transferable, but a mere shop or personal license, dependent upon the

payment of fifty cents per dozen as royalty, and did not contain any grant or transfer of any exclusive rights; that the paper was drawn by Mr. James S. Dennis, president of the Chicago Manufacturing Company and a member of the firm of Dennis & Wheeler.

Whereupon the following transpired:

Q. Now, Mr. Adams, referring to the licenses which have been granted by you under this patent to others, one of which has already been introduced in evidence here, a contract is contained in it with reference to the maintenance or stability of prices. A royalty is also provided in this license of fifty cents per dozen. Now, I desire to ask you, as a matter of fact, whether the one matter, to wit, the contract as to the maintenance or stability of prices, had anything to do with the royalty of license fee which was fixed (in there to buy the paper) between you and your licensee.

(Objected to by counsel for defendants.)

Mr. RAYMOND (to court): Your honors, I desire to say that I propose to show by this witness, as a matter of fact, he being a party of to each one of the transactions with each one of these
89 licensees, and he being himself the licensor, that the contracts therein contained with reference to the maintenance of prices have nothing to do, directly or indirectly, with the fixing of the royalty under this patent evidenced by this license.

(Objection sustained and exception taken.)

And thereupon, plaintiff, having introduced other evidence, to which no exception was taken and which is not material to this bill of exceptions, reserving to himself the right to procure the charter of the Illinois Manufacturing Company, which was subsequently produced and introduced and a copy whereof is hereto attached and marked Exhibit C, rested his case.

Whereupon the defendants, to maintain and prove the issues on their behalf, introduced as a witness JAMES A. BLANKELEY, who, being first duly sworn, testified as follows:

Examined by Mr. DYER:

Q. Where do you live, Mr. Blankley?
A. Bellaire, Ohio.
Q. What is your occupation?
A. Tinner.
Q. Please look at that lantern (handing the witness the Southerland exhibit). Did you ever see that before?
A. Yes, sir.
Q. What do you know about it?
A. The lantern?
Q. Yes. Did you make that?
A. Yes, sir.
Q. Just open the lantern and take out the paper that is in it. Did you ever see that paper before?

A. I saw it or one like it.

90 Mr. RAYMOND: Let me see it. (Witness does so.)

By Mr. DYER:

Q. Why did you make that lantern; how came you to make that lantern?

A. Sir?

Q. How did you come to make that lantern?

A. Why—Mr. Tallman's orders.

Q. From what description did you make it?

A. This specification.

Q. Did you make it like that description?

A. Yes, sir.

Mr. DYER (to the court): I would like to say that I compared that paper with the specification and believe it to be the same. I compared it with the Sutherland patent.

The statement I make it about is that that paper is a correct copy of the specification.

By Mr. HILL:

Q. Did anybody aid you in making that by giving you any suggestions?

A. No, sir.

Q. The only information you had is what you got from that paper, and you made it accordingly?

A. Yes, sir.

Q. And it is now just as you made it and has not been changed?

A. Yes, sir.

(Model of lantern offered in evidence by counsel for defendants and objected to by plaintiff's counsel on the ground that there is no evidence to show that a patent has ever been granted to Sutherland upon his invention.)

Mr. Dyer then read the specification to the jury, and, pend-

91 ing a decision relating to the acceptance of the model in question, court took a recess until 2 p. m.

2 P. M.

Mr. RAINEY: With reference to the question of the publication of the English patent known as the Sutherland patent plaintiff objects to its introduction on the grounds that the patent had never been perfected, and the defendants must prove that a publication of it had been printed prior to the patenting of plaintiff's invention. Another objection is that this paper, if it goes in for any purpose whatever, is objectionable because it does not interfere with our invention. The mere filing of a provisional specification without following it up with the proof that it was enrolled with a patent is not sufficient description of the filing of a patent.

Mr. DYER: It states here (reading) "English patent No. 11914, to K. L. Sutherland." As a matter of fact we do not disagree that this was a provisional specification, and I don't think we disagree

upon the point of law that in a publication the invention must be described so clearly that a skillful mechanic could from the description make the thing simply with the exercise of mechanical skill and without invention, and I don't think we disagree about the fact that we are required to prove the date of publication in a reasonable way in some place, but the statute does not limit the place of publication. I now ask leave to withdraw this and to call Mr. Smith as a witness as to publication.

92 And thereupon the defendants introduced Mr. R. D. O. SMITH, who, being first duly sworn, testified as follows:

Q. Where do you live?
A. Washington, D. C.
Q. What is your business?
A. I am solicitor of patents.
Q. How long have you been so?
A. 24 years.
Q. Where are the records of foreign patents kept in the Patent Office?
A. Kept in one of the libraries.
Q. Is that a public library?
A. Yes, sir; it is much frequented by the public.
Q. In what form are these old English patents—say of the date of 1857.
A. They are all bound volumes up to about 1879 or 1880. The drawings were printed in very large sheets and the volumes in very large folios.
Q. Were they in printed volumes?
A. In printed volumes.
Q. Do you know how they were obtained?
A. I have always understood by exchange with the English patent office.
Q. During that 24 years?
A. Yes, sir.
Q. Do you know after what interval the printed copies of English patents are received in the United States?
A. No, sir; but I have always supposed about six or eight months.
Q. In these bound volumes at the Patent Office provisional specifications appear in their ordinary date?
93 A. They do.
Q. They are all there?
A. They are all there.
Q. Were they bound by the year separately?
A. I think not; bound in volumes of about equal size.
Q. Have you any doubt that the letters patent and provisional specifications of 1857 were in that library prior to 1864?

(Objected to by counsel for plaintiff, and question withdrawn.)

Q. At what date, in the regular course of things, would the

printed volumes containing the patent of Sutherland of 1857 appear in that library of the Patent Office of the United States?

A. Well, I have said that my understanding has been about 6 or 8 months, and during the time I have been in business I have had frequent occasion at the Patent Office to consult the English patents, and I don't recollect any time when they were much in arrears.

By the COURT:

Q. From six to eight months?

A. That is my impression.

Q. This last-published volume would bring it down to about 6 or 8 months after it was issued?

A. I think so.

Q. Been published by the Patent Office here?

A. That is my recollection; that is my understanding.

Q. How near to the date of the patents published in England is the date of the appearance of the publication of the patents here?

A. I think about 6 or 8 months.

94 Cross-ex'n by Mr. RAYMOND:

Q. Have you any personal knowledge as to when this copy was filed?

A. None whatever.

Q. Are you familiar with the rule under the English patent law, under the last revision and as it is now, with reference to the publication of English patents and with reference to provisional specifications?

(No reply.)

Q. Do you know what the rule of law and also the rule of the patent office in England was in 1857 with reference to the publication of provisional specifications?

A. No, sir.

Q. So you don't know but what the rule was in 1857 that these provisional specifications were held there for 6 months or 16 years?

A. I suppose they were held about six months, which I believe was the limit for provisional specifications under the English law.

Q. Do you know what the rule of the patent office was—the commissioner's office in England—in 1857 as to the time when the provisional specifications would be held to be secret papers?

A. I don't speak as an expert on English laws, but my understanding was that there was no secrecy. The application was filed and then advertised after six months.

Q. Let me ask you now whether you are not inaccurate as to what the law was in 1857 and since.

A. I don't speak to a certainty.

95 Q. You can't give, then, any positive testimony as to what the law was in England with reference to provisional specifications in 1857?

A. Nor as to what it is to-day. I don't mean to be understood in that way. I think it is six months from the date of filing, because

a provisional specification is filed and held for about six months, after which time the application is advertised.

Q. That is the law as it is to-day?

A. And as it always has been, as I understand it. I may be mistaken about that.

Q. Have you any personal knowledge whatever of the date of the receipt by the Commissioner or librarian of the United States Patent Office and of the filing by him of a copy of the provisional specification of the Sutherland patent?

A. No, sir.

Q. You don't know of your own knowledge that there has been any proper publication of this specification that would make it a part of the common knowledge?

A. No, sir; I don't know as I ever saw that.

The COURT: It is manifest that that thing has come to this country from England, and could not be in the Patent Office without such being the case; but it seems to me that gentlemen might clear that up by reference to the English law and the English statutes, which are within easy reach.

Mr. HILL: I will offer to the court the contents of the record in the New York case, which contains a large number of printed English specifications, with statements as to when they were published. For instance, here is one, a patent of 1856, published in 1857; price, 10*d.*

96 Here is another, in 1841, which does not appear to have been till 1856 published, &c. Here is another one, which was taken out in 1856 and which was printed in the same year, and here is another one: London: printed by Geo. E. Ayers and William Spottiswood, printers to her most excellent majesty; price, 3*d.*; 1857.

Here is another one, taken out in 1856 and printed in 1857; price, 9*d.*; and here is another one—a provisional specification in 1857 to H. L. Sutherland—the very one in question: London: printed by George E. Ayers and William Spottiswood, &c., and published in 1857.

Mr. DYER: We offer, then, in evidence this provisional specification of the Sutherland patent.

(Objected to by counsel for plaintiff. Objection overruled and exception taken.)

Thereupon JAMES A. BLANKLEY was recalled for the purpose of further cross-examination, and testified as follows:

By Mr. RAYMOND:

Q. I understand that you made that lantern purporting to represent the thing described in that paper, which is understood to be and which is supposed to be a copy of this specification of the English patent?

A. Yes, sir.

Q. How old are you, Mr. Blankley?

A. 33.

Q. You don't know anything about the then art of making lanterns in 1857? You were only three years old at that time.

A. Yes, sir.

Q. So that there is nothing in this model which you have made, outside of the specifications which were submitted to you to follow, other than knowledge which has been acquired by you since 1857?

97 A. Yes, sir.

Q. And under that knowledge you attempted to follow the specification which was submitted to you?

A. Yes, sir.

Q. It describes this cylinder down at the bottom and this ring at the top, and says it is connected together with four rods?

A. Yes, sir.

Q. Why did you make that rod around there instead of making it straight?

A. I don't know that it would make any difference.

Q. In one case it would be a guard and in another case it would only be a partial guard. Do these rods perform the service of any guard at all against that glass, as they are made now, at this part of it (indicating)?

A. No.

Q. What do you find in the description in the specification you followed of these rods—what are they for?

A. To support the ring.

Q. Nothing said in this specification about guarding the lantern at all?

A. No.

Q. Now, this specification furthermore says something about this band at the top. Do you remember what it says? It says it is a flat band?

A. Yes, sir.

Q. Is that a flat band within the meaning of the specifications? Should it not be horizontal? It is perpendicular—this way.

A. I wouldn't think so.

Q. With these rods running from the bottom here to this place, would you call that a flat band?

98 A. Yes, sir; I would.

Q. Why?

A. It is flat one way.

Q. That is the only reason you have for doing that? Now, another thing. Do you know whether there was any lantern known of this kind in 1857 with a glass globe in it that was not soldered there (indicating)? Is there anything in this specification whatever to show whether that globe is removable or is not removable—anything in the paper you followed about that at all?

A. No, sir.

Q. Anything said in the specification about the shape of this top or the perforations?

A. Yes, sir; there is about the perforations.

Q. I will ask you another question, Mr. Blankley. Do you think that any device of this sort with a screw fastening it together is a practical device?

A. No, sir.

Q. You don't think it would ever come into use at all?

A. No, sir.

Defendants' counsel then read the specification of the Sutherland patent in question.

And plaintiff, by his counsel, objected to all the foregoing testimony with reference to the Sutherland patent and the provisional specification and model except so far as its introduction might go to show the state of the art.

And further to maintain the issue on their part defendants offered in evidence, by their counsel, letters patent No. 108,430, dated
99 Oct. 18, 1870, granted to C. S. S. and A. L. Baron, the patent on the continuous guard.

(Objected to by plaintiff as not material to the issue before the court. Objection overruled and exceptions taken.)

And thereupon, to further maintain and prove the issues on their part, defendants' counsel introduced in connection with copies of the below-named patents what purported to be certified copies from the U. S. Patent Office of models of the improvements in said patents described, to wit: Waterman patent of Dec. 25, 1849, No. 6978; Morley's patent of Aug. 29, 1854, No. 11632; Miller's patent of Aug. 17, 1858, No. 21209, a copy of the said certificate to said models, being as follows, to wit:

100 Copy.

Schuyler Duryee, chief clerk.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE.

To all persons to whom these presents shall come, Greeting:

This is to certify that the annexed is a duplicate of the model as it now appears, a portion being lost, except the globe, which in the original is of glass, filed in the matter of the letters patent granted Max Miller August 17th, 1858, number 21209, reissued January 6, 1863, No. 1374, and assigned through mesne assignments to William H. Racey for improvements in lanterns for burning coal oil.

In testimony whereof I, M. V. Montgomery, Commissioner of Patents, have caused the seal of the Patent Office to be affixed this 24th day of March, in the year of our Lord one thousand eight hundred and eighty-six, and of the Independence of the United States of America the one hundred and tenth.

Seal of the Patent Office.

(Signed) M. V. MONTGOMERY,
Commissioner.

101 Concerning the said models defendants' expert witness, R. D. Q. SMITH, testified in his direct examination that on the Saturday previous to the trial of this cause he visited the Patent Office and examined the models then on file there.

That, in his opinion, the Waterman model is a fair representation of the Waterman patent, with the exception as follows:

"I think it is a fair and accurate embodiment of the structure described in the patent, with one exception. In the patent drawing there is represented at this point a shoulder, which is not in the model. I mean the point joining the upper edge of the reflecting frustum with the vertical portion of said frustum which connects it with said cap.

"Q. You say a shoulder?

"A. Yes, sir; there is represented in the drawing a shoulder here.

"Q. Does the shoulder perform any function, as you understand it?

"A. I should understand that that shoulder brings the frustum within the edge of the glass, as it is represented (indicating). This (indicating) is the frustum. That (again indicating) is the vertical part. This (indicating) is the glass globe, and the drawing shows a clear space between the upper edge of the globe and this shoulder I have spoken of, so that the conical portion of the frustum would run down clear this way (indicating)."

102 Of the Morley model he said to the jury:

"It, gentlemen, does not correspond very accurately with the drawings of the patent, but it corresponds, from my recollection, with the model in the Patent Office."

Of the Sutherland model he says:

"There being no drawing attached to the English patent, it is impossible to tell how the patentee intended to make it, but it (the model) corresponds." * * * "Think it corresponds accurately with the description. Of course it is easy to suppose it may have been in different shapes to some extent and still correspond. There being no drawing attached to the English patent, it is impossible to tell how the patentee intended to make it, but it corresponds."

To each of which models as evidence the plaintiff, by his attorney, objected as incompetent and immaterial, which objection was overruled, and then and there plaintiff, by his attorney, excepted.

Thereupon defendants, to further maintain and prove the issues on their behalf, introduced a copy of the J. H. Irwin patent No. 47551, granted May 2, 1855, a copy of which is hereto attached and marked Exhibit 1; to which patent counsel for plaintiff objected on the ground that the record already shows that the said patent was for an invention made subsequently to the Irwin patent No. 50591 now sued upon, which objection was overruled, and plaintiff, by his attorney, then and there excepted.

The testimony referred to in the objection was as follows:

103 "8 Q. State what your idea was in making the invention of the hinged-top lantern and why that invention was called to your attention by the Westlake lantern.

"A. On looking at the Westlake lantern it occurred to me that the lantern would be more useful if the globe were loose and not fastened by plaster or any other means, as in the Westlake lantern, and it would be very much better to have the loose globe come out of the top of the lantern guard than at the bottom of the same, and the bottom fastenings of the Westlake lantern were liable to come loose by moving the lantern from place to place, endangering the breakage of the globe. Having the hinge and spring open-top device, the globe is not likely to be broken, as in the Westlake. These were improvements that I then and now think useful.

"9 Q. Did you immediately after making this invention of the hinged-top lantern apply for a patent for the same; and, if not, why not?

"A. I did not, for the reason that, after thinking the matter over carefully, I concluded that it would be substantially Westlake's invention in a little different form.

"10 Q. What did you at that time think was Westlake's invention?

"A. Substantially any device that would allow the guard to be taken off the lantern as a whole.

"11 Q. Can you refer me to the date and number of any patent for the Westlake lantern you refer to?

"A. I can; No. 43730, dated Aug. 2, 1854.

"12 Q. As you say that you concluded at that time that
104 your hinged-top form of lantern would be substantially Westlake invention in a little different form, state whether you took steps to procure any patent for any other modification; and, if so, what it was.

"A. I did take steps to procure a patent on a lantern of a different form. The patent is numbered No. 47551; dated May 4th, 1865.

"13 Q. Why did you patent the form of lantern shown in the patent No. 47551 before you patented your hinged-top lantern?

"A. Because I thought this was a different invention from that of Mr. Westlake, on account of the guard being broken and not in whole as in Westlake's."

Also the file wrapper, contents, and a copy of the U. S. patent No. 58392, issued Oct. 2, 1866, to A. M. Duburn; to which counsel for plaintiff objected on the ground that it was for a subsequent invention to the Irwin patent now sued upon; which objection was overruled and an exception taken.

Also a certificate from the Patent Office in the form and tenor of the certificate herein quoted to what purported to be a model of the said Duborn patent; to which model and certificate plaintiff, by counsel, objected as before, and the objection was overruled and an exception taken.

The foregoing is all the testimony given in said cause pertinent to any objection or exception made at the trial thereof and pertinent to this bill of exceptions.

105 Whereupon the plaintiff requested the court in its charge to the jury to say as follows:

"Before you should determine the Irwin patent invalid by reason of any prior patent you should be satisfied that you find the entire invention of Irwin in one prior patent. It is not sufficient that you should find one of the elements in one patent, another in a second patent, and a third element in a third patent."

Also to instruct the jury as follows:

"The fact that the Irwin lantern was accepted by the trade, was largely in demand and practically superseded all other lanterns used for the same purpose as Irwin's lantern was designed to be used, is very strong, though not conclusive, evidence that it was novel and not before known."

And a like request was made by plaintiff's attorney that the court should instruct the jury as follows:

"In the construction of a patent due weight must be given to the expression, the whole being as above described of the invention as contained in the specifications."

And a like request that the court should instruct the jury in the following language, taken from the opinion of the U. S. circuit court for the northern district of Illinois in the case of Adams *v.* The Illinois Manufacturing Co. (18 O. G., 412), referred to in the said stipulation between the parties hereinabove contained, to wit:

"The leading feature of this patent is the construction of a
106 loose-globe lantern, so arranged that the globe can be readily removed and replaced and at the same time have the metallic parts of the frame permanently attached together so as to make a basket, in which the globe will be held or retained, even if the catch holding the top or dome to the frame of the lantern is unfastened. This is obtained by hinging the top or dome to the guard on one side, so that it can be closed firmly to the guard by the operation of the hinge and a catch on the side opposite the hinge, so that when the top or dome is lifted or thrown back on the hinge the globe can be removed from the guard."

Each of which four instructions were declined, and to each of which the plaintiff, by his attorney, then and there duly excepted.

Whereupon the court charged the jury as follows:

GENTLEMEN OF THE JURY: Instead of requiring you to render a general verdict in this case, it has been arranged that certain questions of fact shall be submitted to you for your determination, leaving it for the court to pronounce the proper judgment thereon. The questions on which you are to return special findings are the following:

1st. Does the Irwin patent No. 50591, dated Oct. 24, 1865, here in suit, disclose an improvement which required invention as distinguished from mere mechanical skill or judgment at the date of said alleged invention?

The law of the U. S. (sec. 4886 Rev. Stat.) provides in substance that any person having discovered or invented any new
or useful art, machine, manufacture, or composition of mat-
107 ter or any new or useful improvement thereof not known or used by others in this country and not patented or described

in any printed publication in this or any foreign country before his invention or discovery may make application to the Commissioner of Patents and shall be entitled to a patent therefor. In this case it is only necessary to notice the law as it relates to the subject of an improvement upon a machine. Such an improvement, to constitute an invention within the meaning of the law, must be new—not known or in use before—and it must be useful; in other words, the person claiming the improvement must have found out by himself and created or constructed an improvement which had not been found out or produced by any person, and which is beneficial to the public. There must be novelty in the construction of the improved machine—novelty created by or originating in the mind of the person claiming to be the inventor. The Supreme Court of the United States has recently said on this subject that it is not enough that a thing shall be new in the sense that the shape or form in which it is produced shall not have been before known, and that it shall be useful, but that it must, under the Constitution and the statutes, amount to an invention or discovery on the part of the person claiming the invention; and in May last that same high Court declared that where the mode of construction of the article claimed, the material employed, the form after construction, and the purpose for which it was to be used had been described separately in earlier patents, although the article itself had never been described
108 in any single patent, and to that extent was novel and new and was of great utility, it did not require invention to produce it, and was not, therefore, patentable. Improvements, though new and useful, are not necessarily or *prima facie* inventions; they may or may not be patentable. The dividing line between improvements which involve invention and those which do not is often difficult, if not impossible, to define with accuracy.

Like the colors of the rainbow, it may often be difficult to distinguish the dividing line between them; still the law makes a distinction, and in order to enable you to determine the question submitted to you for your consideration, viz., whether the improvement in the Irwin patent lantern involved and required the exercise of invention on his part or only mechanical skill, evidence has been introduced as to the character, condition, and progress of the manufacture of lanterns prior and up to the date of his alleged invention.

This is called the "state of the art" or the subject of lantern manufacture, and it intended to show the exact relation which the Irwin improvement bore to what preceded it. Irwin and the plaintiff, as his assignee, are chargeable with motive or knowledge of all the facts and information connected with lanterns in use at the date of his improvement. Whether he knew it or not, he is charged under the law with the knowledge of everything that was before it, and the patent issued to him in 1865 must be read in the light of this previous state of the art in order to ascertain whether that improvement involves anything so new, useful, and original or distinct as to amount to an invention.

If nothing more appeared in evidence than the patent issued to

Irwin and the model of his lantern the plaintiff would pre-
109 sent a *prima facie* case that the improvement is patentable, and that the patentee was the original and first inventor; but, the state of the art being shown, you are not bound by any presumption of patentability in that improvement. You must determine from the evidence whether the improvement in question or invention was a novelty created by or originating in the mind of Irwin or was deduced as a matter of inference, reasoning, or mechanical skill from the then status and condition of the lantern manufacture which he is chargeable with knowing. Was the improvement, under the state of the art, one which might or would reasonably suggest itself to a skillful workman in that particular business?

If so, it would not be patentable as an invention. In this connection it is proper for you to consider the evidence of Irwin himself, that his improvement was suggested by the prior patent of one Westlake.

In connection with this question, gentlemen of the jury, you must understand in what the alleged patent of Irwin consisted. Where the prior state of the art is such that the field of invention is limited and circumscribed, not admitting of a great, original discovery, the invention of a patentee must be confined strictly to the claim he makes.

His claim is the very soul or life of the patent, as the courts have expressed it.

What Irwin claimed as his invention was "securing a removable lantern top to the upper part of the guard substantially as herein specified and described." That is his claim in his own language; but the description in the previous specifications explained simply how this "removable top" is secured and some of its benefits and advantages.

110 That specification does not enlarge or change his claim or entitle him to include in his patent anything more than the securing of a removable lantern top in the manner therein described. The plaintiff Adams explains in his deposition in this case in what this alleged invention consists as follows. This is a question and answer:

"Then, if I understand you, you consider as a distinctive feature of the invention that the lantern top should not be wholly removable from the guard frame, but that, on the contrary, the fastening on the one side should be permanent in the nature of a hinge, so as to always keep the parts together, while the fastening on the other side should be a catch or a like device of some kind to hold that side of the top down when in use. Is my understanding correct?

"Ans. It is."

And also cross-question No. 33:

"Q. The invention, then, resides in the difference between the cover or top fastened by a hinge and catch or other equivalent, on the one hand, and a cover or top removably fastened by the other

common and well-known device in mechanics—such as guards, screws, spring catches, bayonet joints, etc. Am I correct?

"Ans. In my opinion, it does."

Now, the scope of the claim and alleged invention, as construed by the court, being limited and confined to the securing of a removable lantern top to the upper part of the guard, as described in the specification, the question for you to determine from the evidence is, Did this improvement involve the exercise on
111 Irwin's part of anything more than the mechanical skill of a competent workman in that business? If he did nothing more than take a lantern top such as he could have then found in use and secure it to the guard of the lantern, as described in the specification, by a hinge and catch substantially as lantern tops had previously been fastened to the guard, his improvement would not amount to an invention.

Whether such removable lantern tops secured substantially in the same way as described by Irwin in his claim and specification were previously known or in use you must determine from the proof, including the patents and exhibits in evidence before you. You are especially referred to the English Sutherland patent of 1857 and the Morely patent of 1854.

Now, if there is a removable lantern top in either of these patents secured by a hinge on the guard with any fastening, you have a right to say that this improvement of Irwin's was not an invention. It appears upon simple inspection that the lantern tops of these patents—Sutherland's and Morley's—and the mode of securing the same to the guard differ in some respects from Irwin's arrangement, but the mere change of location of the parts of a mechanism, so long as no different or additional function is performed, does not make the change patentable. Such alteration or modification is not aided by the fact that one of the parts thus transposed performs a double function if the same device had been before used to perform the same function separately.

The difference in the hinge or catches is not an inventive matter, and is not patentable.

112 While, therefore, it may be true that none of the lanterns referred to are equal to Irwin's in beauty of form or convenience of adaptation to the purpose for which it was intended, yet, if every part has been anticipated and used in some form or other for the very purpose and uses to which it is applied in his claim and patent, he could not be properly regarded as the inventor of the same. Now, under these instructions and your consideration of the evidence, you must answer that question and say whether his improvement required the exercise of invention or was merely the result of reason and mechanical skill in that art.

The next question to which you are asked to respond is this: "Had the invention claimed in the Irwin patent, No. 50591, dated Oct. 24, 1865, been patented or described in any printed publication prior to Irwin's supposed discovery or invention thereof?" Was it included in any previous publication?

The defendant, in this branch of the case, has introduced the following evidence: He has called attention to the patent of Waterman, issued in 1849. He has called attention to the patent of Morely, issued in 1854; the Max Miller, in 1858; the English Sutherland patent, in 1857, and to Irwin's patent, No. 47551, issued on the 2d of May, 1865. These patents, with their models, are produced in evidence, and they antedate the Irwin patent in controversy. It is for you to determine whether they substantially cover or embrace his claim or improvement in the present patent.

The publication of the Sutherland patent antedates Irwin's patent, as shown by the evidence. That publication, with the specifications of his patent, is before you.

113 It is also in evidence that a workman in the art of lantern manufacture has from that specification actually constructed a Sutherland lantern, which is exhibited for your inspection and examination. Has that a removable top secured to the outer frame so as to open and allow of the removal of the loose globe contained therein? If so, and that is a part of the description of that English patent, it is substantially what is claimed in the Irwin patent.

A description in a prior publication, in order to defeat a patent, must be in such terms as would enable a person skilled in the art to make, construct, or practice the invention as he could from a prior patent or from the patent itself. It is for you to determine whether that description is such as enables him to construct that lantern, and whether it has a top formed in the manner indicated. If it does it antedated his (Irwin's) patent, because it was published in 1857, and his claim to the invention only dates back to the fall of 1864. If the jury find from the evidence that the plaintiff's lantern has been anticipated in everything else except the hinge they must also find for the defendants on this issue, for the hinge was old. If the jury find from the evidence that the plaintiff's assignor, Irwin, had been anticipated in the construction of his lantern in every part of it pertaining to the invention in controversy, except that the prior lantern used two catches instead of a hinge and catch for securing the removable top to the upper part of the guard, but which hinge and catch had been used in either lanterns for securing a removable top to the part of the guard and was well known, then the substitute of the old hinge and catch for the two old catches required no invention, but involved simply mechanical skill,

114 which is not patentable, and they must find for the defendants. Look also at these other models introduced in evidence—the Morley, the Max Miller, and the Waterman—and see whether they secured or suggested a removable lantern top fastened by a hinge on the one side and some sort of a catch on the other. If they did they anticipated Irwin's patent.

But, gentlemen, the inventor may also anticipate himself; Irwin may, in this case, have anticipated himself.

He took out a patent, No. 47551, on the 2d of May, 1865, which is in evidence before you, with its claim and specification, which you must consider in determining whether the improvement described therein is substantially the same thing as in the patent in contro-

versy, there being a simple difference in the location of the point on the frame or guard where the hinge is located.

Now, having taken that patent of the 2d of May, 1865, if it substantially covers or suggests the patent taken in the fall of 1865—the one in controversy here—these two patents could not stand. One must fall. One is void, and it is not the last. If there is identity in the mode of operation or mechanical structure with no substantial difference, and Irwin takes out two patents, although the last may have been the first invented, yet, after the date of that invention, if he takes out a patent that substantially anticipates it, the first patent taken out is the valid one and the second one is void. These two patents, if they are substantially the same in the matter of the location of the hinge, must be considered the same, for the hinge then cuts no figure in the patent if they perform the same function. If the top, either breaking in the middle or near the top of the globe, performs the same function in the two patents,
115 then they would be substantially the same, and the first taken out is the valid patent and the second one would be void. A patentee cannot claim the same thing described by him in a prior patent in which there is no reservation, and what he omitted to claim and reserve in a prior patent in which the invention was described he dedicates to the public.

If Irwin, in 1865, in his first patent failed to properly claim this thing and did not reserve it he dedicated it to the public, and he could not substantially take out a new patent in the fall of 1865 if it covered substantially the same thing, and the latter patent would be void. Whether the two patents cover the same thing must be determined by the scope of the claim in the latter patent rather than by the description in the specification; so he may have anticipated himself as well as have been anticipated by previous patents and prior publications. You must answer that question, therefore, in the light of these instructions and these patents, and say whether he is anticipated by a previous patent, including his own issue of May, 1865, or by any other public action.

The question is: "Was Irwin the first discoverer of any part of this invention which was patentable?" That is covered by the preceding instruction.

The next question is: "Have the defendants infringed the plaintiff's patent, No. 50591, dated Oct. 24, 1865?" If this patent of the plaintiff can be claimed to be a new invention, it must be for combination of device, which amounts to a new lantern, in which case you must find that the defendants have duplicated that, for you cannot, in view of the state of the art, consider equivalents in patents for mere improvements; it must be the same device
116 and the same invention. It must be substantially a duplicate of the patented invention. But that, gentleman, is a question for you to determine.

The last question submitted is this: "Does the evidence show and establish a license fee or royalty for the use of the plaintiff's patent, No. 50591, now in suit? If so, during what period and at what rate?"

The burden of proof is on the plaintiff to prove such an established fee or royalty to your satisfaction. The sale of a single license, such as that made by Irwin to Adams in 1866, is not sufficient to establish a royalty or uniform license fee. Were the licenses granted by the plaintiff since the 27th day of Oct., 1879, under the patents No. 47551, dated May 2, 1865, and No. 50591, dated Oct. 25, 1865, taken by the licensees in order to get protection of both of said patents in the manufacture of hinged-top lanterns?

Consider these licenses and say what they contain. To be binding on a stranger or infringer sales or licenses must be sufficient in number to establish the fee or royalty charged for the use of the patent as its market value. You, as farmers or business men, would not think of taking the price of a horse in 1866 and fixing that as the price of 1879. You would not be warranted in saying that in 1866 the price was the same as in 1879. These license fees must be sufficient in number to establish the fee or royalty charged, and must also be uniform and be actually paid or secured before defendants' infringement was committed. The license fee or royalty must relate exclusively to the patent claimed to be infringed. It must relate to patent No. 50591 before
117 you can find it to be established at all. License fees for the use of that and another patent blended together would not establish a royalty as to either patent. The royalty must be for the use of the identical patent in controversy and for that alone in order to fix the market value and render it the established fee. If, therefore, it appears from proof in the case that the licenses produced in evidence by the plaintiff embrace or include another patent than the one sued on or that other inducements and agreements than the use of this particular patent, formed in whole or in part the consideration which actually or probably influenced the licensees to pay the royalty therein stipulated, then such license fees would not constitute an established royalty in the particular patent No. 50591, because it could not be assumed or inferred that the license fee agreed to be paid related alone to the use of that one patent when the contract upon its face disclosed other considerations and inducements for the payment of that royalty. The burden is on the plaintiff to show you exactly what was paid as a royalty for that patent and in a sufficient number of instances to establish the market value.

Under such circumstances license fees cannot be regarded as an established royalty for the use of the particular patent in controversy; and, in the absence of other satisfactory evidence as to how the parties to these contracts divided and apportioned that fee between this patent No. 50591 and patent 47550 and the other consideration mentioned and recited in the licenses, it will be your duty to return as your answer to this question that there was no established license fee or royalty on patent No. 50591.

118 Take the case, gentlemen of the jury, and return your answers to these questions. There is evidence which you are not to consider in determining your findings and your responses to these interrogatories. One is the evidence relating to the Duburn

application, which was made some time in 1865—April, 1865—which cuts no figure in this case, and which, therefore, you will not consider.

Then there is the patent of Baron, which also cuts no figure in this case, and which is therefore out of the way.

Whereupon the plaintiff, by his attorney, then and there duly excepted to each and every portion of the said charge of the court to the jury.

And, upon rendering of the verdict of the jury in favor of the defendants, plaintiff then and there moved the court to set aside and vacate the said verdict and to grant a new trial herein, basing said motion upon the following grounds, to wit:

1. Irregularity in proceedings of the court.
2. Misconduct of the defendant.
3. For that the defendant introduced matters and evidence which, by permission of the court, were considered by the jury, then prescribed statutory notice of which had not been given.
4. Surprise, which ordinary prudence could not have guarded against.
5. That the verdict is not sustained by sufficient evidence.
6. That the verdict is contrary to the evidence.
7. That the verdict is contrary to law.

119 8. That the verdict is contrary to the weight of the evidence.

9. Errors of law occurring at the trial and excepted to by plaintiff.
10. Error of the court in its charge to the jury.
11. Error of the court in refusing instructions asked by plaintiff.
12. Error of the court in not permitting this plaintiff to introduce certain testimony offered in evidence at the trial.
13. Error of the court in its rulings on questions of law during the progress of the trial.

(Signed) RAYMOND & RAINEY,
For Plaintiff.

Dated June 9, 1886.

And it is agreed that the hearing of said motion is postponed without prejudice, to be called up and to be determined on reasonable notice by either party to the other.

(Signed) RAYMOND & RAINEY,
For Plaintiff.
GEO. W. DYER,
For Defendant.

Columbus, June 9, 1886.

120 And upon said motion the following special assignment of errors was made and insisted upon by plaintiff:

First. That the court erred in the instruction given and refused concerning the prior art:

1. In refusing an instruction to the jury that before determining the patent sued upon to be invalid by reason of any prior patent it

is not sufficient to find one of the elements in one patent, a second in another, and a third in another.

2. In declining to instruct the jury that the fact that the Irwin lantern practically superseded all others was strong, though not conclusive, evidence of its novelty and utility.

3. In admitting the models offered by defendant and instructing the jury that they were, as a matter of fact, models of prior patents.

4. In instructing the jury that the Sutherland model introduced by the defendants was a model constructed from the Sutherland specifications, and in instructing the jury in effect that the Sutherland specifications were sufficiently full, clear, and exact to enable a workman to construct the Irwin improvement.

5. In instructing the jury in effect that the Irwin patents 47551 and 50591 were substantially the same except in the mere matter of the location of the hinge.

Third. The court erred in the manner of the proper construction of the claim of plaintiff's patent:

1. The final instructions of the court to the jury were that the patent sued upon covered simply and broadly the attaching together of two parts of a lantern by a hinge and a catch as distinguished from securing them by two catches, and we complain that the necessary effect upon the minds of the jury of the court's instructions and of the frequent remarks of the court in the presence of the jury during the progress of the trial was that this was a patent for the mere application of a hinge to a well-known structure.

121

2. In declining the instructions asked by plaintiff that due weight must be given to the words of the claim "substantially as herein specified and described."

3. In declining to give the instruction as to the essential features of the patent sued upon, which instruction was asked by plaintiff in the language used by the circuit court for the northern district of Illinois and substantially in the language used by the circuit court of the southern district of New York construing this patent in prior litigations.

4. In declining to instruct the jury that the general adoption of the Irwin lantern was strong, though not conclusive, evidence of its novelty and utility.

5. In the use made of the extracts quoted from the testimony of Mr. Adams.

Fourth. The court erred in the general tenor and effect of the instructions in that they could have no other effect in the minds of the jury than this, that it was the duty of the jury to find that the plaintiff's patent did not disclose a patentable invention, which, of course, was determinative of the case and practically determinative of each of the special interrogatories to the jury.

And thereupon the court denied said motion to set aside said verdict and for a new trial and ordered judgment to be entered thereon.

J. H. IRWIN.

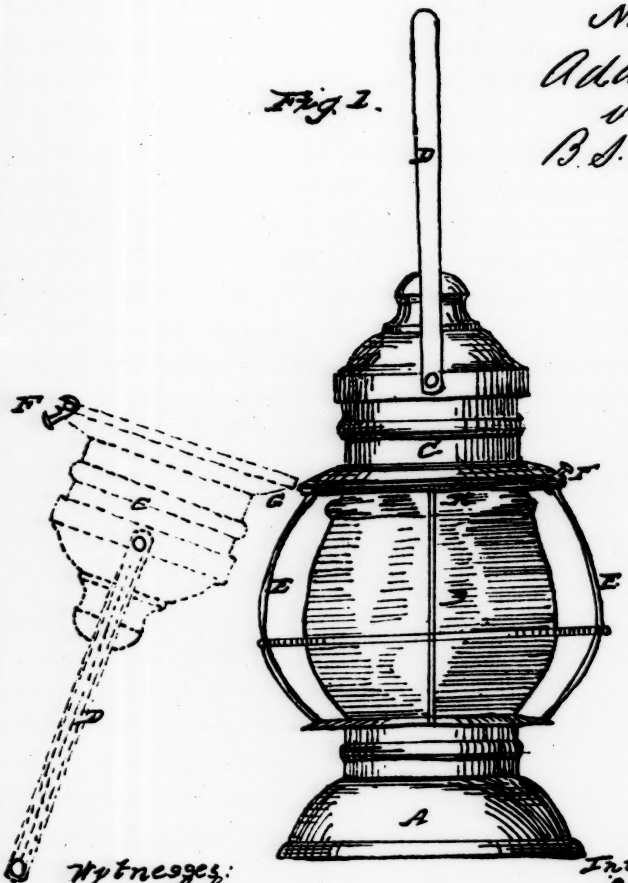
Lantern.

No 50,591. Patented Oct. 24, 1865

123

No. 360
Adams
v.
B. J. Co et al
} 123

Fig 1.



Witnesses:
Samuel Tyler
Geo. C. Nichols

Inventor:
John H. Irwin.
by Coburn & Mann
Attorneys

122 To which order and judgment of the court overruling said motion and entering judgment the plaintiff then and there excepted as being contrary to law.

And thereupon, at the term of said court at which the said order overruling said motion for a new trial, etc., was entered, the following order was, on motion of plaintiff, entered by order of the court, to wit:

"It is ordered that the plaintiff in the above-entitled cause shall have until January 1, 1888, in which to file and present his bill of exceptions in this case."

And because none of said exceptions, etc.—

Now, therefore, this bill of exceptions is signed and sealed by one of the judges who presided at said trial *nunc pro tunc* as of the day of the order that said motion for a new trial be overruled and that said judgment should be entered, this bill being actually signed and sealed within thirty days from the expiration of said term and within the time prescribed by the order of court within which this bill of exceptions should be presented.

[SEAL.] GEORGE R. SAGE,
U. S. District Judge, Southern District of Ohio. [SEAL.]

December 31, 1887.

124 UNITED STATES PATENT OFFICE.

JOHN H. IRWIN, of Chicago, Illinois.

Improvements in Lanterns.

Specification forming part of Letters Patent No. 50591, dated October 24, 1865.

To all whom it may concern:

Be it known that I, John H. Irwin, of the city of Chicago, in the county of Cook and State of Illinois, have invented a new and useful improvement in lanterns, and I do hereby declare that the following is a full, clear, and exact description of the same, reference being had to the accompanying drawing and the letters and figures marked thereon, which form part of this specification.

(Here follows diagram marked p. 123.)

The nature of my said invention consists in attaching the metallic top of the lantern, in which the top of the glass globe or protector enters and by which it is held in place by a hinge, to the upper part of the wire guard surrounding the globe, and securing it at the side opposite said hinge by a removable fastening or spring catch, so that by detaching said catch from the said upper part of the lantern guard the top of the lantern may be thrown back, opening upon the aforesaid hinge, thus enabling the globe to be cleaned or for any other purpose.

125 To enable those skilled in the art to understand how to construct and make use of my invention, I will proceed to describe the same with particularity, making reference in so doing to the aforesaid drawing, in which—

Figure 1 represents a side elevation of my invention, the removable top being represented in two positions.

Similar letters of reference indicate the same parts of my invention in the different positions represented.

A represents the ordinary base or bottom of the lantern containing the oil cup; B, the glass globe or protector; C, the top of the lantern hinged to the upper part of the guards E and G, F being the handle by which the lantern is held or carried from place to place, and F′ the catch arranged opposite the hinge G for holding the lantern top firmly to the guard, H representing an annular wire attached to the upper ends of the guards E.

The full lines in the drawing show the lantern ready for use.

When it is desired to remove the globe or to open the lantern for any other purpose the catch F is pressed downward or inward, releasing the same from the annular wire H or its equivalent for holding catch when the top is swung back upon catch, when the globe can be removed or any other purpose may be accomplished, as desired.

What I claim as my invention, and desire to secure by letters patent, is—

Securing a removable lantern top to the upper part of the guard, substantially as herein specified and described.

JOHN H. IRWIN.

Witnesses:
JAMES F. GRIFFIN.
LEWIS L. COBURN.

126 EXHIBIT B.

(*Certified Copy from the U. S. Patent Office.*)

Liber T 8, p. 289.

Whereas letters patent of the United States of America No. 47551 were on the 2d day of May, A. D. 1865, issued to John H. Irwin, of Chicago, in the county of Cook and State of Illinois, for a new and useful improvement in lanterns;

And whereas other letters patent of the United States, No. 50591, were on the 24th day of October, A. D. 1865, issued to the said Irwin for a certain other new and useful improvement in lanterns;

And whereas letters patent of the United States No. 51798 were on the 2d day of January, A. D. 1866, issued to William Burnes and James F. Griffin, of Chicago aforesaid, for a certain new and useful improvement in lanterns;

And whereas certain other letters patent of the United States, No. 57914, were on the 11 day of Sept., A. D. 1866, issued to the said John H. Irwin for a certain other new and useful improvement in the lanterns;

And whereas John H. Irwin and James F. Griffin above named are now the joint owners of all and singular the above-mentioned patents and inventors therein described;

And whereas the Chicago Manufacturing Company, doing business at Chicago aforesaid, is desirous of purchasing all our
127 right, title, and interest in and to each and all the aforesaid letters patent:

Now, therefore, this indenture witnesseth: That, for and in consideration of the sum of twelve thousand ($12,000) dollars in hand paid, the receipt whereof we do hereby acknowledge, we, the said John H. Irwin and James F. Griffin, have sold, transferred, and assigned, and do hereby sell, transfer, and assign, unto the said Chicago Manufacturing Company all our right, title, and interest in and to each and every and all the aforesaid letters patent; to have and to hold the same unto the said Chicago Manufacturing Company, its successors and assigns, for its and their sole benefit and behoof to the full end of the term for which the said patents were granted as fully and entirely as the same would have been held and enjoyed by us had this sale and assignment not been made.

Witness our hands and seals on this 6th day of October, A. D. 1866.

JOHN H. ERWIN. [SEAL.]
JAMES F. GRIFFIN. [SEAL.]

In presence of—
J. S. DENNIS.

Recorded Oct. 9, 1866.
Ex'd: C. F. E.; L. L.

128 EXHIBIT C.

We, the undersigned, James F. Griffin, Joseph S. Dennis, Calvin O. Wasson, and John H. Irwin, all of the city of Chicago and State of Illinois, being desirous of organizing ourselves into a joint stock company for the purpose of carrying on the manufacturing business hereinafter specified, do therefore, in conformity with the provisions and by the authority of an act of Legislature of the State of Illinois entitled "An act to authorize the formation of corporations for manufacturing, mining, mechanical, and chemical purposes," approved on the 18th day of February, A. D. 1857, and the other acts subsequently passed in addition thereto, hereby certify as follows:

1. First. That the name of the said company shall be the "Chicago Manufacturing Company."

2. Second. That the object for which said company is formed is to manufacture and sell lamps, lanterns, and other illuminating apparatus and such other goods as may in any way appertain thereto.

3. Third. That the amount of the capital stock of the said company shall be one hundred and thirty thousand dollars, and the number of shares in the said stock shall be two thousand and six hundred of the par value of fifty dollars each.

4. Fourth. That the term of the existence of said company shall be fifty years.

5. Fifth. That the number of the directors of said company shall be four, and the following-named persons shall constitute the board of directors for the first year and until their successors shall
129 have been chosen, to wit: James F. Griffin, Joseph S. Dennis, Calvin O. Wasson, and John H. Irwin.

6. Sixth. That the operations of said company are to be carried on in the city of Chicago and State of Illinois, but branches or auxiliary operations may be carried — at other points if deemed proper.

In testimony whereof we have hereunto, and a duplicate hereof, set our hands on this 10th day of Feb., A. D. 1866.

[5-ct. revenue stamp.]

JAMES F. GRIFFIN.
JOHN H. IRWIN.
JOSEPH S. DENNIS.
CALVIN O. WASSON.

STATE OF ILLINOIS, }
County of Cook, City of Chicago, } *ss:*

I, James M. Marshall, a notary public in and for said city of Chicago, do hereby certify that James F. Griffin, Joseph S. Dennis, Calvin O. Wasson, and John H. Irwin, who are severally personally known to me to be the same persons whose names are subscribed to the foregoing instrument, personally appeared before me this day and severally acknowledged that they made and signed the foregoing certificate voluntarily for the purposes therein set forth.

Given under my hand and notarial seal this 10th day of Feb., A. D. 1866.

[5-ct. revenue stamp.]

JAMES M. MARSHALL,
[SEAL.] *Notary Public.*

130 UNITED STATES OF AMERICA, }
State of Illinois, } *ss:*

OFFICE OF SECRETARY.

I, Henry D. Dement, secretary of state of the State of Illinois, do hereby certify that the foregoing is a true copy of the articles of incorporation of the Chicago Manufacturing Company, the original of which is on file in this office.

In witness whereof I hereto set my hand and affix the great seal of State, at the city of Springfield, this 4th day of June, A. D. 1886.

HENRY D. DEMENT,
Secretary of State.

131 And afterwards, to wit, on the 31st day of Dec., A. D. 1887, the following error bond was filed in the clerk's office of the court aforesaid, clothed in the words and figures following, to wit:

Error Bond.

Circuit Court of the United States, Southern District of Ohio, Eastern Division, *ss:*

J. McGREGOR ADAMS
vs.
BELLAIRE STAMPING CO. *et al.*

Know all men by these presents that we, J. McGregor Adams, as principal, and Joseph Kinsey, as surety, are held and firmly bound unto the Bellaire Stamping Company in the sum of one thousand dollars, to be paid to the said Bellaire Stamping Company, its successors or assigns; to which payment, well and truly to be made, we bind ourselves and each of us, jointly and severally, and our and each of our heirs, executors, and administrators, firmly by these presents.

Sealed with our seals. Dated this 30th day of December, 1887.

Whereas the above-named J. McGregor Adams has sued out a writ of error to the Supreme Court of the United States to reverse the judgment rendered in the above-entitled action by the circuit court of the United States for the southern district of Ohio:

132 & 133 Now, therefore, the condition of this obligation is such that if the above-named J. McGregor Adams shall prosecute *their* said writ of error to effect and answer all costs if he shall fail to make good his plea, then this obligation to be void; otherwise to remain in full force and virtue.

J. McGREGOR ADAMS. [SEAL.]
JOSEPH KINSEY. [SEAL.]

Sealed and delivered in presence of—
J. H. RAYMOND.
OLIVER KINSEY.

The above security is approved.

GEORGE R. SAGE,
District Judge of the United States, S. D. O.

134 THE UNITED STATES OF AMERICA, *Southern District of Ohio, Eastern Division,* } *ss:*

I, B. R. Cowen, clerk of the circuit court of the United States within and for the division and district aforesaid, do certify that the foregoing is a full, true, and complete transcript of the proceedings had in the above-entitled cause by and before said court as the same appears of record in said court.

Seal of the Circuit Court, South'n Dist. of Ohio.

In witness whereof I have hereunto set my hand and affixed the seal of said court, at Cincinnati, this fourth day of February, A. D. 1888.

B. R. COWEN, *Clerk,*
By R. C. GEORGI, *Deputy.*

135 THE UNITED STATES OF AMERICA, *ss:*

The President of the United States of America to the judges of the circuit court of the United States for the southern district of Ohio, Greeting:

Because in the records and proceedings and also in the rendition of the judgment of a plea which is in the said circuit court, before you, between J. McGregor Adams and The Bellaire Stamping Company *et al.*, a manifest error hath happened, to the great damage of the said J. McGregor Adams, as by his complaint appears, we, being willing that the error, if any hath been, should be duly corrected and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that, under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Supreme Court of the United States, together with this writ, so that you may have the same at the city of Washington on the second Monday of October next, in the said Supreme Court to be then and there held, that, the record and proceedings aforesaid being inspected, the said Supreme Court may cause further to be done to correct that error what of right and according to the laws and customs of the United States should be done.

Witness the Honorable Morrison R. Waite, Chief Justice of the said Supreme Court, the 31st day of December, 1887, in the year of our Lord one thousand eight hundred and eighty-seven.

Seal of the Circuit Court, South'n Dist. of Ohio.

B. R. COWEN,
Clerk of the Circuit Court of the U. S., S. D. O.

[Endorsed:] United States circuit court, S. D. O., E. D. No. 173. J. M. Adams *vs.* The Bellaire Stamping Co. *et al.* Writ of error. Filed —— —, 18—. — — ——, clerk.

136 THE UNITED STATES OF AMERICA, *ss:*

To The Bellaire Stamping Company, J. T. Mercer, and C. H. Tallman, Greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States, to be holden at the city of Washington on the second Monday of October next, pursuant to a writ of error filed in the clerk's office of the circuit court of the United States for the southern district of Ohio, wherein J. McGregor Adams is plaintiff and you are defendants in error, to show cause, if any there be, why the judgment in the said writ of error mentioned should not be corrected and speedy justice be done to the parties in that behalf.

Witness the Honorable Morrison R. Waite, Chief Justice of the

said Supreme Court, this 31st day of December, in the year of our Lord one thousand eight hundred and eighty-seven.

[Seal of the Circuit Court, South'n Dist. of Ohio.]

GEORGE R. SAGE,
District Judge of the Southern District of Ohio,
Sitting and Holding the Circuit Court of said District,
No Circuit Judge or Circuit Justice Being Present.

137 [Endorsed:] 1, 10, '88. United States circuit court, S. D. O., E. D. No. 173. J. M. Adams — The Bellaire Stamping Co. *et al.* Citation to defendants in error. Filed Jan'y 18, 1888. B. R. Cowen, clerk. Service 13th.

Received this writ at Columbus, Ohio, 31st day of December, 1887, and on the 13th day of January, 1888, I gave a true copy of this to J. T. Mercer, and at same time I handed another true copy to J. T. Mercer as president of the Bellaire Stamping Co., and at the same time I gave a true copy of this writ to C. H. Tallman; also, at the same time, I handed another true copy of this writ to C. H. Tallman as secretary of the said named corporation, the Bellaire Stamping Co., at Bellaire, Ohio.

HENRY C. URNER, *U. S. Marshal.*
WILLIAM S. DRESBACK, *Bailiff.*

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Endorsed on cover: S. Ohio C. C. U. S. No. 360. J. McGregor Adams, plaintiff in error, *vs.* The Bellaire Stamping Company, J. T. Mercer, and C. H. Tallman. Filed May 1, 1888.

Office Supreme Court U. S.
FILED
OCT 16 1891
JAMES H. McKENNEY,

Supreme Court of the United States.

OCTOBER TERM, 1891.

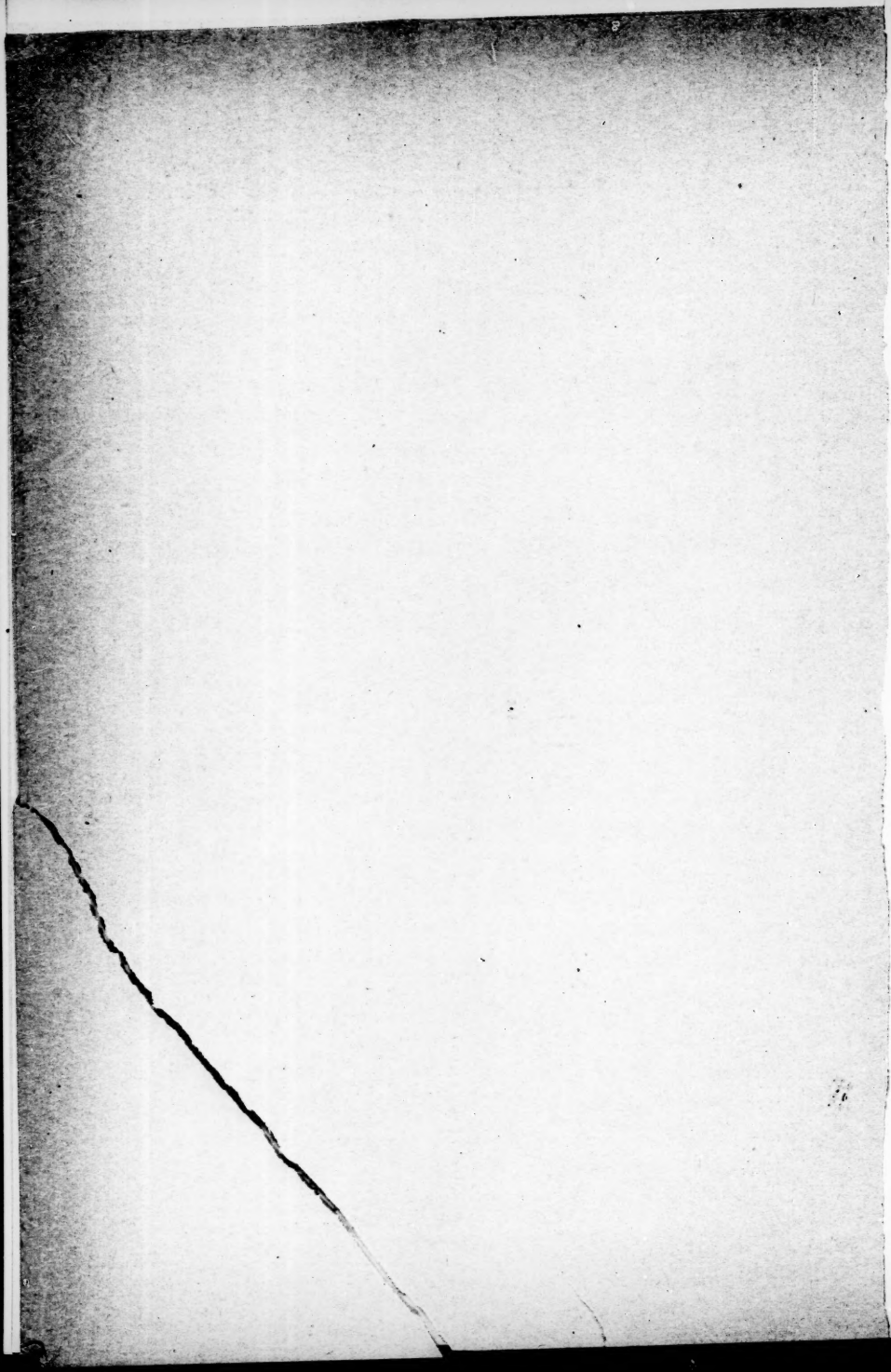
No. 50.

J. McGREGOR ADAMS,
Plaintiff in Error,
vs.
BELLAIRE STAMPING COMPANY, *et al.*,
Defendants.

BRIEF FOR PLAINTIFF IN ERROR.

J. H. RAYMOND,
Att'y, and of Counsel for Plaintiff.

TEMPLE COURT, CHICAGO,
September 25, 1891.



Supreme Court of the United States

OCTOBER TERM, 1891.

J. McGREGOR ADAMS,
Plaintiff in Error,
vs.
BELLAIRE STAMPING COMPANY, *et al.*,
Defendants.

BRIEF FOR PLAINTIFF IN ERROR.

This is a suit at law, brought by the plaintiff in error for the infringement of Letters Patent No. 50,591, issued October 24, 1865, to John H. Irwin, for improvements in lanterns, in which the plaintiff complains of an unfair trial below.

The suit was tried before the U. S. Circuit and District Judges, for the Southern District of Ohio and a jury, in 1886, Judge Jackson presiding.

Supreme Court of the United States

OCTOBER TERM, 1891.

J. McGREGOR ADAMS,
Plaintiff in Error,
vs.
BELLAIRE STAMPING COMPANY, *et al.*,
Defendants.

BRIEF FOR PLAINTIFF IN ERROR.

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The suit was tried before the U. S. Circuit and District Judges, for the Southern District of Ohio and a jury, in 1886, Judge Jackson presiding.

STATEMENT.

The patent in suit had been previously twice sustained in most thoroughly contested equity proceedings, once before Judge Blodgett, in the Northern District of Illinois (4 Ban. & Ard. 543; S. C. 18 O. G. 412), and once before Judge Wallace, in the Southern District of New York (19th Fed. Rep. p. 317).

The patent (Trans. p. 67), to use the language of the prior adjudications, is for the following invention :

"The leading feature of this patent is the construction "of a *loose globe* lantern, so arranged that the globe can "be readily removed and replaced, and at the same time "have the metallic parts of the frame permanently at- "tached together so as to make a basket, in which the "globe will be held or retained, even if the catch holding "the top or dome to the frame of the lantern is unfast- "ened. This is obtained by hinging the top or dome to "the guard on one side, so that it can be closed firmly to "the guard by the operation of the hinge and a catch on "the side opposite the hinge, so that when the top or "dome is lifted or thrown back on the hinge the globe can "be removed from the guard." (Trans. p. 58).

Prior to the introduction of this lantern, the devices in use were "made in a variety of forms. The principal "amount were made by plastering the top and bottom of "the globe to the top of the lantern and to its bottom "hoop, where they became one part. They were sur- "rounded by their guards, also soldered to the top and "bottom, thus making the globe non-detachable, except "by breaking the plaster and unsoldering the guards. A "second class of lanterns were made by cementing the

"top and bottom of the lanterns on the globe with a "removable guard. Another class were the lanterns "cemented to the bottom hoop, and held in place by "springs or lugs to the guards, permanently attached to "the top flange of the lantern." (Trans. pp. 32 and 33).

The Irwin patent came into general use, every manufacturer in the country, with only three or four exceptions, taking licenses thereunder (see list, Trans. p. 35); and the railroad companies of the country, who are the principal users of these lanterns, adopted them to almost a universal extent (Trans. 33, 34), and through their regularly constituted authorities, — the Eastern and Western Railroad Associations, which in patent matters represent, with inconsiderable exceptions, the entire railroad interests of the United States,—acquiesced in the validity of this patent, and the officers and employes of the railroad companies were instructed by circulars and letters that they could not safely buy lanterns manufactured in accordance with this Irwin patent except from those who held licenses thereunder. (Trans. p. 34).

It is contended on the part of the plaintiff that the errors hereinafter to be noted show, only too plainly, that the Circuit Judge, at the commencement of the trial, came to the conclusion that this patent was invalid for want of patentable novelty; and, by his conduct of the trial and his charge to the jury, made it a necessity that the jury should so find.

The jury, finding the patent to be invalid, of course, found, being especially interrogated concerning the same, that there was no infringement, and that there was no damages.

The amount of the use by the defendants is stipulated (Trans. p. 26) to be 120,503 $\frac{5}{12}$ lantern frames and lanterns complete, which, at the rate of royalty established by the licenses granted by the plaintiff, amounts to over $60,000.

ASSIGNMENTS OF ERRORS.

The formal assignment of errors include all of the thirteen grounds set forth in the applicable Ohio Statute (Trans., p. 62). The assignments of errors then and now especially insisted upon by the plaintiff are as follows:

First. The Court erred in the instructions given and refused concerning the prior art.

"1. In refusing an instruction to the jury that before "determining the patent sued upon to be invalied *by* "*reason of any prior patent*, it is not sufficient to find one "of the elements in one patent, a second in another, and "a third in another.

"2. In declining to instruct the jury that the fact that "the Irwin lantern practically superseded all others was "strong, though not conclusive, evidence of its novelty.

"3. In admitting the models offered by defendants, "and instructing the jury that they were, as a matter of fact, models of prior patents.

"4. In instructing the jury that the Sutherland "model introduced by the defendants was a model con- "structed from the Sutherland specifications, and in "instructing the jury in effect that the Sutherland specifi- "cations were sufficiently full, clear, and exact to enable "a workman to construct the Irwin improvement.

"5. In instructing the jury in effect that the Irwin "patents 47,551 and 50,591 were substantially the same, "except in the mere matter of the location of the hinge.

Second. The Court erred in the matter of the proper construction of the claim of plaintiff's patent.

"1. The final instructions of the Court to the jury "were that the patent sued upon covered simply and "broadly the attaching of two parts of a lantern by a "hinge and a catch as distinguished from securing them "by two catches, and we complain that the necessary "effect upon the minds of the jury of the Court's instruc- "tions, and of the frequent remarks of the Court in the "presence of the jury during the progress of the trial, "was that this was a patent for the mere application of a "hinge to a well-known structure.

"2. In declining the instructions asked by plaintiff, "that due weight must be given to the words of the claim, "'*substantially as herein specified and described.*'

"3. In declining to give the instruction as to the essen- "tial features of the patent sued upon, which instruction "was asked by plaintiff in the language used by the Circuit "Court for the Northern District of Illinois, and substan- "tially in the language used by the Circuit Court for the "Southern District of New York, construing this patent in "prior litigations.

"4. In declining to instruct the jury that the general "adoption of the Irwin lantern was strong, though not "conclusive, evidence of its novelty and utility.

"5. In the use made of the extracts quoted from the "testimony of Mr. Adams.

"*Third.* The court erred in the general tenor and "effect of the instructions, in that they could have no "other effect in the minds of the jury than this, that it "was the duty of the jury to find that the plaintiff's patent "did not disclose a patentable invention, which of course "was determinative of the case, and practically determin-"ative of each of the special interrogatories to the jury." (Trans. 65, 66).

ARGUMENT.

A discussion of the manifest errors of the record concerning the question of damages seems unnecessary, for if the construction which the Circuit Court gave to the plaintiff's patent be fair and correct, then all other questions are immaterial; so, also, if the finding of the jury, under the instructions of the court, that there was no patentable novelty in plaintiff's patent be correct, then, of course, there was no infringement.

The Proper Construction of Irwin's Patent.

If the position of the Circuit Court and of defendants' counsel, that this is simply a patent upon a hinged lid, as distinguished from a lid or cover held in place by two screws or two catches, be unfair and incorrect, then a trial *de novo* should be awarded.

To disregard the "loose globe" feature and the "basket" construction, and the other elements already named, and to mimify this patent by utterly disregarding the words of the claim "substantially as herein specified "and described," into a patent upon a coffee-pot lid, is repugnant to the principles and precedents governing the fair, not to say liberal, construction of letters patent for inventions.

The trade name under which the patent has been universally bought, sold and used is "The hinged-top, loose-"globe lantern."

The patent (Trans. 67) clearly specifies a base, a globe which is loose instead of being cemented in place either at its top or at its bottom bearing, a wire basket, which surrounds and protects this globe, to the top ring of which basket the metal top or dome of the lantern is fastened, all so constructed and secured as to complete a new structure having several novel features, as, for instance: (1) the top or dome when closed rests upon the top of the loose globe and holds it in place; (2) but when by accident the top is unfastened, the swinging or usual handling of the lantern will not spill and break the globe; and (3) "thus enabling the globe to be cleaned, or for any other "purpose." *Each of these features is fully and clearly set forth in the specifications, and any ordinary, intelligent manufacturer, purchaser or user, interested in this art, would, upon a single reading of the patent, conclude that they made up the invention intended to be secured.*

There is nothing here interpolated by the fancy or the astuteness of experts or counsel. It is all plainly contained in the succint specifications of the patent.

The Circuit Courts for the second and seventh Circuits were both fair and correct in finding that the patent consisted in the arrangement by which the globe is retained and can be readily removed and replaced, the metallic parts of the frame being permanently attached together to form a protecting basket, and holding or retaining the globe even if the catch is unfastened.

"*This is accomplished*," says Judge Blodgett, "by "hinging the top or dome," etc., substantially as specified and described in the specifications of the patent.

To single out one of the mechanical elements of construction (the hinge) by which these results are accomplished, and to say that that old element constitutes and comprises the invention claimed, simply because the claim of the patent uses the word "securing," we submit, is both unfair to the patent and incorrect as a matter of legal construction.

The claim of the patent reads:

"Securing a *removable lantern top* to the *upper part* of "*the guard, substantially as herein specified and described.*"

This, plainly, upon its face, means such a *protecting guard* as is described, containing and retaining the *loose globe* described, and a *removable top*, "in which the top of "the glass globe or protector enters, and by which it is "held in place, secured thereto as specified and described."

By a hinge or its equivalent? Certainly so, because it, or its equivalent, properly located between the particular parts pecified, is a necessary means of securing those parts together in the manner, for the purpose and to the results specified and described.

Upon this question of the proper construction of plaintiff's patent the Circuit Court specially erred (1) in refusing to instruct the jury that due weight must be given to the words, "substantially as herein specified and described," and (2) in instructing the jury (Trans. p. 60, fol. 110) as follows:

"The description in the previous specifications [of this patent] explained how this removable top is secured, "and some of its benefits and advantages. That specifica- "tion does not enlarge or change his claim or entitle him "to include in his patent anything more than the securing "of a removable lantern top in the manner therein described," thus entirely ignoring the words in the claim, "upper part of the guard," and "substantially as," etc., and utterly ignoring the uses, purposes, construction and results specified and described.

Continuing this subject, and at the same time in part anticipating the errors as to the prior art, we call special attention to the following quotations from the instructions:

"The specification does not enlarge or change his claim "or entitle him to include in his patent anything more "than the *securing of a removable lantern top in the man-* "*ner described.*" * * * "Now, if there is a remov- "able lantern top in either of these (prior) patents "secured by a hinge on the guard with any fastening, you "have a right to say that this improvement of Irwin's was "not an invention." * * * "Yet, if every part had "been anticipated, and used *in some form or other* for the "very purpose and uses to which it is applied in his claim "and patent, he could not be properly regarded as the "inventor of the same." * * * "If the jury find "from the evidence that the plaintiff's lantern had been "anticipated in everything else except the hinge, they must "also find for the defendant, for the hinge was old." * * * "The substitution of the old hinge and catch "for the two old catches required no invention, but in- "volved simply mechanical skill, which is not patentable,

"and they must find for the defendants. Look also at "these other models introduced in evidence, the Morley, "the Max Miller and the *Waterman, and see whether they* "*secured or suggested a removable lantern top fastened* "*by a hinge on the one side, and some sort of a catch on the* "*other.* IF THEY DID, THEY ANTICIPATED IRWIN'S PATENT." * * *

Referring to the first Irwin patent, "you must "consider" (it) "in determining whether the improve- "ment described therein is substantially the same thing as "the patent in controversy, *there being a simple difference* "*in the location of the point on the frame or guard where* "*the hinge is located.*"

It is difficult with patience and with perfect propriety to discuss the proposition that these specifications and this claim are legally resolvable into a patent upon a hinge. That proposition obtained below; and it was not right.

Counsel for defendant now insists upon the above proposition and then, and inconsistently, insists that this patent, properly construed, is a patent upon a new combination of old elements, and, being such, is subject to the criticisms (1) that it is upon a non-patentable combination, for that it is a combination of mechanical elements which do not co-act; and (2) that it is upon a non-patentable combination, for that it is a mere aggregation of elements, the assemblage of which did not involve the exercise of the inventive faculty.

To this we reply:

1. The positions thus taken, and the arguments made by the defendants' counsel demonstrate the incorrectness

of the conclusions of the trial Judge, that this is a patent, when properly construed, simply upon a hinge.

2. The particular parts secured together as specified *do* co-act within all the requirements of the rules of decision in patent cases. The top holds the loose globe in place, it also holds and is secured to the guard or basket from which the bottom is suspended. Take away any one part named in the claim, and the result would be incomplete and useless.

3. The combination, if such it is convenient to call it, *does* import invention rather than the mere convenient assemblage of parts.

Again—

If there were no other error in this record, the refusal of the court to instruct the jury that the facts that the Irwin lantern was accepted by the trade, was largely in demand, and practically superseded all previous lanterns for the same use, were very strong, though not conclusive, evidence of its novelty and utility in the sense in which those terms are used in patent laid, if there was no other error in this record than this, it would be sufficient ground upon which to award the plaintiff a new trial, for upon the question of patentable novelty these considerations have ever been considered of weight and importance in the determination of this question of fact. It is a question of fact which should in all cases go to the jury without anything in the nature of peremptory instructions.

The plaintiff should have been given "the benefit of "every inference that could have been fairly drawn from "the evidence, written and oral."

Marshall v. *Hubbard*, 117 U. S. 419.

Such facts are ever conclusive upon the question of utility, and have ever been held as strong and even in many cases presumptive evidence of patentable novelty. The reason for giving such weight to such facts is this: Universal adoption, to the exclusion of previous devices, is conclusive evidence of a public want. That the want remained unsatisfied till supplied by the patentee, is at least presumptive evidence that he "brought to light that "which had remained hidden," and devised that which mere mechanical skill had failed to produce.

It seems certain that (1) the prior art should have been considered by the jury in the light of such an instruction as was refused; and that (2) if the plaintiff had been allowed this or any similar instruction, the minds of the jury would have been thereby otherwise and materially influenced both in comparing Irwin's improvement with the prior art and in considering the question whether Irwin's improvement amounted to invention.

A sufficient citation to the correctness of the instruction asked, is *Consolidated Valve Co.* v. *Crosby Valve Co.* (113 U. S. 157), decided by the Supreme Court in 1885, in which the fact of general adoption is repeatedly insisted upon as evidence of patentable novelty, although the prior devices (and especially the Webster) embodied all the parts of the patent sued upon and for identical purposes, and resembled the plaintiff's valve in purpose, in general make up and appearance, and in operation.

That these considerations of general adoption to the exclusion of all prior devices for the same purpose, are material facts in the case and are proper to be considered, has never been denied, and it is well settled that the parties are entitled, of right, to proper instructions, either as asked or in a modified form, as to all material facts known.

Again—

The patent is *prima facie* valid, and the trial judge though technically, by using the words "are not *bound*," may in a sense be said to have been right, yet he was in error when he said to the jury :

"If nothing more appeared in evidence than the patent "issued to Irwin and the model of his lantern, the plain- "tiff would present a *prima facie* case that the improve- "ment is patentable, and that the patentee was the orig- "inal and first inventor; but, the state of the art being "shown, you *are not bound* by any presumption of pat- "entability in that improvement." (Trans. 59, 60).

Again—

While plaintiff was making his *prima facie* case, the deposition of an expert (D. J. Powers) was being read from as to the question of the utility of plaintiff's device, whereupon the following proceedings were had in the presence of the jury :

"THE COURT: The witness whose testimony you read "must confine his statement as an expert to the construc- "tion of this lamp and its superiority over any other, but "he cannot go into an argument before this jury as to its "general utility.

"(TO THE JURY): The jury will not pay any attention "to what the witness is saying as to the general utility of "*this thing* that is in evidence before you.

"MR. RAYMOND: It is the province of an expert to "examine what is in a patent, and give testimony as to "what these advantages are, and what the construction of "the patent should be.

"THE COURT: But he does not know all the patent- "able lamps that have been in existence up to this time. "He says 'so far as he knew and has gone,' but he does "not undertake to say that he is perfectly familiar with "the art as it existed up to the date of this patent.

"MR. HILL: If he had done that it is his duty to "bring the facts before the Court, and let the Court see "whether it was a patentable article or not."

"THE COURT: You put yourself in the position of "saying, Mr. Raymond, that this Court cannot say what "is patentable and what is not, and you cannot bring an "expert here and testify what is patentable.* The Court

*In explanation of above, it is proper for plaintiff's counsel to state that, after the opening statements had been made, the jury was sent out, and the Circuit Judge announced to counsel that, in his opinion, the patent sued upon was simply for a well-known fastening, and that a peremptory instruction should then go to the jury to return a verdict for the defendant. Counsel for plaintiff then insisted, upon the authority of this Court, that the question of validity, the question of infringement, and the question of damages, were all mixed questions of law and fact which, in every patent case at law, must go to

" won't submit to that. You must get your facts in here, " and the Court will construe the matter of law to the " jury. You have not laid the foundation to introduce any " such testimony.

" MR. RAYMOND: What we are reading now is usual, " but it is cumulative of what we have already in the " record, so we will stop this right now.

" THE COURT; *It is a question for the Court, and one " which the Court has to decide.*" (Trans. –. 48).

Plaintiff's counsel excepted to the statements of the Court made in the presence of the jury.

It is perfectly plain that the Court was of opinion that it was the province of the Court, in the end, to determine the question of patentability upon whatever facts might be submitted, and the Court proceeded upon this theory, both in the instructions refused and in the instructions given.

Again—

The following instructions were refused:

" Before you should determine the Irwin patent invalid, " *by reason of any prior patent*, you should be satisfied " that you find the entire invention of Irwin in one prior " patent. It is not sufficient that you should find one of

the jury; that the questions of novelty and utility were purely questions of fact for the jury; and that upon the question of validity the province of the Court was simply to instruct the jury as to the legal meaning of the patent as an instrument, the face and meaning of which the Court should interpret and construe. Upon a demonstration of the correctness of this proposition the jury was recalled, and the trial proceeded. [3 Fisk. 343; 3 Blatch. 535; 5 McLean 44; 17 How. 74; 1 Wall 491; 28 Fed. Rep., 85-90.]

"the elements in one patent, another in a second patent, "and a third element in a third patent." (Trans. p. 58).

This instruction is quoted from *Union S. Refinery* v. *Matthilson*, 2 Fish. 600.

Manifestly, the reason for refusing this instruction was, in the opinion of the Court, that the Irwin patent consisted of but one element, namely, a hinge.

As manifestly, if the Court was wrong in its construction of the patent, and should have found that the patent involved a loose globe, a protecting basket, from which the bottom was suspended, and "to the upper part of" which the top was so secured as to insure the retention of the globe in place at all times and under all conditions, then the refusal of this instruction was, also, material error.

Again—

The rule of comity is, of course, not a binding rule, although it is a strong and thoroughly well established rule of decision, equal in dignity to the rules which govern the discretion of the Chancellor in granting or refusing an injunction, in the exercise of which his decision, as a rule, is final, and from which, generally, no appeal lies. We do not contend that it is technical error, and subject, *per se*, to review, that a judge presiding over a trial at law should ignore the doctrine of comity and should set aside well-considered and deliberately pronounced judgments by other Benches of the Circuit Court of the United States, as was done in this case.

The court was asked to instruct the jury in the language of the prior adjudications construing this patent

(see Statement, *supra*), and declined to do so. This refusal is cited simply to further show the real meaning and effect of the erroneous instructions of the court.

In *National Brake Shoe Co.* v. *Terre Haute Co.* (19 Fed. Rep. 517), which was an action at law, in referring to a prior decision by his honor Judge Drummond, in charging the jury Judge Wood says: "I say to you that "such decisions have been made, but they were decisions "in particular cases, made of course with reference to the "evidence adduced in those cases, and, while they are "entitled to weight upon your mind, they are not abso-"lutely conclusive upon you."

I think that a Circuit Judge of the United States, presiding over a trial at law of a patent case, should be as much bound, in his part of the trial, by the rules of comity and *stare decisis* as he is and should be in hearing and deciding equity cases, and especially in construing a grant by the government, which construction should be the same in all the United States Circuits until changed by this Court. But I admit that there is no law requiring this consistency, and cite this refusal of the Court below only the more clearly to show the erroneous construction given by the Court to the jury of plaintiff's patent.

Again—

The defendants (Trans. p. 56) introduced a copy of the Irwin Patent, No. 47,551, granted May 2, 1865, as anticipatory of the Irwin patent sued upon, to which the plaintiff objected on the ground that the record already showed that Patent No. 47,551 covered a construction devised by

Irwin after the actual date of the invention of the patent sued upon, the evidence of which fact appears at pages 56 and 57 of the Transcript.

Notwithstanding plaintiff's objection to this Irwin patent, No. 47,551, as evidence for any purpose, the court said to the jury (Trans. pp. 62 and 63, Fol. 114): that "these two patents, if they are substantially the same in "matter of the location of the hinge, must be considered "the same, for the hinge, then, cuts no figure in the "patent if they perform the same function. If the top, "either breaking in the middle or near the top of the "globe, performs the same function in the two patents, "then they would be substantially the same, and the first "taken out is the valid patent, and the second one would be "void";—again, reducing the Irwin patent sued upon to a patent upon a hinge, and instructing the jury that if they find a hinge in the Irwin patent, No. 47,551, then the jury must find that Irwin anticipated himself.

It is perfectly manifest, as was decided by Judges Blodgett and Wallace, that the structure of the Irwin patent, No. 47,551 (even if, in point of time, it legally anticipated the patent sued upon), did not disclose the invention of the patent sued upon, and that the latter describes and claims patentable novelty.

Judge Wallace said: "Assuming that Irwin's first "patent was granted before the lantern of the second "patent was invented, it is believed that the change made "in the last lantern was not such an obvious one as to "negative the exercise of invention. The special utility "of the device over the lantern of the first patent con-"sists in the protection of the loose globe against "accident," etc.

There was no occasion, necessity, or legal rule (even under the strict rules of practice in the Patent Office) requiring Irwin in the patent which first issued to make a cross-reference to, or to reserve the subject-matter of the patent sued upon, because the invention described and claimed in the patent sued upon was not disclosed or suggested in the patent which first issued.

Again—

The plaintiff objected and excepted to the admission in evidence of models offered by the defendant purporting to be duplicates of models as they then (in 1886) existed in the Patent Office, under a certificate of the Commissioner of Patents, and to the instructions of the court to the jury that they were, as a matter of fact, models of prior patents.

The exception appears in the transcript at page 66. A sample certificate of the Commissioner of Patents, under which these models were introduced, which certificate states that they are copies of the model "as it now "appears, a portion being lost, except the globe," etc., appears at page 55 of the transcript.

The models referred to are the Morley, the Miller, and the Waterman, concerning which the Court said to the jury (Trans. p. 62): "Look at these other models intro- "duced in evidence,—the Morley, the Max Miller and the "Waterman,—and see whether they secured or suggested "a removable lantern top fastened by a hinge on to one

"side, and some sort of a catch on the other. If they "did, they anticipate Irwin's patent."

The Revised Statutes (§ 892) provide that "written or "printed copies of any "*records*, *books*, *papers* or *draw-* "*ings* belonging to the Patent Office" * * * "shall be "evidence in all cases where the originals could be evi- "dence." We do not think that the original model itself, if proved to have been preserved in the top story of the Patent Office (notwithstanding the fires that have occurred) in the shape in which it was originally filed, would be competent evidence to sustain such a charge to the jury which, in effect, was that the model "anticipated Irwin's patent." But, be this as it may, it seems perfectly plain that such mutilated models, under such a certificate from the Commissioner of Patents, supported, and supported only, by the testimony of the defendant's expert that on the Saturday previous to the trial he had compared the same with what was on deposit in the Patent Office, constitutes useless evidence for any purpose whatever, and ought not to have been admitted, and ought not to have been made the basis of such a controlling charge to the jury.

Again—

An English *provisional specification* filed by Sutherland, which never went to a patent, is introduced in evidence under objection. The defendant's expert says, "there being no drawing attached to the English patent, "it is *impossible to tell how the patentee intended to make* "*it*, but it corresponds."

Extracts from the Sutherland provisional specifications are given to a young man in the employ of the defendants, who, at the date of these specifications, was three years old, and who therefrom, with his knowledge of the art in 1886, and for the purposes of this case, makes a model now presented to the Court. For the record as to the statements now being made, see Transcript, pp. 49–56, Folio 102.

The plaintiff objected to the introduction of this model as evidence (Trans. p. 101), and excepted to the charge of the Court which, in effect, instructed the jury that the Sutherland specification was sufficiently full, clear and exact to enable a workman to construct the Irwin improvement, and, further, that as a matter of fact, these models represented prior patents.

It is a sufficient comment, concerning this Sutherland English provisional specification and the fraudulent model introduced in evidence, to say that, at that date, a loose globe had never been heard or even thought of in such a structure, and, to repeat what we have already said, that these prior structures have no more to do with the Irwin patent than has a trunk or coffee-pot lid.

Again—

The court in its instructions to the jury, according to the exception taken by the defendants, made an improper use of extracts from the testimony of the plaintiff, Mr. Adams.

Mr. Adams, in his deposition, on cross-examination, freely and without objection answered all the questions put, even when interrogated as to the proper legal construction of the Irwin patent. He says (Trans. p. 39), "I "am not a professional expert," * * * "and while I "gladly give my opinion and views for what they are "worth, I do not want this case prejudiced by non-pro- "fessional views as to the construction of patents." Notwithstanding this, counsel for defendants and the court below have twisted his deposition into an opinion that the Irwin patent is a patent for a hinge; and not only so, but, although, upon the question of the proper construction of the Irwin patent, no question of estoppel can be based upon Mr. Adams' deposition, the Court below, as we think erroneously (Trans. p. 69), quotes from his deposition for the purpose and with the effect just stated.

We, therefore, respectfully submit that, as matters of law, there was error in the trial below in the following particulars, on the ground of any one of which the plaintiff should be awarded a new trial, to-wit: Especially in the construction given to plaintiff's patent, also in the instructions refused, in the instructions given, and in the admission of incompetent evidence which was necessarily controlling in the minds of the jury upon the questions of validity and anticipation.

Respectfully submitted,

J. H. RAYMOND,

Att'y. and of Counsel for Plaintiff.

TEMPLE COURT, CHICAGO,
September 25, 1891.

Office Supreme Court U. S.
FILED.
APR 29 1891
JAMES H. McKENNEY.
CLERK.

Supreme Court of the United States.

October Term, 1890.

J. McGREGOR ADAMS,
Plaintiff in Error,
vs.
THE BELLAIRE STAMPING CO. et al.,
Defendants.

No. 360.

BRIEF FOR DEFENDANT IN ERROR.

L. HILL,
For Defendant in Error.

McGILL & WALLACE PRESS,
WASHINGTON, D. C.

IN THE

Supreme Court of the United States.

OCTOBER TERM, 1890.

J. McGregor Adams, Plaintiff in Error,

vs.

The Bellaire Stamping Co. *et al.*, Defendants.

No. 360.

BRIEF FOR DEFENDANTS IN ERROR.

This is an action on the case claiming $62,500 damages for the alleged infringement of a patent granted to John H. Irwin, October 24, 1865, No. 50,591, for improvements in lanterns.

The suit was tried at Columbus, Ohio, June 2–9, 1886, before Judge Jackson and a jury, and resulted in a verdict for the defendants on all five of the special issues submitted.

The issues and findings were as follows (see Transcript, p. 25):

"1. Does the Irwin patent No. 50,591, dated October "24, 1865, here in suit, disclose an improvement which "required invention, as distinguished from mere me- "chanical skill or judgment, at the date of said alleged "invention?

"Answer. No invention.

"2. Had the invention claimed in the Irwin patent "No. 50,591, dated October 24, 1865, been patented or

"described in any printed publication prior to Irwin's "supposed discovery or invention thereof?

"Answer. Yes.

"3. Was Irwin the original and first inventor or dis- "coverer of any material and substantial part of the thing "patented in plaintiff's patent No. 50,591, dated October "24, 1865?

"Answer. No.

"4. Have the defendants infringed the plaintiff's pat- "ent No. 50,591, dated October 24, 1865?

"Answer. No.

"5. Does the evidence show an established license fee "or royalty for the use of the plaintiff's patent No. "50,591 now in suit; if so, during what period and at "what rate?

"Answer. No."

Exceptions taken by plaintiff to various rulings of the court on the admission and exclusion of evidence, and to the charge of the trial judge; motion by plaintiff to set aside the verdict and order a new trial, on the grounds stated in the bill of exceptions, and on the grounds that the verdict was against the law and the evidence; motion overruled and judgment for defendants on the verdict, and writ of error by plaintiff.

Defendants' contention is—

1. That there was no error either in the verdict, the charge, or the rulings.

2. That from those parts of the evidence which were offered and admitted without objection it conclusively appeared that the verdict on the issues submitted must be for defendants, without regard to the character of the evidence objected to, and therefore the alleged errors in the rulings and charge of the court were utterly immaterial.

3. That in view of the common knowledge of mankind, of which the court will take judicial notice, the plaintiff's patent was void on its face for want of patent-

able invention, and therefore the alleged errors at the trial, even if true, were immaterial, and the verdict was correct.

THE ALLEGED INVENTION.

The subject-matter to which the Irwin device is applied as an improvement is a lantern, of the general construction shown in the drawing opposite to pp. 7 and 67 of the Transcript. Such a lantern consists of a metal bottom A, a glass globe B, a metal top C, having a bail D or F, and a guard E formed of upright wires connected to top and bottom rings.

In a lantern of this sort—already old and well known long before the date of Irwin's alleged improvement—the bottom, the guard, and the top together constitute a kind of basket, in which the lamp, with its glass chimney and globe, is placed, in order that the glass may protect the flame from the wind and the guard may protect the glass from injury; whence it is sometimes called a basket-lantern. The lantern is carried by means of the swinging bail attached either to the top or guard, it is immaterial which. The bottom, supporting the lamp and chimney, is generally attached to the lower ring of the guard by means of a bayonet joint, so that it can be detached and removed for the purpose of filling or trimming the lamp or cleaning or renewing the chimney. The globe is supported by the lower ring of the guard, and for purposes of cleaning or renewal is insertible or removable through the upper end of the guard when the top is open. The top aids in securing the globe in place, and the top and bottom, together with the globe, protect the flame from the wind. Prior to Irwin's alleged invention it had been customary in such lanterns to removably fasten the top to the guard by various means, such as screws, bayonet joints, spring-catches, etc.

Taking this old, well-known structure as a thing that needed improvement, Irwin proceeded to apply to it what

he calls the "invention" in controversy, for the use of which his assignee demands of the defendants the modest sum of $62,500, and the nature of which is stated in the claim as follows:

"*Securing a removable lantern top to the upper part of the "guard, substantially as herein specified and described.*"

And in the specification as follows:

"The nature of my said invention consists in attaching "the metallic top of the lantern, in which the top of the "glass globe or protector enters and by which it is held "in place *by a hinge*, to the upper part of the wire guard "surrounding the globe and securing it at the side oppo-"site said hinge *by a removable fastening or spring-catch*, so "that by detaching said catch from the said upper part "of the lantern guard the top of the lantern may be "thrown back, opening upon the aforesaid hinge, thus "enabling the globe to be removed, or for any other pur-"pose."

It is obvious that the terms "removable fastening or spring-catch" cover every conceivable device applicable to lanterns and adapted to connect one edge of the lid to and disconnect it from the top of the basket or guard at the will of the operator. What Mr. Irwin claimed, therefore, was simply the application to a lantern-basket of a lid secured by a hinge at one side and by any kind of locking or latching device at the opposite side.

The important advantages of this remarkable "invention" over the prior lantern structures are not set forth, as is usually the case, in the patent, but we think they will be sufficiently obvious to the court upon an inspection of the apparatus. They consist in the facts that it is easier to manipulate one spring-catch than two, and that the hinge will prevent the top or lid from becoming separated from the basket.

The plaintiff, Mr. Adams, testified (Transcript, pp. 37 to 39, cross-answers 31 to 45, inclusive), that the inven-

tion *resides wholly in the use of a hinge and catch* instead of two catches or other equivalent fastenings, and that the only advantage possessed by it arises out of the fact that *it prevents the parts from becoming separated and lost* in case the catch should accidentally become unfastened.

And Mr. Adams, the owner of the patent, was perfectly correct in his understanding of the "invention" described and claimed therein. The most critical examination can make nothing else out of it. What Mr. Irwin claimed was *the securing of a lid to a lantern-basket by means of a catch at one side and a hinge at the other.* He made no other invention, and does not pretend to have made any other. But, as matter of law, if he had invented the whole lantern he could not now by reason of the terms of the claim broaden the patent beyond the specific means for attaching the lid to the basket.

Keystone Bridge Co. v. *Phenix Iron Co.*, 95 U. S., 274, 279.

With such a claim it was unnecessary at the trial to introduce any evidence at all as to the prior state of the art, or as tending to prove that the general construction of the lantern, with respect to all matters except the combination of catch and hinge, was old and well known, because, for the purposes of the suit, the law conclusively presumes all matters and things outside of the claim to have been old and public property at the date of the patent.

Rowell v. *Lindsay*, 113 U. S., 97, 101, 102, and authorities there cited.

It is immaterial, therefore, whether Judge Jackson did or did not admit or exclude any specific piece of evidence touching the prior state of the art, for the patent itself conclusively admits everything in the lantern to have been old except the combined catch and hinge for securing the lid to the basket. This alone disposes of all ob-

jections taken by the plaintiff to the rulings of the court below admitting or excluding evidence touching *the first issue* submitted to the jury. The jury were authorized, on the face of the patent, and with or without further evidence, to assume that to be true which the law conclusively presumes to be true. The evidence objected to was offered simply to prove such facts to be true; if admitted, it could do nothing more than the law does without its aid, and hence no ruling of the court admitting it could harm the plaintiff, nor, even if wrong, amount to such material error as to disturb or affect the finding of the jury.

Decatur Bank v. *St. Louis Bank*, 21 Wall., 294.
Brobst v. *Brock*, 10 Wall., 519.

THE VERDICT CORRECT.

Assuming those things to be true which the claim itself, as matter of legal presumption, conclusively admits to be true, the patent is clearly invalid and void on its face for want of patentable invention, and the verdict was therefore right.

There are four independent grounds upon which, or any one of which, this conclusion is inevitable, viz.:

(A) Because in view of the common knowledge of mankind the alleged "invention" is only an obvious instance of mere "double use."

(B) Because the claim must be construed as for a *combination* of basket, lid, hinge, and latch; and, in fact, this is a mere "aggregation," and not a "combination."

(C) Because the patent, being for an alleged combination of *four* elements, amounts to an admission, in law, that any possible combination of any *three* of those elements was old. Now, assuming the combination of basket, lid, and hinge to be old, it required no invention to add the old, well-known device, a latch. So, also, assum-

ing the combination of a basket, lid, and latch to be old, it required no invention to add the old, well-known device, a hinge.

(D) Because the only advantage or improved result claimed, to wit, the non-detachability of the lid, results solely from the use of the hinge; and it is matter of common knowledge that the idea or plan of bringing or articulating two elements together, with the resulting advantage of non-separability, is not due to the ingenuity of man and never was broadly patentable to him.

We will discuss these matters in the order above stated.

(A.)

The court takes judicial notice of those things in the arts and sciences which, at the date of the patent, were commonly and generally known and supposably familiar to all intelligent persons.

Brown v. *Piper*, 91 U. S., 37.

And also of the well-known advantages of such things.

Glue Co. v. *Upton*, 6 O. G., 838 (Clifford, J.), S. C., affirmed, 97 U. S., 6.

In the year 1865 the public were in full possession and universal use of the hinge-and-catch device, having inherited from the remotest antiquity the knowledge of it and its uses and advantages. It was in common use for securing all sorts of lids to all sorts of things. Familiar instances are found in coffee-pots, watches, show-cases, corn-poppers, pails, tea-caddies, spectacle cases, in fact, boxes of all kinds, from a "Saratoga trunk" down to a snuff-box or a match-box, and baskets of all kinds, from a big "hamper" down to my lady's work-basket. Inasmuch as a hinged door is distinguished from a hinged lid or "cover" only by its vertical position (which does not involve invention), it follows that every completely

equipped swinging door, from the gates of Troy down to the tin door of the old-fashioned tallow-dip farm lantern, was provided with the very device which Mr. Irwin has here patented.

The two advantages of the device as compared, for example, with a door or cover fastened at its opposite edges by two buttons, bolts, screws, catches, or other "removable fastenings," were, first, that it was easier to manipulate one removable fastening than two, and, secondly, that the hinge prevented the door or lid from becoming detached and lost. The knowledge of these advantages was co-extensive with the knowledge and use of the device itself, and was in the possession of every ten-year-old boy thousands of years ago. Mr. Irwin neither discovered nor invented anything new about the structure or its advantages or uses, but simply took the same old device that had already been applied to the side door of lanterns and the top door or lid of all sorts of things, and applied it to the top door or lid of a lantern-basket.

"'It is settled,' says Mr. Justice Gray, speaking for the "court, 'by many decisions of this court * * * that "the application of an old process, or machine, to a "similar or analogous subject, with no change in the "manner of application, and no result substantially dis-"tinct in its nature, will not sustain a patent, even if the "new form of result has not before been contemplated.' "(*Pennsylvania Railroad Co.* v. *Locomotive Truck Co.*, 110 "U. S., 490, and cases there cited.

"It follows from this principle that, where the public "has acquired in any way the right to use a machine or "*device* for a particular purpose, *it has the right to use it* "*for all the like purposes to which it can be applied*, and no "one can take out a patent to cover the application of "the device to a similar purpose.

"If there is any qualification of this rule it is that if "a new and different result is obtained by a new appli-"cation of an invention, such new application may be "patented as an improvement on the original invention;

"but if the result claimed as new is the same in character as "the original result, it will not be deemed a new result for "this purpose."

Blake v. *San Francisco*, 113 U. S., 682, 683.

The plaintiff himself, when on the witness stand in this suit, was unable, as we have already seen, to predicate any result whatever from Irwin's new application of the old hinge-and-catch device other than the old and well-known result of preventing the lid from becoming detached and lost. (Transcript, pp. 38, 39.)

No evidence was therefore needed to authorize or sustain the verdict on the first issue, which disposes of the whole case. This verdict was a foregone conclusion from the face of the patent itself, in view of the common knowledge of mankind. Neither the rulings of the court on the admission of evidence, nor on the law or the weight of the evidence, could affect the result in the least. The patent presents merely an instance of good judgment in the selection of known means, or, in other words, "double use," instead of the invention of a new means.

(B.)

There is another conclusive reason why the verdict and judgment on the first issue were sound, namely, that the assemblage of elements here patented is a mere aggregation and not a patentable combination.

Hailes v. *Van Wormer*, 20 Wall., 353.
Pickering v. *McCullough*, 104 U. S., 310.

The claim, in its participial form, might be construed as for the *method* or *art* of "securing" things, viz., by a hinge and catch; but as this would render the patent void under the doctrine of *Corning* v. *Burden* (15 How., 252), the claim, *ut res magis valeat*, must undoubtedly be construed as for the *combination* of the basket, the lid, the hinge, and the catch.

Now, irrespective of the question of *novelty*, we submit that the essential feature of patentable *combination* is lacking in such a claim, and that the claim is, therefore, void on its face.

The *hinge* performs its functions just the same whether the lid has a fastening at the opposite side or not. So, too, the *catch* performs its function just the same whether the lid be secured at its opposite edge by a hinge or by any other suitable form of fastening. Each of these two devices, the hinge and the catch, is a complete and operative structure in and of itself, and each is used to perform its *own* function—not to aid the other in the performance of *its* function, nor to unite with it in the performance of some new function.

The *result* is an aggregation, viz., the result of the *basket*, *plus* the result of the *lid*, *plus* the result of the *hinge*, *plus* the result of the *catch or lock*, and there is no new result due to the combination of the four parts in one structure. If we remove the catch, the other three parts co-act precisely as before, with precisely the same result, *minus* the special result of the catch. The difference is substantially the same as the difference between a tea-pot and a coffee-pot, of which two articles the lid of the former generally has no catch, while that of the latter usually has one; or, the difference between a door without a lock and a door with a lock.

The only function mentioned by the plaintiff as being new or important in lanterns is that the lid is prevented from becoming detached and lost. But this is due to the *hinge* alone; the catch has nothing in the world to do with it. Hence, it is not a new function of the *combination*, but only the old well-known function of a hinge.

Inasmuch as the four parts do not co-act to produce any new result due to their combination, the claim clearly falls within the prohibition of *Pickering* v. *McCullough*,

and, as the jury correctly found, is void for want of patentable invention; and this, too, on the face of the patent, without the necessity for any evidence as to the state of the art except that which is disclosed by the very terms of the claim itself. Nothing in the rulings or charge of the trial judge did or could affect the finding of the jury on this question. True, they did not, in express terms, find "no combination," but they did find "no invention," and this finding is supported by the obvious fact of "no combination."

(C.)

Again, the patent for the combined basket, lid, hinge, and latch is not infringed by the use of a basket, lid, and hinge without the latch. In other words, a man who should make or use the lantern shown in Irwin's patent without any fastening at the side of the lid opposite to the hinge, would not have Irwin's "invention." But, if a purchaser of this lantern should *fasten down the free edge of the lid* by any kind of "removable fastening" whatever, such, for example, as a string, a screw, a rubber band, a pin, a spring-catch, etc., etc., he would thereby become an infringer. It is obvious, however, that the change would not involve invention, and that no man in this age of the world can be prohibited from temporarily fastening down that which, in his opinion, needs to be fastened down.

(D.)

The result sought to be monopolized by the patent is the preventing of the lid from becoming detached and lost, and this result looks to the *hinge* as the essential element. But a hinge is not, and never was, broadly patentable to anybody in any age of the world—first, because it does not rise to the dignity of an invention,

and, secondly, because it was old long before man began to invent.

It does not rise to the dignity of an invention, because it is within the knowledge and skill of the lowest orders of the animal kingdom. For example, in all parts of the world certain *spiders* are in the habit of constructing their nests in the form of a box or cavity covered by a protecting lid hinged to one side of the nest. (See *Popular Science Monthly* for December, 1890, pp. 189 to 193, article, "Defenses of Burrowing Spiders," where several examples of this construction are described and illustrated.)

That it was old long before man began to invent is shown in his own body and in the bodies of almost all other animals, vertebrate and invertebrate. When man needed a hinge in the articles made by him he did not have to invent one, but simply to imitate a structure already familiar to him.

Yet here comes Mr. J. McGregor Adams with a patent on this contrivance that even the spiders had made and used for thousands of years, and claims, in the Supreme Court of the United States, $62,500 damages of the defendant for using it! In behalf of the spiders, we beg leave to protest!

We respectfully submit that, upon all or any of the four grounds above stated, the verdict on the first issue was correct both in law and in fact; and therefore that the rulings and charge of the court below on other and additional matters were entirely inconsequential, whether right or wrong.

If our position is sound, it disposes of the whole case.

II.

THE RULINGS AND CHARGE CORRECT.

The plaintiff assigns, as the first error, that the court below was wrong—

"1. In refusing an instruction to the jury that before "determining the patent sued upon to be invalid by rea- "son of any prior patent it is not sufficient to find one of "the elements in one patent, a second in another, and a "third in another."

We answer—

1. Whether such instruction should be given or not depends upon the character of the patent. If the patent were for a true "combination" of new or old elements, producing a new result by virtue of their *combination*, then the instruction prayed for would be correct. But if the patent were (as it is) for merely a new *aggregation* of old elements, in which each element performed its old function, and no new result was produced by their combination in the manner claimed, then the instruction prayed for would not apply, and it would have been error to give it. The law is that whereas a claim for a true *combination* can not be anticipated by showing the separate elements to be old, yet a claim for a mere *aggregation* can be so anticipated.

Hailes v. *Van Wormer*, 20 Wall., 353.
Stephenson v. *Brooklyn R. R. Co.*, 114 U. S., 149.
Reckendorfer v. *Faber*, 92 U. S., 347.
Stimpson v. *Woodman*, 10 Wall., 117.
Hotchkiss v. *Greenwood*, 11 How., 248.
Pearce v. *Mulford*, 102 U. S., 112.
Hollister v. *Benedict Co.*, 113 U. S., 59.
Penn. R. R. Co. v. *Locomotive Truck Co.*, 110 U. S., 490.
Blake v. *San Francisco*, 113 U. S., 679.
Pickering v. *McCullough*, 104 U. S., 310.
Thompson v. *Boisselier*, 114 U. S., 1.

In all these cases and many others the defendants were permitted to show, first, that each element was separately old; second, that there was no new mechanical result produced by their union; and thirdly, that such union, for the purpose of aggregating their several old results, was matter of mere judgment and knowledge of the art and not invention.

Hence it follows that the instruction prayed for involved an incomplete statement of the law, and was properly refused. If given, it could only have tended to mislead the jury by confounding "combinations" with "aggregations," and by failing to discriminate between the very different principles of law applicable to those two subjects.

2. We further answer that inasmuch as the Irwin patent discloses and claims a mere aggregation, it would have been gross error to give the instruction prayed for. The charge of the court must be based upon the facts before the jury.

Bearer v. *Taylor*, 1 Wall., 637.
Rhett v. *Poe*, 2 How., 457.
Lucas v. *Brooks*, 18 Wall., 436.

3. Thirdly, the charge presented the whole controversy plainly, and gave the law so as to guide the jury correctly.

The defendants' first special plea (Transcript, p. 21) raised the question whether the patent was for a patentable invention or for the product of mere skill and judgment in view of the prior art.

The first special issue (Transcript, p. 25) embodied the same question.

The court, therefore, properly directed the particular attention of the jury to this question, and stated the law fully, clearly, and correctly, leaving the decision entirely to their judgment without any attempt to influence or

bias their action. This is all that the law requires, and where it is done there is no error in refusing some special instruction prayed for, even though it should, in itself, be correct.

The Schools v. *Risley*, 10 Wall., 91.
Railway Co. v. *Whitton*, 13 Wall., 270.
Railway Co. v. *McCarthy*, 96 U. S., 258.
Kelly v. *Jackson*, 6 Pet., 622.

See also, 3 How., 674; 1 Black, 533; 7 Wall., 565; 8 Wall., 27; 19 Wall., 433; 93 U. S., 291.

The second error assigned consists—

"2. In declining to instruct the jury that the fact that "the Irwin lantern practically superseded all others was "strong though not conclusive evidence of its novelty "and utility."

We answer:—

1. The assignment of error does not state the prayer correctly; there was nothing in it about "utility," but only about *novelty*, and it differed in other important respects (see Transcript, p. 58) from the form of statement on p. 66.

2. The question at issue under the first and main issue submitted was not of novelty, but of *patentable invention*. The instruction prayed for was not germane to this issue, and was, therefore, properly refused. Where there is *no invention* the extent of use and the superseding of other devices before used are matters of no moment.

Hollister v. *Benedict Co.*, 113 U. S., 59.
Rubber Tip Pencil Co. v. *Howard*, 20 Wall., 498.
Butler v. *Steckel*.
Union Edge Setter Co. v. *Keith*, 55 O. G., 285.

3. In view of these facts the instruction could not properly be given in the form presented. It needed a

qualification to adapt and confine it to the second and third issues. It should have prayed the court to instruct the jury that, *if* they found the patent to involve invention, in contradistinction to mere skill and judgment, then, on the further issues as to the novelty and utility of that invention, they were at liberty to regard its commercial success as competent, though not conclusive evidence for the plaintiff. So qualified, there could have been no valid objection to it, but without that qualification it was adapted to muddle and mislead the jury, and would have tended to lead them into error as to the first issue, to which the evidence mentioned had no relevancy or competency. The word "strong" was also improper—the jury should judge of the strength of the evidence. The prayer was, therefore, properly refused.

The third error assigned consists—

"3. In admitting the models offered by defendant "and instructing the jury that they were, as matter of "fact, models of prior patents."

We answer:

1. The models were duly certified copies from the Patent Office (see Transcript, middle of p. 55).

The certificate of the Miller model pointed out its variance from the orginal (Id., bottom of p. 55).

The testimony of Mr. Smith (Id., p. 56) identified the Waterman, Marley, and Sutherland models as fair reproductions of the originals, or fair models from the original descriptions of the patents, and pointed out their variances.

There is no pretense on the part of the plaintiff that these models were not complete as respects the guard, the lid, and the means of securing the lid to the guard.

The court did not instruct the jury that these models were absolutely correct copies in all respects of the original Patent Office models, or absolutely correct reproductions

of the things patented, but simply admitted the models with their patents and with the testimony concerning them, and left the jury to judge of the facts on the whole evidence.

The fourth error assigned consists—

"4. In instructing the jury that the Sutherland model "introduced by the defendants was a model constructed "from the Sutherland specifications, and in instructing "the jury in effect that the Sutherland specifications "were sufficiently full, clear, and exact to enable a work-"man to construct the Irwin improvement."

We answer:

1. The uncontradicted evidence of Blankley (Transcript, pp. 49, 50) shows that he constructed this very model from a copy of Sutherland's specification without any other aid.

2. The court did not instruct "the jury in effect that the Sutherland specifications were sufficiently full, clear and exact to enable a workman to construct the Irwin improvement," nor even to enable him to construct the Sutherland lantern. On the contrary, the court said to the jury (see Transcript, middle of p. 62): "*It is for you to determine* whether that description is such as enables him to construct that lantern, and whether it has a top formed in the manner indicated."

The fifth error assigned consists—

"5. In instructing the jury in effect that the Irwin "patents, 47,551 and 50,591, were substantially the same, "except in the mere matter of the location of the hinge."

We answer:

That is not the meaning of the court's instructions (see Transcript, folios 114, 115, pp. 62, 63). The court merely told the jury in effect that if they found the two Irwin lanterns to be substantially the same in function, mode

of operation, and mechanical structure, except that the hinge was placed differently, the difference in the location of the hinge would not be material. This is undoubtedly correct.

Under the heading "Third" (Transcript, p. 66), five specific errors are further assigned, viz.:

"1. The final instructions of the court to the jury were "that the patent sued upon covered simply and broadly "the attaching together of two parts of a lantern by a "hinge and catch as distinguished from securing them "by two catches, and we complain that the necessary "effect upon the minds of the jury of the court's instruc-"tions and of the frequent remarks of the court in the "presence of the jury during the progress of the trial "was that this was a patent for the mere application of "a hinge to a well-known structure."

We answer:

1. That the alleged "frequent remarks" are not set forth in the bill of exceptions, and therefore can not be used as grounds of error.

2. That as to the scope of the patent the court charged the jury in the very terms of the claim (see Transcript, middle of p. 60 and top of p. 61), and not in the terms stated in the assignment of error.

3. That if the court had charged the jury as stated in the assignment of error it would only have construed the claim exactly as the plaintiff himself construed it in his testimony quoted in the charge, and surely the plaintiff could not complain of this as error.

4. And that such construction would have been correct.

The court, however, confined itself to construing the patent in terms of its own language, which is clear, full, and unmistakable in meaning.

The second assignment of error under this head is—

"2. In declining the instructions asked by the plaintiff that due weight must be given to the words of the claim 'substantially as herein specified and described.'"

We answer:

1. There was no prayer for this instruction. The prayer was (Transcript, p. 58) for the court to instruct the jury that due weight must be given to the expression, "*The whole being as above described of the invention as contained in the specifications.*" There being no such "expression" in the patent, the court very properly declined to give the instruction in manner and form as prayed for.

2. The court did, in substance, give the instruction in the manner and form stated in the assignment of errors, saying (Transcript, p. 60): "What Irwin claimed as his invention was 'securing a removable lantern-top to the upper part of the guard substantially as herein specified and described.' That is his claim, in his own language; *but the description in the previous specifications explained simply how this 'removable top' is secured*, and some of its benefits and advantages. That specification does not enlarge or change his claim or entitle him to include in his patent anything more than the securing of a removable lantern-top *in the manner therein described.*"

What the plaintiff desired was an instruction authorizing him to argue to the jury that the claim in effect involved the construction of the entire lantern.

What the court gave the jury to understand was that the claim was limited to the described mode of securing the top to the guard.

Under this instruction the jury could not be muddled. "*Hinc illae lachrymae.*"

That we do not misjudge the motive will clearly appear from the next succeeding assignment of error, which is as follows:

"3. In declining to give the instruction as to the essen-
"tial features of the patent sued upon, which instruction
"was asked by the plaintiff in the language used by the
"Circuit Court for the northern district of Illinois, and
"substantially in the language used by the Circuit Court
"of the southern district of New York, construing this
"patent in prior litigations." (See Transcript, p. 58.)

We answer:

Judge Jackson was right in refusing this instruction for the following reasons:

1. No law or rule of comity obliges one court to follow another into a clear error of law or fact.

2. That the New York and Illinois courts were clearly in error in construing the whole lantern into the claim is evident from even a cursory examination of the patent.

(*a*) The specification declares in terms that the invention consists in "attaching" and "securing" the lid to the basket by a "hinge" and "removable fastening or spring-catch," so that by detaching the catch from the upper part of the guard the lid may be thrown back, opening upon the hinge.

The claim follows this description and adds nothing to it. On the rule, "*Expressio unius exclusio alterius est*," this clearly limits the invention to the means for securing the lid to the upper part of the guard or basket.

(*b*) The parts which are so stated to constitute the invention have no mechanical co-action whatever with the globe, the lamp, the chimney, or the base A, and operate just the same whether these last-named parts be present or not. Smash the globe or the chimney, or detach and remove the base A and the lamp, and the alleged "invention" described and claimed in the patent will still be there, entirely unaffected by such proceeding. Hence no reason or excuse can be given for reading these independent elements into the claim.

(*c*) As they do not co-act in any patentable sense with

those elements which are expressly declared to constitute the invention claimed, to add them or any of them to said claimed elements would obviously produce a mere aggregation and not a patentable combination. What reason can be given for reading into the claim elements neither expressed in it nor co-acting with its expressed or implied elements, especially in view of the fact that such proceeding would render the claim invalid on its face as being for an obvious aggregation?

(*d*) The declared object of the invention is to enable the lid to be thrown back on its hinge when the catch is detached so that the globe can be removed, "*or for any other purpose*" (Transcript, p. 6). "When it is desired to remove the globe *or to open the lantern for any other purpose*" (*Id.*, p. 7), "the top is swung back upon the hinge G into the position indicated by the dotted lines, when the globe can be removed, *or any other purposes may be accomplished as desired.*" (*Id.*, p. 7.)

That the opening of the lid will enable the attendant to reach his hand into the basket and remove the globe if he so desires does not put the globe into mechanical combination with the lid and its fastenings. If it did, then, on the same principle, if he should open the lid to wipe the globe, the wipe-rag would enter into the combination; if a huckster should open his basket to take out a turkey, the turkey would become combined with the lid; or if a servant should open the door of a house to let a visitor out, the visitor would find himself in mechanical combination with the door. The thing is, of course, a wild absurdity, and we should feel obliged to apologize to the court for even replying to it were it not for the fact that the circuit courts in New York and Illinois seem to have been hypnotized into an approval of it.

The fact is, that the globe is one of the contents of the basket, and is no more in combination with the lid and its fastenings than are the contents of any other box or basket.

(*e*) Moreover, the lid is to be opened by the means described not only to remove the globe, but for "any *other* purpose." It follows, therefore, that if the capability of removing the globe puts the latter into combination with the lid and its fastenings, then the capability of carrying out such "other purpose" puts into the combination anything and everything that will come under the scope of such "other purpose." Any logical reason that would exclude from the combination the wipe-rag suggested above would exclude the globe also. The lamp chimney would, of course, be included in the combination for the same reasons as the globe, because it, too, could be inserted or removed through the open top if desired.

3. It is hardly conceivable that the circuit courts in Illinois and New York meant to be understood as including a removable globe in the combination claimed. Their language on the subject is somewhat loose, however, and taken in connection with the fact that they sustained the patent, would, if given to the jury in the instruction prayed for, have possibly muddled the jury as to the real scope and character of the alleged "invention;" hence the instruction was properly refused.

It is to be noted that the decisions in Illinois and New York were given prior to the decision of this court (A. D. 1883) in *Penn. R. R. Co.* v. *Locomotive Truck Co.*, 110 U. S., 490, and when the law of double use was not so clearly understood by the lower courts as it has been since that decision.

The fourth assignment under this head is substantially the same as the second under the first head, and has therefore been already answered.

The fifth is as follows:

"5. In the use made of the extracts quoted from the "testimony of Mr. Adams."

The quotations are found on pp. 60, 61, and the entire testimony on pp. 32–45 of the Transcript.

The court made no "use" of the testimony except to quote it.

Mr. Adams is the plaintiff, the owner of the patent, and a mechanic who has been extensively engaged in the manufacture of lanterns since 1860. (Ans. 3, p. 32, Transcript.) We fail to conceive any valid objection to his testimony. His counsel made no objection to the questions when his testimony was taken.

The final assignment of error is as follows:

"Fourth. The court erred in the general tenor and "effect of the instructions in that they could have no "other effect in the mind of the jury than this, that it "was the duty of the jury to find that the plaintiff's "patent did not disclose a patentable invention, "which, of course, was determinative of the case and "practically determinative of each of the special inter-"rogatories to the jury."

We answer:

1. This assignment is so vague and indefinite as to be unintelligible. Does it mean that the court misdirected the jury as to the law, or as to the facts? In either case, to be a good assignment of error, it should point out the particular misdirection objected to in order to give the defendant due notice of the points to be answered.

2. If the patent was void on its face for want of patentable invention, as we submit it was, the court had the right, and was in duty bound to so direct the jury, and would have been justified in directing a verdict for defendant.

3. What the court did was to instruct the jury correctly as to the law of the case. If this was tantamount

to telling them that the plaintiff had no ground of action—as it probably was—it was unfortunate for the plaintiff; but it was not error.

We now call the attention of the court to the fact that the special assignments of error all relate to questions arising under the first, second, and third issues only. *No error is alleged as to any ruling or direction of the court on any question relating to the fourth or fifth issues.* Hence no question is now open under the verdict upon these two issues.

The fourth issue (Transcript, p. 25) relates to the question of infringement, and was found in favor of defendant. This finding, which is not open for discussion here, disposes of the whole controversy.

This conclusion can not be affected by any of the alleged errors of the court in directing the jury as to the construction to be placed upon the plaintiff's patent. On that point the plaintiff's complaint is that the court only included in the invention the guard, the lid, the hinge, and the catch, whereas it should have included also other elements of the lantern, such as the removable globe, etc., etc. In other words, that the court held the invention to consist in a certain part of the structure, whereas, in fact, it consisted in that part combined with other parts.

But the jury found that the defendant did not infringe *that* part; and, of course, it follows that the defendant did not infringe the combination of that part with other parts. Hence that the alleged error did not and could not in any way affect the result so far as this issue was concerned.

Under the fifth issue the jury found that the plaintiff had established no measure of damages. No error is alleged as to any ruling or direction of the court relating

to matters involved in this issue. Under the verdict on this issue the plaintiff could recover only nominal damages and costs even if the jury had found all the other issues in his favor. We therefore respectfully submit that even if this court should disapprove of the rulings and instructions of the court below, and for that reason set aside the verdict on all the other issues, it could only remand the case with directions to enter a judgment for nominal damages and costs, in view of the verdict on the fifth issue, as to which no error is alleged.

In the above discussion we have not taken into consideration the general objection made by the plaintiff to the entire verdict as to all the issues on the grounds that it was against the weight of the evidence, etc., etc., and that there was "irregularity" in the proceedings of the court, "misconduct" on the part of the defendant, "surprise" on the part of the plaintiff, etc., etc.

As to the "irregularity," "misconduct" and "surprise," we do not even know what is meant. But if any such things existed they should have been specially excepted to at the time, relief asked, and a refusal of relief, together with all the facts, made a part of this record by bill of exceptions. This not having been done there is nothing before the court to inquire about.

As to the verdict being against the weight of the evidence, etc., etc., we have already pointed out enough to show the contrary, and will reserve any further remarks to the oral argument.

Respectfully submitted,

L. Hill,
For Defendant in Error.

L. Hill